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Aktenzeichen: T 113/82
Case Number:
N° du recours :

ENTSCHEIDUNG / DECISION

vom / of / du 22 June 1983

Anmelder:
Applicant: International Business Machines Corporation
Demandeur :

Stichwort:
Headword: "Recording apparatus"
Référence :

EPÜ / EPC / CBE Articles 52(1), 56
"Inventive Step"

Leitsatz / Headnote / Sommaire

If, in order to proceed from the known art to the invention one needs to take a series of steps and the last step is not proved to be known from the prior art nor is it derivable therefrom even though it appears at first sight to be a very simple one, the presence of an inventive step cannot in general reasonably be denied.

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number: T 113 / 82

DECISION
of the Technical Board of Appeal 3.2.1
of 22 June 1983

Appellant: International Business Machines Corporation
Armonk, N.Y. 10504 (US)

Representative: Lewis, Alan J.
IBM United Kingdom Patent Operations
Hursley Park
Winchester, Hants, SO21 2JN (GB)

Decision under appeal: Decision of Examining Division 086 of the European Patent
Office dated 31 March 1982 refusing European patent
application No 79 102 637.0 pursuant to Article 97(1)
EPC

Composition of the Board:

Chairman: G. Andersson

Member: M. Huttner

Member: P. Ford

Summary of Facts and Submissions

- I European patent application No. 79 102 637.0 filed on 25 July 1979 and published on 5 March 1980 under No. 0 008 378, claiming priority from a prior application in the United States of America of 28 August 1978, was refused by decision of Examining Division 086 of the European Patent Office dated 31 March 1982. The decision was based on Claims 1 to 3 received on 6 June 1981, with the amendments as set forth in the appellants' letter submitted on 23 November 1981.
- II In the decision the Examining Division held that the subject-matter of the current Claim 1 did not involve an inventive step. In support of the decision it cited the documents DE-U-1 910 543 and DE-B-1 786 498 and pointed out that the features of the preamble of Claim 1 are known from DE-U-1 910 543 and that those of the characterising portion do not involve an inventive step, again by reference to DE-U-1 910 543 and DE-B-1 786 498.
- III On 25 May 1982 the appellants lodged an appeal against that decision with payment of the appeal fee and the Statement of Grounds filed in due time. The appellants adhere to the claims on which the refusal was based and are of the opinion that the subject-matter of Claim 1 is not obvious from the publications cited. They also state that they would be prepared, if need be, to introduce the features of Claim 3 into Claim 1 or to amend Claim 1 so as to include the location of the key board.

- IV By a communication pursuant to Article 110(2) EPC dated 19 January 1983, the appellants were advised that the claims, the description and the drawings contained a number of deficiencies.
- V In reply to the communication, the appellants submitted amendments to be effected in the description in manuscript, new pages 2, 3, 4 and 5 of the description together with new Claims 1 to 3.

Claim 1 now reads as follows:

1. Operator controlled recording apparatus for recording matter on a discrete document entered into the apparatus by the operator and comprising a document transport path along which the document is transported to a recording station, said transport path comprising document-receiving-and-guiding surfaces including an initial, externally accessible, entry, substantially horizontal, flat surface (30a) on which the operator can position a document to be entered, followed by a contiguous upwardly directed, curved surface (30c) within the apparatus casing which subtends an angle of substantially 90 degrees and changes the direction of movement of an entered document from a generally horizontal direction to a generally vertical direction, and a contiguous substantially vertical surface, characterised in that the apparatus comprises a single set of drawing-and-delivery rolls (40, 42) for drawing the document through the recording station (20, 24) and for delivering the document out of the apparatus, said rolls (20, 24) being located within the apparatus casing above the recording station (20, 24) so as to engage the leading end of the document, after that end has been pushed by the operator

.../...

through the recording station, to pull the trailing portion of the document through the recording station (20, 24) and to deliver the document out of the top of the apparatus casing so that it is readily accessible to the operator.

VI The appellants requested that the impugned decision be set aside and the European patent be granted on the basis of the amended description and drawings and the presently effective Claims 1 to 3.

VII In case the Board of Appeal's intention, upon consideration of appellants submissions, were to uphold the Decision to Refuse, the appellants requested an oral proceeding prior to the Board's issue of its decision.

VIII For the original claims, description and drawings reference should be made to publication No. 008 378.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 EPC and Rule 64(a) EPC.

In the notice of appeal the appellant does not explicitly state the extent to which amendment or cancellation of the impugned decision is requested. However, it is clear from the circumstances of the case that the appellant is asking for cancellation of the decision.

Therefore, the appeal can be considered as complying with the provisions of Rule 64(b) EPC (cf. decision of Technical Board of Appeal 3.3.1 of 14 December 1982, in Case No. T 07/81: Official Journal EPO 3/1983, 98).

2. The features of the first part of the Claim 1 are, in combination, part of the prior art as represented by DE-B-1 786 498 (Rule 29(1)(a) EPC). In the Board's view, no objection may be raised against the preamble of Claim 1 acknowledging an operator-controlled recording apparatus disclosed in the publication referred to as the most pertinent prior art, for such apparatus is undoubtedly closer to the subject-matter of the application in respect of the salient features than that disclosed in DE-U-1 910 543.

Likewise, the Board has no objection to the appellants' amendment of the characterising clause so as to eliminate the horizontal exit slot in the apparatus casing, which feature, previously in the second part of the Claim 1, was not supported by the description. Nor is there any objection to the claim specifying pulling the trailing portion of the document through the recording station so as to deliver it out of the top of the apparatus casing, because this latter feature finds its support on page 8, lines 6 to 10 of the description as filed.

