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**Datasheet for the decision
of 23 February 2024**

Case Number: T 1591/22 - 3.2.05

Application Number: 15151335.5

Publication Number: 2894041

IPC: B41K3/10, B41K3/12, B41F13/00,
B41F33/00

Language of the proceedings: EN

Title of invention:

Numbering device for typographic numbering having electric motors for driving numbering wheels

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 request 5: yes; auxiliary request 6: no)



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1591/22 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 23 February 2024

Appellant: Paul Leibinger GmbH & Co. KG Nummerier-
(Opponent) und Markierungssysteme
Daimlerstrasse 14
78532 Tuttlingen (DE)

Representative: Westphal, Mussnug & Partner
Patentanwälte mbB
Am Riettor 5
78048 Villingen-Schwenningen (DE)

Respondent: KBA-NotaSys SA
(Patent Proprietor) PO Box 347
55, Avenue du Grey
1000 Lausanne 22 (CH)

Representative: Koenig & Bauer AG
- Lizenzen - Patente -
Friedrich-Koenig-Straße 4
97080 Würzburg (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
22 April 2022 concerning maintenance of the
European Patent No. 2894041 in amended form.**

Composition of the Board:

Chairman P. Lanz
Members: T. Vermeulen
F. Blumer

Summary of Facts and Submissions

- I. The opponent lodged an appeal against the interlocutory decision of the opposition division finding that European patent No. 2 894 041 ("the patent") as amended according to auxiliary request 5 met the requirements of the European Patent Convention.
- II. The patent originates from European patent application No. 15 151 335.5, a third generation divisional application of European patent application No. 07 789 741.1 filed as international application PCT/IB2007/052366 ("the earlier application") and published as WO 2007/148288 A2 (hereinafter referred to as "document E3").
- 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), and under Article 100(c) EPC.
- IV. 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 that the decision under appeal be set aside and the patent be maintained as amended on the basis of one of auxiliary requests 6 to 8 filed with the reply to the statement setting out the grounds of appeal.
- V. Claim 1 of auxiliary request 5 considered allowable by the opposition division has the following wording (the

feature numbering used by the board appearing in square brackets):

"[M1.1] A numbering device (1) for carrying out numbering in sheet-fed or web-fed numbering presses, [M1.2] said numbering device (1) comprising a casing and [M1.3] a numbering unit (6) with rotatable numbering wheels (7) carrying alpha-numerical symbols thereon, which numbering wheels (7) are disposed next to each other and rotate about a common rotation axis, said numbering device further comprising electro-mechanical actuation means for setting the position of said numbering wheels (7), [M1.4] wherein said electro-mechanical actuation means are mechanically autonomous, 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), [M1.5] wherein each independent driving means comprises an electric motor (15) driving the associated numbering wheel through a gearing (16; 19-23; 23*) with a gear-wheel assembly (19-23; 23*), [M1.6] wherein the gear-wheel assembly (19-23; 23*) comprises a driving pinion (23; 23*) meshing with a toothed wheel (16) disposed on a side of the associated numbering wheel (7), [M1.7] wherein said electro-mechanical actuation means are disposed in an inner space of the casing of said numbering device (1 *[sic]*), [M1.7a] 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, [M1.8a] wherein the driving pinions (23) are disposed in a staggered manner along their shafts (22), the position of the driving pinions (23) being such that they mesh with the corresponding toothed wheels (16) of the numbering wheels (7), and [M1.8] an axial position of the driving

pinions (23; 23*) along their shafts (22) is adjustable [M1.8b] as a function of the width and/or axial position of the associated numbering wheels (7) on the common shaft (17), and [M1.6a] wherein each gear-wheel assembly (19-23) and the associated toothed wheel (16) form a two-stage gearing, wherein the meshing of the driving pinion (23; 23*) with the toothed wheel (16) provides one stage of the two-stage gearing."

VI. Claim 1 of auxiliary request 6 differs from claim 1 of auxiliary request 5 by the following (hereinafter underlined) amendments to features M1.6, M1.8a and M1.8:

"[M1.6'] wherein the gear-wheel assembly (19-23; 23*) comprises a first pinion (20) coupled to the electric motor (15), a gear wheel (21) mounted on an intermediate shaft (22), which gear wheel (21) meshes with said first pinion (20) and drives said intermediate shaft (22) into rotation, and a driving pinion (23; 23*) mounted on that intermediate shaft (22) and driven into rotation by that intermediate shaft (22), said driving pinion (23; 23*) meshing with a toothed wheel (16) disposed on a side of the associated numbering wheel (7),"

"[M1.8a'] wherein the driving pinions (23) are disposed in a staggered manner along their intermediate shafts (22), the position of the driving pinions (23) being such that they mesh with the corresponding toothed wheels (16) of the numbering wheels (7), and [M1.8'] an axial position of the driving pinions (23; 23*) along their intermediate shafts (22) is adjustable".

