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**D E C I S I O N**  
**of 3 August 1995**

**Case Number:** T 0390/92 - 3.4.1

**Application Number:** 83730054.0

**Publication Number:** 0099324

**IPC:** G07D 7/00

**Language of the proceedings:** EN

**Title of invention:**

Note receptacle for currency validator

**Patentee:**

ARDAC, INC.

**Opponent:**

Mars, Incorporated

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 56

**Keyword:**

"Inventive step (no)"

"Disclosed technical problem identically solved in the closest prior art"

"Obvious constructional modifications"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0390/92 - 3.4.1

**D E C I S I O N**  
**of the Technical Board of Appeal 3.4.1**  
**of 3 August 1995**

**Appellant:**  
(Proprietor of the patent) ARDAC, INC.  
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**Representative:**  
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**Respondent:**  
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**Representative:**  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office dated 24 February 1992  
revoking European patent No. 0 099 324 pursuant to  
Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** H. J. Reich  
**Members:** G. Davies  
Y. J. F. van Henden

## Summary of Facts and Submissions

I. The appellant is the proprietor of European patent No. 0 099 324. Claim 1 as granted reads as follows:

"1. A note receptacle for a currency validator, comprising:

top (20; 50) and bottom (22; 52) plates having first end portions in spaced-apart, parallel relationship with each other, and defining a passageway (18; 48) therebetween; and characterized by:

side rails (32, 36; 54, 56) connected to said top and bottom plates along lateral edges thereof, said side rails defining plural widths of said passageway at second end portions of said top and bottom plates and a single width of said passageway at said first end portions of said top and bottom plates."

Granted Claims 2 to 10 are dependent on Claims 1.

II. The patent was revoked by a decision of the Opposition Division following opposition by the respondent on the ground that amended Claim 1 filed during the opposition proceedings on 18 April 1991 did not satisfy Article 123(3) EPC, mainly because it no longer contained the following feature of the granted Claim: "a single width of said passageway at first end portions of said top and bottom plates". Moreover, the Opposition Division took the view that the revocation of the patent would have been unavoidable, because document:

D6: Research Disclosure, October 1980, pages 402 to 407, cited in the notice of opposition, was prejudicial **inter alia** to the novelty of Claim 1 as granted.

III. The appellant (patentee) lodged an appeal against this decision. It requested that the decision of the opposition division be set aside and the patent maintained as granted. In the grounds of appeal the appellant made the following submissions:

- (a) The invention provides a single entrance for a note irrespective of the note's size. Document D6 simply teaches the provision of plural passageways of distinctly different widths, each passageway being totally separate and distinct from the other.
- (b) The top and bottom plates of the conventional receptacle disclosed in document D6 are not in spaced-apart **parallel** relationship but are tapered towards each other to direct the paper to a common area.
- (c) There is absolutely no teaching in document D6 of a passageway having a first end of a single width and a second end of plural widths. Each of the passageways of document D6 tapers from a first height at the entry to a second lesser height at the exit. Such structure is clearly not the same as a single width at one end and plural widths at the other.

IV. The respondent (opponent "Landis and Gyr Betriebs AG") replied to the grounds of appeal on 5 November 1992 and requested dismissal of the appeal. By facsimile received on 7 July 1993, the EPO was informed that the above particular division of "Landis and Gyr" which dealt with the field of banknote handling and validation, had been acquired by the company "Mars, Incorporated". As a consequence and with the agreement of Landis & Gyr, Mars, Incorporated should now be regarded as the opponent. On 1 December 1993, the EPO communicated the

change of opponent and his representative to the appellant (patentee). The new respondent supplemented the reply to the grounds of appeal on 22 June 1994, emphasising **inter alia** the relevance of the following document cited in the notice of opposition:

D3: US-A-4 301 361.

V. By letter filed 5 November 1992, the respondent requested the Board to charge the appellant with its costs connected with the appeal proceedings for reasons of equity. In the respondent's opinion, the appeal proceedings could have been avoided with regard to the actual ground for revocation (Article 123(3) EPC), if the appellant had defended his rights during the proceedings before the opposition division with due care.

VI. Both parties requested oral proceedings on an auxiliary basis. In a communication accompanying a summons to oral proceedings, the Board informed the parties of its provisional view that the subject-matter of granted Claim 1 might be found to lack an inventive step for the following reasons: the features which distinguish the subject-matter of Claim 1 as granted from the closest prior art disclosed in document **D6**, i.e. that

- (a) top and bottom plates having first end portions in "**parallel**" relationship with each other; and
- (b) said side rails defining "a **single width** of said passageway at said **first end** portions of said top and bottom plates",

appear not to contribute to the solution of the problem posed in the description, i.e. to facilitate proper positioning of a document. They are moreover known from Figures 1 and 2 of document D3 as conventional

constructive elements in a similar receptacle. The use of their known properties would be obvious to a skilled person.

VII. In reply to the above communication, the appellant in a letter dated 23 March 1995 maintained its request for maintenance of the patent as granted and withdrew its request for oral proceedings. Thereupon, the parties were informed that the oral proceedings due to take place on 29 March 1995 had been cancelled.

VIII. In a letter dated 24 March 1995, the **respondent** declared that it maintained its auxiliary request for oral proceedings in the event that the Board intended to issue a decision in any way adverse to the opponents.

