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Aktenzeichen / Case Number / N° du recours : T 566/88 - 3.2.1

Anmeldenummer / Filing No / N° de la demande : 84 103 579.3

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Bezeichnung der Erfindung: Hand-held labeler

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : B65C 11/02

**ENTSCHEIDUNG / DECISION**

vom / of / du 17 January 1990

Anmelder / Applicant / Demandeur : Monarch Marking Systems

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 56

Schlagwort / Keyword / Mot clé : "Inventive step (yes)"

**Leitsatz / Headnote / Sommaire**

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : T 566/88 - 3.2.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.1  
of 17 January 1990

**Appellant :** Monarch Marking Systems Inc.  
P.O. Box 608  
Dayton Ohio 45401 (US)

**Representative :** Patentanwälte  
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**Decision under appeal :** Decision of Examining Division 080  
of the European Patent Office  
dated 29 June 1988 refusing  
European patent application  
No. 84 103 579.3 pursuant to  
Article 97(1) EPC

**Composition of the Board :**

**Chairman :** F. Gumbel  
**Members :** F. Brösamle  
F. Benussi

## Summary of Facts and Submissions

- I. European patent application No. 84 103 579.3 filed on 25 May 1982, and published under publication No. 0 137 892 is a divisional application of the earlier application No. 82 104 562.2 published under No. 0 066 777 and was refused by decision of 29 June 1988. That decision was based on Claim 1 filed with letter of 29 January 1988 and Claims 2 to 6 filed with letter of 22 December 1986.

The reason given for the refusal was that particularly in the light of the prior art documents

- (D1) EP-A-657
- (D2) US-A-3 957 562

the subject-matter of Claim 1 did not involve an inventive step within the meaning of Article 56 EPC and that Claims 2 to 6 add nothing of inventive significance to the subject-matter of Claim 1.

Further documents discussed in this decision are:

- (D3) DE-A-2 816 161
- (D4) DE-A-2 253 565
- (D5) JP-A-62-28331
- (D6) a brochure entitled "The New Dimension in Labeling METO MULTICODER 3000"

- II. On 5 August 1988 a notice of appeal was filed and the appeal fee was paid at the same time. The Statement of Grounds of Appeal was filed on 28 October 1988.

In this Statement the Appellant argued that D3 is the nearest prior art document and not D1 and that the

labeller according to D3 is "hammerlike", i.e. the labeller has a linear layout, which leads to a labeller seriously out of balance and to a point of application of the labels far away from the user's hand. Due to the exit of the carrier web in front of the handle of the labeller disclosed in D3 the carrier web interferes with the article to be labelled and the visibility of the label application is obstructed. D3 in the Appellant's view is therefore seriously deficient. It is furthermore argued that the labeller according to D1 also suffers from the above disadvantages. With this prior art, the battery is not contained in the handle and the handle does not depend downwardly of the labeller; the exit for the carrier web is in front of the handle.

Referring to the non prior art labellers according to D5, D6 and D7 ("Sato" reference M-3600) the Appellant intended to demonstrate that skilled persons, confronted with the problem of devising a commercially acceptable thermal hand-held labeller, were taught away from Appellant's labeller according to Claim 1 underlying the impugned decision. The labellers according to D2 and D4 were felt to be manually activated labellers ("dumb labellers") which are not so favourable in use as thermal labellers; the Appellant sees no reason for incorporating a battery power supply in such a type of labeller and in particular not in its handle. The conclusion of the Examining Division that a combination of documents D1 and D2 would immediately lead to the subject-matter of Claim 1 was strongly contested.

III. In its communication dated 16 October 1989 the Board raised objections under Article 123(2) and also under Article 56 EPC by further pointing to the documents

- (D8) GB-A-1 360 504, and
- (D9) GB-A-1 360 505.

IV. In reply to the above-mentioned communication of the Board the Appellant, with letter dated 29 December 1989, filed three versions of Claim 1 and brought forward reasons why in his opinion the subject-matter of any of these Claims 1 is inventive.

In this context, additional non prior art documents were cited, namely

- (D10) DE-A-3 705 950
- (D11) "SAGAWA NETWORK" brochure
- (D12) JP-A-61-205 155,

in order to demonstrate that subsequent to the priority date of the present application the skilled persons were taught away from the subject-matter of Claim 1. As a consequence the Appellant maintains that the claimed labeller is inventive over the prior art.

V. In the oral proceedings held on 17 January 1990 the Appellant filed new Claims 1 and 2, whereby in the preamble of Claim 1 it was made clear that the rechargeable battery powers the drive motor and the print head.

In order to overcome an objection of the Board raised under Article 123(2) EPC, the Appellant modified Claim 1 in its characterising clause so that Claim 1 now reads as follows:

"1. A hand-held labelling machine comprising: a housing (21) having a front portion, a rear portion and a manually engageable handle (26), the housing having means for holding a label supply roll (R) having labels (L)

releasably adhered to a carrier web (W), means (49,52,53) within the housing for defining a pathway for the carrier web, wherein the housing (21) has an exit opening (54) for the carrier web, means for printing on a label at a printing position, means (51) for peeling the printed label from the carrier web, label applying means (25) disposed adjacent the peeling means, means (44) driven by an electric motor (35) for advancing the carrier web to peel a printed label from the carrier web at the peeling means and for advancing the printed label into label applying relationship with the label applying means and for advancing another label into the printing position, means including a keyboard (27) mounted on the housing for entering selected data to be printed, the printing means including a thermographic printing head (36) having a plurality of individually selectable printing elements (36') arranged in a single line array disposed substantially transverse to the direction of advancement of the carrier web for printing on a label at the printing position, the motor (35) and the head (36) being powered by a rechargeable battery, means (202) coupled to the keyboard for receiving and electrically processing data representative of the selected data entered by the keyboard, means (208) electrically coupling the data receiving and processing means and the thermographic printing head, and means (37,210) for causing the data receiving and processing means to operate the thermographic printing head to print the selected data on the label, characterised in that the handle is provided by the outer shell of the rechargeable battery, wherein the handle (26) depends downwardly of the front and rear portions of the housing, and wherein the carrier web exit opening (54) is disposed at the rear portion of the housing so that the carrier web (W) exits behind the handle (26)."

This Claim 1 was further defended by the Appellant by demonstrating the historical development before and after the claimed priority in the technical field of hand-held labellers, wherein the linear layout in labellers with electrical drive and thermoprinters prevailed. A further design possibility was only disclosed in D5, where the labeller has more or less the form of a smoothing-iron. The characterising features of Claim 1 in the Appellant's contention made necessary a complete redesign of the nearest prior art labeller which is believed to be unobvious considering the available prior art in a real life approach, particularly if one takes into account that the problem underlying the present application apparently was not recognised in the prior art.

VI. The Appellant requests to set aside the impugned decision and to grant a patent on the following basis:

- Claims 1 and 2 and description submitted at the oral proceedings,
- Claims 3 to 6 filed on 22 December 1986.
- Figures 1 to 6 as originally filed
- Figure 12 as originally filed, renumbered Figure 7.

#### Reasons for the Decision

1. The appeal is admissible.
2. Claim 1 is no longer open to a formal objection under Article 123(2) EPC since the newly introduced features in the preamble remove the unsupported generalisations objected to in the Board's communication, and the amendments to the characterising clause render its subject-matter consistent with the original disclosure, see in particular page 5, lines 8/9 of the patent application.

Claim 1 also meets the requirements of Rule 29(1)(a) and (b) EPC, since it is correctly delimited over the nearest prior art document D1. Due to the rewording of the precharacterising clause of Claim 1 concerning the "control circuit" there can be no doubt that D1 is now the nearest prior art document.

3. The subject-matter of Claim 1 is novel in view of D1 to D4, D8 and D9, since none of these documents discloses a labeller comprising all the features specified in Claim 1. In particular, the feature that the handle is provided by the outer shell of the rechargeable battery is not present in any document. Novelty was not disputed by the Examining Division or the Board so that no further substantiation is necessary in this respect.
4. The examination of the subject-matter of Claim 1 in view of an inventive step leads to the following result:
  - 4.1 Starting from the nearest prior art labeller according to D1, the subject-matter of Claim 1 differs therefrom in that
    - (a) the handle is provided by the outer shell of the rechargeable battery
    - (b) the handle depends downwardly of the front and rear portions of the housing and
    - (c) the carrier web exit opening is disposed at the rear portion of the housing so that the carrier web exits behind the handle.
  - 4.2 In the original version of the parent application and of the divisional application no object to be solved is literally indicated. However, in both applications, see

page 2, lines 33-34 as originally filed, it is outlined that "The invention provides a convenient to use, compact arrangement for a hand-held labeller".

Moreover, right from the beginning, a prior art labeller according to D1 (corresponding to US-A-4 264 396 being mentioned on page 1, lines 6 to 11 of the description) was dealt with as starting point of the invention.

In respect of the D1 labeller, it was found by the Appellant that the arrangement of the battery apart from the handle may cause problems due to an imbalance of masses, that the carrier web exit opening next to the label exit location can cause problems, since the carrier web dangles in front of the handle and interferes with the application of labels; from D1 it can further be seen that the label applicator is located far away from the handle and that most of the labeller components such as the driving motor and the thermographic printer are situated away from the handle so as to generate a moment of rotation against the user's hand, which must be counteracted by the user and contributes to his fatigue.

4.3 Hence, for the purposes of assessment of inventive step the above cited sentence of originally filed page 2, lines 33-34 ("...convenient to use, compact arrangement...") has to be interpreted in the light of the above indicated deficiencies of the D1 labeller, thus arriving at the object of the invention as indicated in the valid description, page 2, paragraph 3.

4.4 The problems encountered in a labeller according to D1 are, to the Board's conviction, overcome by features (a) to (c) as listed above under 4.1. It can immediately be seen that the T-form of the housing has important advantages as far as the weight-balance is concerned,

and in addition to the provision of a T-form the heavy mass in the form of the battery is directly in contact with the user's hand, so that fatigue is mostly excluded. The provision of the carrier web exit opening at the rear of the labeller housing leads to a clear separation between the label application location and the location of carrier web removal. Thereby an easy application of labels is possible, since the visibility of the location of application is not negatively influenced by any carrier web.

