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Aktenzeichen / Case Number / N^o du recours : T 257/85
Anmeldenummer / Filing No / N^o de la demande : 80 303 877.7
Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 028 165

Bezeichnung der Erfindung:
Title of invention: An electrostatographic reproduction system
Titre de l'invention :

Klassifikation / Classification / Classement : G 03 G 15/00, B 65 H 37/04

ENTSCHEIDUNG / DECISION

vom / of / du 8 December 1986

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet : Xerox Corporation

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Articles 52, 56

Kennwort / Keyword / Mot clé : "Inventive step"

Leitsatz / Headnote / Sommaire



Case Number : T 257 /85

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 8 December 1986

Appellant : Xerox Corporation
Xerox Square - 020
Rochester New York 14644 (US)

Representative : Rank Xerox Limited
Mr. K.B. Weatherold
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Decision under appeal : Decision of Examining Division 044 of the European Patent Office dated 29 May 1985 refusing European patent application No. 80 303 877.7 pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : K. Lederer
Member : E. Turrini
Member : R. Schulte

Summary of Facts and Submissions

- I. European patent application No. 80 303 877.7 filed on 30 October 1980 (publication number 0 028 165) and claiming priority from a prior application of 30 October 1979 (US 89 336) was refused by decision of the Examining Division 044 of the European Patent Office dated 29 May 1985.
- II. This decision was based on Claims 1 to 3 filed on 15 October 1984. For more details reference is made to the application file.
- III. The reason given for the refusal was that the subject-matter of Claim 1 did not involve an inventive step having regard to the disclosure in US-A-3 709 595 and US-A-3 884 408 and to the common knowledge of a person skilled in the art.
- IV. On 22 July 1985 an appeal was lodged against the decision together with the appeal fee. The statement setting out the Grounds of appeal were received in due time.
- V. The Appellant requested that the impugned decision be cancelled in its entirety and a patent granted on the basis of the claims on which the refusal was based.

The Appellant argued that the refusal decision was based on an ex post facto analysis because the solution proposed in US-A-3 884 408 is in connection with a different problem to that of the present invention and that there are more than two remedies to the disadvantage of travelling sheets hitting a fixed stapler.

Claim 1 received on 15 October 1984 reads as follows:

1. An electrostatographic reproduction system, including a processor (11) for processing copy sheets; a compiler (82) to which the completed copy sheets are delivered horizontally and compiled into vertically-stacked sets, and apparatus (84) for securing each set of copy sheets together, characterised by
the securing apparatus having a fixed vertical pivotal axis (196) outside the path of the sheets, and being pivotable between an inoperative position outside the path of the sheets and an operative position in which it can attach a fixing element (195) to a corner of the compiled set, and means for driving the securing apparatus from its inoperative position to its operative one, and actuating it there to secure the set together before driving it back to its inoperative position when a complete set has been compiled and secured.

Claims 2 and 3 are dependent on Claim 1.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. There is no objection to the current version of the claims, description and drawings as far as Article 123(2) EPC is concerned, since it is adequately supported by the original disclosure. In particular,

- although the feature "a document handling apparatus (40) for advancing document sheets to an exposure station (14)" (see originally filed Claim 1 and page 1 of the description) is not any more present in current Claim 1, the original disclosure (see Figures 12 and 13 and description

starting at the foot of page 19) shows that the handling apparatus (40) is excluded in certain circumstances, e.g. where the reproduction system has to copy a bound document;

- as far as Claim 2 is concerned, although it is drafted in more general terms than the corresponding Claim 5 of the original disclosure, it is clearly supported by the description as originally filed, page 8, second paragraph, where the stapler is merely mentioned in general terms.

3. The subject-matter of Claim 1 is new.

3.1 Document US-A-3 709 595 (Figures 1, 3, 8 and 9 and the corresponding description) discloses an electrostatographic reproduction system which includes the features of the preamble of Claim 1 (processor 11; tray assembly, i.e. compiler, 70; stapler group, i.e. apparatus for securing, 74). According to this document the apparatus for securing is always in an operative position and not pivotable.