#### **Reasons for the Decision**

1. The appeal is admissible.
2. *Inventive step - Claim 1*
- 2.1 The following wording of Claim 1 is known from the closest prior art according to document D6:

"A note receptacle ... comprising top (see D6, 70 in Figure 2) and bottom plates (28a in Figure 2) having first (i.e. output) end portions in a spaced apart ... relationship with each other and defining a passageway therebetween (page 405, left column, lines 9 to 12); characterised by: side rails (82a, 82b, 82c, 84a, 84b, 84c in Figure 4) connected to said top and bottom plates

along lateral edges thereof, said side rails defining plural widths of said passageway at second (i.e. input) end portions of said top and bottom plates (page 405, left column, lines 14 to 19)."

The appellant's opinion that the conventional passageways of plural widths are totally separate and distinct from each other (see paragraph III above) is not shared by the Board. The conventional passageways are formed by slots 72, 74 and 76 in Figure 4 and 1 of documents D6. These all communicate with one and the same output passageway (132 in Figure 2) and are thus functionally interrelated. Moreover, rails 82a, b, c and 84a, b, c, integrate passageways 72, 74 and 76 into a constructional unit. The appellant's argument that the height of the conventional passageways is tapered towards the first end portion (output) of the receptacle is accepted. However - contrary to the Appellant's opinion in paragraph III- (c) above - the tapered height does not influence the fact that the conventional passageways at second end portions (input) have rails which define clearly the plural different **widths** of the passageways (see document D6, page 405, left column lines 13 to 23) such as claimed in Claim 1. Document D6 leaves open, whether bottom plate 28 and top plate 70 are provided with rails within the first end portion (output) beginning at output passageway 132. The Board has interpreted this unclear disclosure in favour of the appellant in that the sides of the conventional output passageway are open and took such interpretation into account in establishing the existence of distinguishing feature (b) mentioned in paragraph VI above.

- 2.2 The technical aim disclosed in the patent in suit, column 1, line 60 to column 2, line 14 - ie to avoid misalignment and thereby incorrect registration of wide and narrow notes - is already achieved by the

conventional note receptacle disclosed in document D6; see D6, page 405, left column, lines 24 and 25 reading: "the provision of slots of various widths facilitates proper positioning of a document sheet on the platen" (see 12 in Figures 4 and 1). In the Board's view, a skilled person is able to derive from this text that the teaching of document D6 corresponds technically to the "aspect of the invention" in the patent in suit, column 2, lines 23 to 32, ie to avoid misalignment by providing a plurality of tracks of different width which feed a single slot. A skilled person in the Board's view would realise that platen 12 and its registration line 14 in Figure 4 which belong to the transport mechanism 24 in Figure 1 of document D6, are comparable equivalents to the generally-known slot of an acceptor of a currency validator. A skilled person would thus easily realise that the conventional receptacle disclosed in document D6 is suited "for a currency validator" as claimed in Claim 1. Consequently, the above-stated essential main technical aim of the patent in suit is disclosed and solved identically in the closest prior art and therefore cannot form part of the objective problem and its solution by virtue of the features which distinguish the subject-matter of Claim 1 from this closest prior art. For this reason, the above-stated aspect of the invention cannot be taken into consideration when examining inventive step.

2.3 The features which distinguish the subject-matter of Claim 1 from the closest prior art according to document D6 are known **per se** from document D3 in a similar receptacle, ie

- (a) top and bottom plates having first end portions in "parallel" relationship with each other; see top and bottom plates. 14, 14a and 16, 16a in Figure 2 of document D3; and

- (b) said rails define "a single width of said passageway at said first end portions of said top and bottom plates; see rails 18, 18a and 20, 20a in Figure 1 of document D3.
- 2.4 The description of the patent in suit does not reveal to the skilled reader any particular effect produced by distinguishing features (a) and (b). A skilled person may find the use of feature (a) desirable in view of the outer geometrical shape of the receptacle. Furthermore, a skilled person may wish to prolong the lateral guidance of the largest note in the passageway of maximum width by feature (b). Such properties of the conventional elements defined by features (a) and (b) are easily recognisable in document D3. Making an analogous use of such known properties of the constructional elements (a) and (b) disclosed in document D3 in the conventional receptacle disclosed in document D6 is regarded as an obvious constructional modification of the closest prior art which remains within the routine capacities of a skilled person.
- 2.5 For the reasons set out in paragraphs 2.1 to 2.4 above, in the Board's judgement, Claim 1 lacks an inventive step within the meaning of Article 56 EPC.
3. Claims 2 to 10 fall because of their dependency on Claim 1.

Under these circumstances, there is no need to give effect to the respondent's auxiliary request for oral proceedings.

4. In the appeal proceedings, the appellant has no longer maintained Claim 1 as amended on 18 April 1991 which claim was held to be contradictory to Article 123(3) EPC by the first instance. He requested that the appealed

decision be set aside on the basis of granted Claim 1; see paragraph III above. Hence, contrary to the respondent's submission in paragraph V above, in the appeal proceedings the actual ground for revocation by the first instance had already been removed. The appellant was clearly adversely affected by the statement of the first instance that Claim 1 as granted was not novel and that revocation was unavoidable. In appealing such a decision the Board sees neither a lack of due care nor a procedural abuse.

For these reasons, the respondent's request that the appellant be ordered to pay the costs incurred by the respondent in the appeal proceedings is rejected.

#### **Order**

#### **For these reasons it is decided that:**

1. The appeal is dismissed.
2. The Respondent's request for an award of costs is rejected.

The Registrar:

The Chairman:

M. Beer

H. J. Reich