Thus, the subject-matter of Claim 1 is sufficiently supported by the description and it does not extend beyond the content of the application as originally filed. The amendments are, therefore, allowable under the terms of Articles 84 and 123(2) EPC.

3. According to the characterising portion, the subject-matter of Claim 1 differs from DE-B-1 786 498 by a number of features, which may be summarised broadly as: a single set of drawing-and-delivery rolls located above the printing station and within the apparatus casing for

drawing the document through the recording station and for delivering it out of the apparatus, said set engaging the leading end of the document upon being pushed through the recording station by the operator, thereby pulling the trailing end through said station delivering the document out of the top of the apparatus.

Due to the fact that of the other citations uncovered by the search report none discloses a single set of drawing-and-delivery rolls, the subject-matter of Claim 1 proves to be novel (Article 54 EPC).

4. In the apparatus known from DE-B-1 786 498, an interrelated operation under programme control of three different feed mechanisms is required, whereby the programme causes a clutched feed mechanism to initiate feeding movement of a selected card to the first reversible tractor feed mechanism which passes the card to the second reversible tractor feed mechanism, which in turn advances it to the recording station while maintaining a grip on the trailing end of the card so that it can be withdrawn when the mechanism is reversed, while the leading end of the card projects as a free standing entity into the recording station. Thus, from the operator's point of view, it is difficult to retrieve the cards individually from the exit pocket and, from the constructional aspect, the apparatus is mechanically complicated. The appellants consider these facts as disadvantages.
5. Thus, according to the appellants, the technical problem to be solved by the invention resides in the provision of an operator controlled recording apparatus which is not mechanically complicated and in which the document

feed mechanism operates in one direction only in order to simplify the control mechanism.

6. The solution of this problem underlying the application is based on the idea of locating the single set of drawing-and-delivery rolls beyond the recording station and requiring the operator to push the document through the recording station into engagement with said rolls, then delivering the document so that the leading end projects beyond the apparatus casing in order to allow the operator to read the recorded matter.

7. It remains to be examined whether the subject-matter of Claim 1 involves an inventive step and the question now arises whether the publications cited would give the skilled person any indication as to how in the apparatus according to DE-B-1 786 498, the mechanism could be modified so as to arrive at the subject-matter claimed in Claim 1.
 - 7.1 The publication DE-U-1 910 543 shows an operator controlled recording apparatus (a typewriter) with a downwardly orientated throat formed by two tapering surfaces leading to the nip of a first pair of rolls by which the paper is inserted and moved beyond the printer and a second, temporarily spaced-apart pair of rolls, which thus play no part in feeding the paper. During the subsequent printing operation, the latter rolls become engaged so as to form a nip and are driven at a somewhat higher circumferential speed than the first pair of rolls in order to keep the paper taut at the printing station. In addition, each pair of rolls is so arranged as to keep the paper taut in the printing direction and to prevent any oblique movement while it is being ad-

vanced. Hence, the two pairs of rolls serve as essential elements for keeping the paper constantly taut at the printing station, in the longitudinal as well as in the transverse direction. Notwithstanding the fact that the second pair of rolls delivers the sheet of paper only upon termination of the printing action and after the paper has left the first pair of rolls, it is virtually impossible that a person skilled in the art could derive from the disclosed function of this second pair of rolls any hint whatsoever leading him to the idea of omitting the first pair of rolls located below the printing station. From this, it must be inferred that in view of DE-U-1 910 543, the employment of one single set of drawing-and-delivery rolls for drawing the document through the recording station and delivering it out of the apparatus is not to be considered as obvious to a person skilled in the art.

- 7.2 Furthermore, applying the teachings of the DE-U-1 910 543 to such apparatus would simply not be reasonable to a man skilled in the art, since the apparatus described in DE-B-1 786 498 is intended for processing stiff cards, there is no need for a clamping action of the leading and trailing ends of the cards in order to keep them taut in the printing station. Even if this were considered as a reasonable step, it would still not lead to the subject-matter claimed in Claim 1, because the decisive step of simplification to the extent of using one single set of rolls above the printing station only and eliminating that positioned ahead of the printing station, would still be lacking. Hence, in order to proceed from the known art to the invention one actually needs to take a series of steps which may be considered as a significant indicator of the presence of inventiveness particularly in a case where the last decisive step

has neither been proved to be known from the prior art nor is derivable therefrom, although this last step may at first sight seem to be a very simple one.

7.3 The Board's view, therefore, is that the claimed invention does not follow logically from the known art considered above, and it leads it to the conclusion that the subject-matter of claim 1 would not be obvious from either citation taken singly or combined and hence the required inventive step is not lacking (Article 56 EPC).

Claim 1 is thus allowable in accordance with Article 52(1) EPC.

8. With respect to the dependent claims 2 and 3, neither is open to objection on formal grounds and their subject-matter includes special embodiments of the invention defined in Claim 1 and are therefore likewise acceptable.

9. There can be no objection to the amendment of the present description in its introductory portion to sufficiently acknowledge the closest prior art. Other parts have been corrected as requested by the Board.

10. No application has been made for reimbursement of the appeal fee in accordance with Rule 67 EPC and the circumstances of the case cannot be considered to justify such a reimbursement.

For these reasons,

it is decided that:

1. The decision of Examining Division 086 dated 31 March 1982 is set aside.

2. The case is remitted to the first instance with the order to grant a European Patent on the basis of the following documents:

- description pages 2, 3, 4 and 5 received on 12 March 1983, page 1 as filed and original pages 4 to 8 renumbered as pages 6 to 10, each amended as set forth by appellants' letter of 7 March 1983 received on 12 March 1983;
- Claims 1 to 3 received on 12 March 1983;
- 3 sheets of drawings 1/3, 2/3 and 3/3 as filed.

The Registrar:

J. Rbe

The Chairman:

