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D E C I S I O N
of 23 April 1999

Case Number: T 0371/97 - 3.2.5

Application Number: 90118149.5

Publication Number: 0418903

IPC: B41F 13/02

Language of the proceedings: EN

Title of invention:

Paper web threading apparatus for rotary printing press

Patentee:

Kabushiki Kaisha Tokyo Kikai Seisakusho

Opponent:

Koenig & Bauer - Albert AG

Headword:

-

Relevant legal provisions:

EPC Art. 122(2), (3)

Keyword:

"Extension beyond the originally filed application (no)"
"Remittal to the first instance (no)"

Decisions cited:

-

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0371/97 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 23 April 1999

Appellant: Koenig & Bauer - Albert AG
(Opponent) Postfach 6060
97010 Würzburg (DE)

Representative: -

Respondent: Kabushiki Kaisha Tokyo Kikai Seisakusho
(Proprietor of the patent) 26-24, Shiba 5-chome
Minato-ku
Tokyo (JP)

Representative: Ter Meer Steinmeister & Partner GbR
Mauerkirchernstrasse 45
81679 München (DE)

Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 29 January
1997 concerning maintenance of European patent
No. 0 418 903 in amended form.

Composition of the Board:

Chairman: H. P. Ostertag
Members: C. G. F. Biggio
C. Holtz

Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal against the interlocutory decision of the opposition division dated 29 January 1997, by which the European patent No. 481 903 was maintained in amended form.

Opposition was filed against the patent as a whole, based on Article 100(a) EPC in conjunction with Article 54 and 56 EPC (lack of novelty and of an inventive step).

The opposition division, having had regard to the following prior art documents:

E1: DE-A-2 532 168, and

E2: DE-A-2 241 127, corresponding to FR-A-2 196 909, which was acknowledged in the granted patent specification (column 1, lines 3 to 6) as being the prior art disclosing the preamble of Claim 1 as granted; and to Claim 1, as amended during the oral proceedings held on 12 December 1996,

held that the grounds for opposition mentioned in Article 100(a) EPC did not prejudice the maintenance of the contested patent, as amended.

Claim 1, as amended, reads as follows:

"A paper web threading apparatus for rotary printing press comprising

a paper web threading member guide (10,10') provided

along a paper web threading path of the printing press extending from a paper web supply section (S) to a position just in front of a folding section (F);

a paper web threading member (2,2') located over the whole length of the paper web threading path extending from the most upstream position thereof which is run along the paper web threading member guide (10,10') during the web threading operation;

a paper web retaining member (1,1') provided on said paper web threading member (2,2') for securing the paper web to be threaded along the path and at least one paper web threading member driving unit (B) for running said paper web threading member along said paper web threading member guide (10,10');

characterised by

a paper web threading member pooling section (A) provided downstream of the paper web threading path, to take up the leading end of a paper web threading member the tailing end of which being connected to a paper web,

a plurality of paper web threading member pooling sections (A) being gathered in a group (Z),

the paper web threading member pooling sections (A) being movable to connect the threading members as desired to any one of a plurality of paper web threading member guides (10,10')".

In the decision under appeal, the opposition division further held that the above-quoted Claim 1 met the

requirements of Articles 123(2) and 123(3) EPC, so that the grounds of opposition mentioned in Article 100(b) EPC did not prejudice the maintenance of the so amended contested patent, either.

- II. The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked on the ground that Claim 1 on file as amended in the oral proceedings before the opposition division did not comply with Article 123(3) EPC, alternatively, that the case be remitted to the first instance for additional search as regards Claim 1.

The respondent (patentee) requested that the appeal be dismissed.

- III. The appellant argued essentially as follows.

The presently effective Claim 1 had been amended in such a way as to contravene Article 123(3) EPC.

Claim 1, as granted, comprised the following expression: "said threading member (2,2') being movable through said pooling section (A)" (see column 14, lines 35 to 36 of the granted patent), which the opposition division found to be open to be construed as meaning either

- (a) that the threading member (2,2') could be connected to any selected ones of a plurality of paper web threading member guides, or
- (b) that the threading member (2,2') was movable through the pooling section (A), e.g. from end to

end of said pooling section (A),

as stated by the opposition division in paragraph 2.4.2 of the decision under appeal.

Since the above-quoted expression: "said threading member (2,2') being movable through said pooling section (A)" had been deleted from Claim 1 as amended, one of the two possible interpretations of the subject-matter thereof had also been deleted, thereby providing for an extension of the scope of said claim, thus, for a violation of Article 123(3) EPC.

In Claim 1, as amended during the oral proceedings before the opposition division, the following feature: "...a plurality of paper web threading member pooling sections (A) being gathered in a group (Z)..." was added to the subject-matter thereof and was considered as essential for the positive appreciation of the inventive step involved by said subject-matter.

Such a feature was not mentioned in any of the originally filed claims, so that no search was performed in respect of this feature. A complementary search regarding Claim 1, as amended, was accordingly necessary, which justified the alternative request.

IV. The respondent argued essentially as follows.

The appellant submitted that the scope of Claim 1, as amended during the oral proceedings before the opposition division, was extended beyond the scope of the granted Claim 1, because the following feature: "...said threading member (2,2') being movable **through**

said pooling section (A)..." had been deleted from the subject-matter of said claim.

Owing to the unclear meaning of the word "**through**" comprised in the wording of the above feature, theoretically, two interpretations thereof, as mentioned on page 7 of the decision under appeal, were possible, i.e. said feature might be construed as meaning:

- (a) said threading member (2,2') being movable **by means of** the pooling section (A), or
- (b) said threading member (2,2') being movable **by passing through** said pooling section (A).

As it was discussed during the oral proceedings before the opposition division, it was clear from the context, particularly the originally filed description (page 24 and Figures 9 and 10), that the first interpretation (a) was the correct one and that Claim 1, as granted, was indeed unclear. Claim 1 was, accordingly, clarified by amending it in the sense of the first interpretation (a).

This clarifying amendment of Claim 1, also meant that the second alternative interpretation (b) was removed from the scope of said claim. As correctly stated by the opposition division in the decision under appeal, this amendment restricted the extent of protection conferred, and therefore did not contravene the requirements of Article 123(3)EPC.

The appellant's opinion was incorrect. Deleting a

feature from a claim normally meant an extension of the scope of said claim, but, in the present case, the deletion was in fact restricting the possible interpretation of Claim 1. Therefore, the clarifying amendment of Claim 1 made during the oral proceeding before the opposition division was admissible and did not violate Article 123(3) EPC.

There was no need to remit the case for an additional search. Claim 1 was a combination of features, of which the feature that the pooling sections A were gathered in a group Z, was not a particularly important key feature. Concerning the patentability of the subject-matter of said claim, it would not make any difference whether this feature, as such, was known or not. It had only been taken out from the description in order to make the scope of Claim 1 clear.

Moreover, the appellant could have conducted the necessary search by himself.

Finally, remitting the case to the first instance would result in a substantial delay of the proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. The questions on which the Board has to decide are:
 - the alleged violation of Article 123 EPC which would lead to the revocation of the contested patent, if well-founded, and

- the alleged necessity of a further search, specifically intended to ascertain whether or not the feature added to the presently effective Claim 1 was known as such.

3. *Article 123(2) and (3) EPC*

3.1 The Board concurs with the conclusion of the opposition division, in considering that the disputed amendment of Claim 1 does not violate either Article 123(2) or 123(3) EPC, for the following reasons.

3.2 In the independent Claim 1 of the contested patent as granted (see column 14, lines 35 to 39, thereof), the granted wording:

"... said threading member (2,2') being movable through said pooling section (A) to be connected as desired to any selected ones out of a plurality of paper web threading member guides (10,10')"

was replaced by the following wording:

"... a plurality of paper web threading member pooling sections (A) being gathered in a group (Z), the paper web threading member pooling sections (A) being movable to connect the threading members as desired to any one of a plurality of paper web threading member guides (10,10')".

3.3 *Article 123(2) EPC*

The above-quoted amended feature is based on the originally filed application (page 27, line 25 to

page 28, line 13), which forms also part of the description of the patent specification as granted on column 13, lines 10 to 26, see e.g.: "... a plurality of paper web threading member pooling sections A are gathered into a group Z ... as shown in Fig. 9 ... by moving paper web threading member pooling sections A ... by a proper means ... in any of the directions shown by arrows ... sections A, A ... can be connected sequentially and/or as desired to any selected ones out of the paper web threading member guides 10 ...".

The requirements of Article 123(2) EPC are thus met.

3.4 Article 123(3) EPC

As stated by the respondent and confirmed in the decision under appeal, the clarifying amendment adopted, in the form of the wording pointed out above (paragraph 3.2), results in the deletion from independent Claim 1, as granted, of the above second interpretation (b) (see item III) of said feature in question, which was considered to make Claim 1 unclear. Such a deletion does not violate Article 123(3) EPC, since it does not extend the protection conferred by Claim 1 as granted. Nor does it confer any protection to other fields which were not already covered by said granted claim.

During the opposition procedure, the appellant objected that furthermore the feature: ("by moving ... pooling sections A") "together with the relevant auxiliary guides 10" ("by a proper means"), see description of the patent specification on column 13, lines 16 to 19, should have been inserted into Claim 1, as amended.

The Board, however, concurs with the view of the opposition division on the matter and does not consider this feature as an essential feature for carrying out the invention, in order to obtain the desired effect according to Claim 1 of the contested patent. It is definitely within the ordinary skill of the person skilled in the art to apply any useful means to physically connect the movable pooling sections as desired to any one of the guides as explicitly defined by the amended Claim 1.

Under these circumstances, there are no deficiencies pursuant to Article 123(2) or 123(3) EPC to prejudice the maintenance, pursuant to Article 102(3) EPC, of the patent as amended.

4. *Remittal to the first instance*

The Board agrees with the respondent's submission that the feature added to Claim 1 as granted, i.e. "a plurality of paper web threading sections (A) being gathered in a group (Z)" is not a particularly important key feature of Claim 1 as amended, so that, concerning the patentability of the subject-matter of said claim, it will not make any difference whether this feature, as such, was already known or not.

Moreover, as already mentioned above (point 3), the Board is satisfied that the amendments to Claim 1 as granted comply with the requirements of Article 123(2) and (3) EPC.

Under these considerations, the Board is of the opinion that a complementary search on the subject-matter of

the presently effective Claim 1 would not lead to any substantial difference in the appreciation of the patentability of the subject-matter of said claim, as expressed by the opposition division in the decision under appeal. The Board will therefore not allow the requested remittal to the first instance for any additional search as regards Claim 1.

5. Since the appellant has not raised any objections in respect of novelty or inventive step, there are no further outstanding patentability issues for the Board to consider.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Townend

H. Ostertag