VII. The appellant's submissions may be summarised as follows.

Auxiliary request 5 - compliance with Article 76(1) EPC

Firstly, the amendments to claim 1 of auxiliary request 5 only partly reflected the disclosure in the earlier application as regards the two-stage gearing arrangement. In particular, basis for feature M1.6a was primarily found in claim 6 of the earlier application. However, not all of the additional features of that claim 6 were added to the new claim 1. Individual components of the two-stage gearing, such as the first pinion 20, the gear wheel 21 or the intermediate shaft 22 were left out despite being disclosed in structural combination with the other components of the two-stage gearing. Also a functional significance could be ascribed to the specific structure of the two-stage gearing, see for example the passage from page 14, line 29 to page 15, line 9 of document E3. In order to achieve the objective of having a small and compact numbering device, the concrete arrangement of an intermediate shaft between the motor and the numbering wheels with a gear wheel driven by a first drive pinion and a second drive pinion was of decisive importance. By omitting the intermediary shaft, also the feature group M1.8, M1.8a and M1.8b unallowably amended the earlier application as filed. There was no original disclosure for adjusting the axial position of an arbitrary driving pinion on an arbitrary shaft.

Secondly, the replacement of "gearing" by "gear-wheel assembly" caused a shift in the meaning of the claim.

Thirdly, when filing the European patent application that led to the patent in suit, the text passage on

page 6, lines 4 to 10 had been deleted from the earlier application. This amendment of the description infringed Article 76(1) EPC since it affected the interpretation of the patent in respect of the understanding when the electro-mechanical actuation means was completely arranged within the numbering device.

For those reasons, the requirements of Article 76(1) EPC were not met.

Auxiliary request 6 - compliance with Article 76(1) EPC

Despite the further amendments, it was still possible that the two-stage gearing of claim 1 according to auxiliary request 6 comprised a planetary gearbox, contrary to the original disclosure of the earlier application. Furthermore, the passage on page 13 of document E3 that served as basis for the amendments to claim 1 also mentioned a reduction gear 18 with an output shaft 19. Claim 1 of auxiliary request 6, however, did not require the motor to be associated with a reduction gear. The embodiment of Figure 7 of the earlier application was thus more specific.

Therefore, the requirements of Article 76(1) EPC were not met.

VIII. The respondent essentially argued as follows.

Admittance of an objection under Article 76(1) EPC

In the proceedings before the opposition division, the appellant expressly raised no further objection under Article 76(1) EPC against claim 1 of auxiliary request 5. Therefore, the submissions presented in the

statement setting out the grounds of appeal in respect of the detailed embodiment of the "two-stage gearing" amounted to a new objection which was raised for the first time on appeal and had to be rejected.

Auxiliary request 5 - compliance with Article 76(1) EPC

Claim 1 of auxiliary request 5 was directed to an axially adjustable drive pinion on a shaft driven by a two-stage gearing. The axial adjustability was disclosed in the second paragraph of page 19 of document E3. The need for a two-stage gearing for driving this shaft was derived from the fact that no alternative embodiment with a single-stage gearing was disclosed in the earlier application. The appellant's argument that a small and compact numbering device was only possible by adding the details of the two-stage gearing was not well-founded.

Furthermore, the expression "gear-wheel-assembly" had not been replaced by "gearing" in claim 1 of auxiliary request 5. Rather, the term "gearing" was merely added. It was in accordance with the original disclosure of the earlier application that the "gearing 16; 19-23; 23*" comprised the "gear-wheel-assembly 19-23; 23*" and the "toothed wheel 16". This was precisely what was reflected by claim 1 of auxiliary request 5.

The passage on page 6 of document E3 was an assessment of the state of the art, not of the features of the solution claimed by the earlier application. Anyway, the objection by the appellant was moot, since the addition of further features to claim 1 regarding the casing made an interpretation on the basis of the deleted paragraph superfluous.

Therefore, the requirements of Article 76(1) EPC were met.

Auxiliary request 6 - compliance with Article 76(1) EPC

The additional features of claim 1 according to auxiliary request 6 were based on the second paragraph of page 13 of document E3. The sentence on lines 26 and 27 of page 13 started with "[p]referably" which implied that the reduction gear was merely optional and that the motor was effectively coupled to the first pinion 20.

Therefore, the requirements of Article 76(1) EPC were met.