3.2 The electrostatographic reproduction system described in US-A-3 884 408 (Figures 5 and 10; column 5, line 61 to column 7, line 22) comprises a processor 11, a compiler 32 and an apparatus 71 for securing each set of sheets. The securing apparatus has a fixed pivotal axis and is pivotable between an inoperative and an operative positions. Also means for driving the securing means are provided (see mechanism 79'). In contrast to the subject-matter of Claim 1, the compiler has bins 57 to which the sheets are delivered vertically, a set of sheets being compiled in each bin, and the pivotable securing means is mounted about a horizontal axis and is displaceable along the horizontal axis so as to permit

it to be indexed from one bin to the next, passing from one operative condition to the next (see stapling apparatus 71).

3.3 The other cited documents of the prior art are not relevant with respect to the present invention.

4. The subject-matter of Claim 1 is considered to involve an inventive step within the meaning of Article 56 EPC.

4.1 Claim 1 is based on US-A-3 709 595, which is in the Board's opinion the nearest prior art. Starting from the disclosure of this document, the problem to be solved is to avoid or at least reduce sheet jams at the securing means due to the travelling sheets hitting the securing means.

Said problem is solved by rendering the securing means movable as set out in the characterising portion of Claim 1.

4.2 The identification of the problem is per se not inventive, since a man skilled in the art would recognise that the securing means positioned on the path of the sheets disclosed in US-A-3 709 595, could lead to sheet jams.

4.3 As far as the solution to this problem is concerned, the skilled man would look at prior art systems including a sheet compiler and securing means and he would indeed consider US-A-3 884 408. However, he would not recognise that the therein described securing means together with the corresponding driving means could be introduced after modification, i.e. vertically positioning the horizontal pivotal axis, in the system according to US-

A-3 709 595 in place of the fixed securing means in order to solve the posed problem (obtaining in this way the subject-matter of Claim 1), since the pivotal movement of the securing means in US-A-3 884 408 is addressed to solve a totally different problem, namely that of permitting the securing means to be shifted along the horizontal axis from one bin to the next without hitting the wall separating them.

4.4 The other cited document of the prior art are not relevant in judging the inventive step.

4.5 In the decision of refusal the Examining Division argued that once known the problem of jamming at the securing means "only two remedies to this disadvantage" are available, namely choose a securing means "having a head and anvil spaced apart by a bigger distance" or move the securing means "out of the path of the moving sheets", this last remedy allowing two options, i.e. pivotal or linear movement, and that it would lie "within the competence of a person skilled in the art to choose one of the above remedies". The Board of Appeal agrees with the Appellant that there are other possible remedies, e.g. solutions in which the securing means remains fixed while the stack of sheets is in some way movable. In other words, the skilled man would have a plurality of alternatives which *prima facie* seem to be equivalent. However, they can have quite different effects in connection with the requirements of an electrostatographic reproduction system as the reduced bulk of the machine, the high speed by which the sheets are driven, etc. The choice of one among the plurality of alternatives is therefore not considered obvious by the Board of Appeal.

- 4.6 Since the subject-matter of Claim 1 is novel and involving an inventive step, Claim 1 is allowable under Article 52 (1) EPC.
5. Claims 2 and 3 correspond to particular embodiments of the invention. They are therefore allowable as dependent claims in agreement with Rule 29 (3) EPC.

Order

For these reasons,

it is decided that:

1. The decision of the Examining Division dated 29 May 1985 is set aside.
2. The case is submitted to the first instance with the order to grant a European patent on the basis of the following documents:
 1. Description :

pages 3 to 6, 8, 10 to 12 and 20 to 23 of the original application;
pages 7, 9, 13 to 19 received on 18 February 1983;
page 2 received on 12 August 1983;
page 1 received on 15 October 1984 with the following amendment:
the expression "In a preferred form a stapling head ..."
reads "In a preferred form the securing apparatus is a stapler. A stapling head ...".
 2. Claims 1 to 3 received on 15 October 1984 with the following amendment: in Claims 1 and 2, the expression "securing means" reads "securing apparatus".
 3. Drawings, Figures 1 to 15 of the original application.

The Registrar:

J. Ruckerl

03091

The Chairman:

K. Lederer