- 4.5 The comparison with the prior art documents D1 to D4 and D8/D9 shows that feature (a) of the characterising clause of Claim 1 is completely new and not realised in any of the available prior art documents.

Moreover, the labellers according to D1, D3 and D4 do not disclose a handle depending downwardly from the housing of the labeller, but recommend a totally different overall design. The labellers known from D8/D9 disclose a T-form for the labeller housing, however, it is not disclosed that the battery is also provided in the handle. The Appellant has presented convincing evidence that there are labellers on the market with an external power supply, see also D7 and D11.

The labeller known from D8/D9 on the other hand suffers from the carrier web exit at the front side of the labeller, see reference sign "23" in Fig. 1 of D8/D9, and it has to be considered that this labeller does not make use of a thermoprinter. One of the power consumers is therefore not existent in the labeller of D8/D9 so that even if a battery would be used as a power supply the problem of weight distribution according to the present application was not as stringent as with the labeller according to Claim 1, where the battery not only powers

the drive motor, but also the thermoprinter and has consequently to be dimensioned accordingly. There is no direct lead from this prior art to the subject-matter of Claim 1.

The hand-held labeller according to D2 is a mechanical labeller in which no battery is used. For a skilled person it is obvious that the T-form of the housing of the labeller is primarily, if not solely, chosen for reasons of actuating the labeller. In combination with a mechanical labeller it is convenient to have a T-form housing, since the actuation of the lever "81" of D2 can be carried out by four fingers of the user's hand. This document does not teach to concentrate heavy masses in the handle as it is one basic idea underlying the labeller according to Claim 1, since in contrast to the known labeller according to D2 all heavy parts are concentrated outside the handle.

From these considerations, in the Board's view, it follows that the mechanical labeller according to D2 cannot be a source of disclosure for a skilled person confronted with the problem of improving the weight distribution of a labeller with a battery-supplied electric drive and with a thermoprinter according to D1.

Document D4 is again not suited to lead a skilled person to the labeller of Claim 1, since none of the characterising features of this claim is realised in D4. Again a linear layout is chosen in D4 and the carrier web exit is in front of the handle.

- 4.6 From the foregoing considerations it follows that there is no direct lead from the prior art labellers according to D1 to D4 and D8/D9 to the subject-matter of Claim 1, basically since feature (a) is completely missing in the

prior art constructions and since feature (b) is only known from D2 in a different context as compared with the present invention and without addressing the problem of avoiding fatigue during operation of the labeller. In these circumstances, it does, in the Board's view, not matter that feature (c) of Claim 1 certainly does not contribute to the existence of inventive activity, since this feature obviously lies within the normal skills of a practitioner, if he becomes aware of any difficulties concerning the exit location of the carrier web. This assessment is clearly supported by the prior art constructions, see for instance D2, Fig. 10 and D4, Fig. 1, which both disclose labellers, in which the carrier web exits on the opposite side of the labeller in view of the location of the label exit. Feature (c) of Claim 1 is thus basically known.

4.7 Summarising, the Board comes to the conclusion that despite the fact that D2 discloses features (b) and (c) of Claim 1 per se, there cannot be seen any probability that a skilled person being confronted with the object of the present invention set out above under 4.2 and 4.3, would consider these features solely known for the layout of a mechanical labeller and would combine them with feature (a) not described in any of the available documents, in order to achieve the subject-matter of Claim 1.

4.8 Consequently the subject-matter of Claim 1 is considered to be based on an inventive step in the light of the available prior art documents. This claim is thus allowable, under Article 56 EPC.

Dependent Claims 2 to 6 are likewise allowable in combination with Claim 1.

- 4.9 The Board came to the above conclusion solely by considering the prior art as reflected by D1 to D4 and D8/D9 so that the historical approach favoured by the Appellant and including non-prior-art documents was not needed to show the existence of an inventive step. Certainly, this approach would support the above positive judgment.
5. The amendments to the description and to the drawings take account of the prior art and the scope of the claims in their present form. By deleting those Figures and their corresponding text which relate to the control and printing system, a clear cut has been carried out between the subject-matter claimed in the parent application and that of the present divisional application, Rule 25(2) EPC.

Order

For these reasons, it is decided that:

1. The impugned decision is set aside.
2. The case is remitted to the first instance with the order to grant a patent on the basis of the following documents:

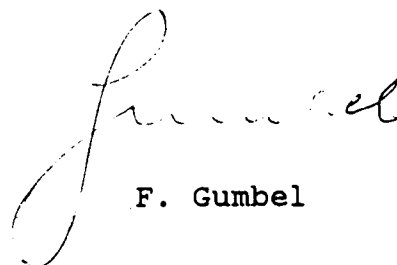
Claims 1 and 2 and description submitted at the oral  
proceedings,  
Claims 3 to 6 filed on 22 December 1986,  
Figures 1-6 as originally filed,  
Figure 12 as originally filed, renumbered Figure 7.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel

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