Reasons for the Decision

1. Admittance of an objection under Article 76(1) EPC
 - 1.1 In the statement setting out the grounds of appeal, the appellant raised an objection under Article 76(1) EPC against features M1.6 and M1.6a of claim 1 according to auxiliary request 5 having regard to the detailed embodiment of the two-stage gearing disclosed in the earlier application. In the respondent's view, this objection was raised for the first time on appeal and was therefore not to be admitted.
 - 1.2 It is clear from point 3.2 of the minutes of the oral proceedings held on 12 January 2022 before the opposition division that an extensive discussion took place in the context of the appellant's then main request (rejection of the opposition) on whether the amendments of features M1.6 and M1.8 extended the subject-matter of claim 1 as granted beyond the content

of the earlier application. In particular, the appellant argued that *"features [...] relating to the second pinion were impermissibly absent from the subject-matter of claim 1"*, it then discussed *"the dependency of the subject-matter of claim 7 on that of claim 6"*, and also alleged by citing the description of the earlier application that *"there was, in general, a clear and specific teaching in the originally filed documents of a specific group of features and that no generalisation of this teaching was suggested"*. Also the reference in point 3.3 of the minutes to the written arguments of the parties with regard to features M1.5 and M1.6 of claim 1 as granted confirms that the appellant maintained its position put forward in section C.I.2.a of the notice of opposition and repeated in section I.3 of its letter dated 11 November 2021 that the amendments related to the two-stage gearing were isolated from a group of features that were disclosed with a structural and functional link in the earlier application.

- 1.3 The fact that an exchange of arguments took place between the parties on the generalisation of the specific two-stage gearing arrangement contained in the earlier application also follows from the decision under appeal, in particular from the sentence bridging pages 8 and 9 in point 13 (*"the opponent alleged that there is, in general, a clear and specific teaching in the originally filed parent application of a specific group of features concerning in particular a two-stage gear-wheel assembly and that no generalisation of this teaching is suggested"*) and from the second sentence of point 14 on page 9 (*"the proprietor [...] sought to illustrate a basis for the isolation of the axial adjustment of the driving pinions of the respective toothed wheels of the numbering wheels from the two-*

stage gear-wheel assembly of figure 7"). As a matter of fact, the references to *"a specific group of features"* and *"figure 7"* in the above-mentioned sentences also indicate that the discussion was not merely confined to the absence in claim 1 as granted of a general *"two-stage gearing"* - this expression was later added in claim 1 of auxiliary requests 4 and 5 as part of feature M1.6a - but that it extended to the specific features of the two-stage gearing described and shown in combination in the earlier application.

- 1.4 It follows from the foregoing that the appellant's arguments brought in support of the ground for opposition under Article 100(c) EPC together with Article 76(1) EPC against the respondent's then main request must have persisted in the context of claim 1 of auxiliary request 5 in which, apart from the shaft 22, none of the other components of the two-stage gearing had been added. The statements in point 6.1 of the minutes (*"[t]he opponent had not objections with regards to [...] Article 100(c) EPC to the fifth auxiliary request"*) and in point 32 of the decision under appeal (*"[f]urthermore, he did not raise any objection with respect to [...] Article 76(1) EPC"*) must therefore be understood in the sense that no further objections under Article 76(1) EPC were raised against claim 1 of auxiliary request 5. As a consequence, the objection under Article 76(1) EPC raised in the statement setting out the grounds of appeal is therefore not considered to be new; it was already filed in the proceedings before the opposition division. It can therefore not be regarded as an amendment to the opponent's case in the sense of Article 12(4), first sentence, RPBA, which may be admitted only at the discretion of the board.

2. Auxiliary request 5 - compliance with Article 76(1) EPC

2.1 In point 33 of the decision under appeal, the opposition division held that the amendments to claim 1 of auxiliary request 5 "*clearly overcome the objections concerning Article 76(1) EPC*" for the reason that "[t]he staggered configuration of the driving pinions of the respective two-stage gear-wheel assembly defined in claim 1 of the auxiliary request 5 is explicitly mentioned in combination with all the other features on page 19, lines 3-12 of E3". Unlike the wording of claim 1 of auxiliary request 5, however, the passage of the earlier application cited by the opposition division explicitly refers to "*intermediate shafts*". It is evident from the illustration of the kinematic driving chain in Figure 7 of document E3 that the shafts of driving pinions 23 meshing with toothed wheels 16 illustrated also in Figures 5 and 6 are not just any shafts: they couple motors 15 to numbering wheels 7 through a first gear stage formed by driving pinions 20 and gear wheels 21 and through a second gear stage formed by driving pinions 23 and toothed wheels 16, see the second paragraph on page 13 and also claim 6 of the document E3. Also the variant of Figures 12 and 13 described on page 22, lines 3 to 6 of document E3 and the wording of claims 7 and 8 of document E3 foresee the adjustable arrangement of driving pinions 23* on *intermediate shafts* 22 of a two-stage gearing.

2.2 The question is then whether or not the term "*two-stage gearing*" in feature M1.6a already implies that the shafts 22 of the driving pinions 23 are intermediate shafts in the sense of the embodiments of the earlier application. The board is not convinced that this is the case. By leaving out the details of the first gear stage, the wording of claim 1 of auxiliary request 5

covers the possibility that the two-stage gearing has a first gear stage of the planetary type yielding a coaxial arrangement of electric motor 15 and driving pinion 23, 23*. Such a gear-wheel assembly is not disclosed in the earlier application. In fact, it clearly goes against the disclosure of the figures and their description, which foresee a first driving pinion 20 coupled to the motor (through an optional reduction gear) in mesh with a gear wheel 21 mounted on the intermediate shaft of second drive pinion 23, 23*.

- 2.3 The appellant's further objections under Article 76(1) EPC are not persuasive. Throughout the earlier application as filed, the arrangement of output shaft 19 of electric motor 15, first pinion 20, gear wheel 21, intermediate shaft 22 and second drive pinion 23 is referred to as "*gear-wheel assembly 19-23*". In contrast, the term "*gearing*" is consistently used to encompass both the gear-wheel assembly and toothed wheel 16 of the associated numbering wheel (see, for example, page 14, lines 10 to 21 of document E3). The corresponding use of this terminology in claim 1 of auxiliary request 5 does therefore not result in a shift in meaning.

Also the argument in connection with the deletion of the passage on page 6, lines 4 to 10 of the earlier application is not persuasive. Unlike what is argued by the appellant, the deleted passage was not essential for understanding under which circumstances the electro-mechanical actuation means is disposed entirely inside the numbering device. It merely concerned an assessment of the state of the art. The opposition division was correct in its assessment that the description of the divisional application, on which the patent is based, contains "*a clear indication for*

interpreting the arrangement of the driving means with respect to the casing" (see point 21 of the decision under appeal).

- 2.4 In view of the considerations of points 2.1 and 2.2 above, the board concludes that the subject-matter of claim 1 of auxiliary request 5 extends beyond the content of the earlier application as filed, so that the requirements of Article 76(1) EPC are not fulfilled. Auxiliary request 5 is therefore not allowable.
3. Auxiliary request 6 - compliance with Article 76(1) EPC
- 3.1 In the respondent's auxiliary request 6, claim 1 has further been amended by the addition of features concerning the two-stage gearing arrangement. Feature M1.6' now requires that the driving pinion 23, 23* is mounted on an *intermediate* shaft which carries a gear wheel meshing with a first pinion, i.e. the first gear stage, coupled to the electric motor. Also the staggered and adjustable arrangement of the driving pinions according to features M1.8a' and M1.8' now specifies that the shaft is an intermediate shaft.
- 3.2 The amendments have a clear basis in the earlier application, both in the description on pages 13 and 19, and in claims 6 to 8 of document E3. The appellant is correct that a planetary gearbox is not excluded from the claim wording. It is even expressly foreseen by the earlier application, in the form of a reduction gear (see page 15, line 15 of document E3). However, reduction gear 18 and also output shaft 19 are only disclosed as optional components in combination with the two-stage gearing. This not only follows from page 13, lines 26 to 27 of document E3, it is also evident

from page 8, lines 8 to 11 ("*preferably coupled*") and page 14, lines 4 to 9 ("*the optional reduction gear*"), both of document E3. Furthermore, claim 6 of the earlier application discloses that the first pinion is "*coupled to the electric motor*", similarly to the wording of feature M1.6a'. An output shaft is not mentioned in claim 6 of the earlier application. And the dependency of claim 6 either on claim 4 or on claim 5 again demonstrates that the reduction gear is merely optional in the context of the two-stage gearing.

3.3 For the above reasons, the board is satisfied that the requirements of Article 76(1) EPC are met in respect of claim 1 of auxiliary request 6.

3.4 No further objections were raised by the appellant against the claims of auxiliary request 6 or against the description and the drawings of the patent specification as amended in the context of auxiliary request 5 during the oral proceedings before the opposition division. Since the board finds no reasons to raise any such objections itself, auxiliary request 6 and the amended description and drawings of the patent specification are considered to be allowable.

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 on the basis of the following documents:
 - claims 1 to 10, filed as auxiliary request 6 with the reply to the statement setting out the grounds of appeal;
 - description, paragraphs
 - 1-27, 29, 32-43, 45-89 of the patent specification,
 - 28, 30, 31, 44 as filed during the oral proceedings before the opposition division on 12 January 2022;
 - drawings, sheets 1/22-22/22 of the patent specification.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated