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D E C I S I O N
of 5 February 2003

Case Number: T 0463/01 - 3.2.7

Application Number: 93308028.5

Publication Number: 0596606

IPC: B65H 7/12

Language of the proceedings: EN

Title of invention:

Method and apparatus for detecting double-fed sheets

Patentee:

PITNEY BOWES INC.

Opponents:

NEOPOST LTD
Heidelberger Druckmaschinen AG
Böwe System AG
Giesecke & Devrient GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 54, 56, 84, 100(a), 112(1)(a), 123(2)
EPC R. 57a, 67

Keyword:

"Novelty - main request (no)"
"Added subject-matter - 1st auxiliary request (yes)"
"Inventive step - 2nd auxiliary request (no)"
"Referral of questions to Enlarged Board of Appeal (no)"
"Reimbursement of appeal fee (no)"

Decisions cited:

-

Catchword:

-

Respondent: PITNEY BOWES INC.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 27 March 2001
rejecting the opposition filed against European
patent No. 0 596 606 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: A. Burkhart
Members: P. A. O'Reilly
J. H. P. Willems

Summary of Facts and Submissions

- I. The appellants I, II, III and IV (opponents) each filed an appeal against the decision of the Opposition Division to reject the oppositions against the European Patent No. 0 596 606.
- II. Oppositions were filed against the patent as a whole and based on Article 100(a) EPC (lack of novelty and lack of inventive step).

The Opposition Division held that the subject-matter of claim 1 of the main request (maintenance of the patent unamended) was novel and involved an inventive step.

The most relevant prior art documents for the present decision are:

D1: EP-A-0 280 147

D2: EP-A-0 086 097

D4: DE-A-3 230 524

D5: DE-A-2 153 910

D6: DE-A-3 235 235

D7: DE-A-2 930 270

D8: DE-A-3 926 491

D14: US-A-4 966 354

- III. Appellants I, II, III and IV each requested that the

decision of the Opposition Division be set aside and the patent be revoked.

Appellants I and IV requested that questions of law be put to the Enlarged Board of Appeal. Appellant I further requested reimbursement of the appeal fee.

The respondent requested that the decision under appeal be set aside and the patent be maintained in amended form in accordance with the main request filed during oral proceedings before the Board on 5 February 2003, or alternatively, in accordance with the first or second auxiliary request also filed during the oral proceedings before the Board on 5 February 2003.

IV. The independent claim of the main request reads as follows:

"1. A mechanism for detecting double fed sheets having a first means (64, 70) for generating a signal representative of the instantaneous thickness of a sheet as said sheet is transported past said first means, second means (72), responsive to said first means for generating a sequence of samples of said signal, and third means (74), responsive to said samples, for determining if a double sheet is being transported past said first means (64, 70), said mechanism being characterised in that said third means is arranged for:

- a) determining an average thickness for at least one subsequence of said samples;
- b) comparing said average thickness to a predetermined reference value;
- c) if said average thickness is greater than said

reference value, generating a double detect signal representative of a double fed sheet; and
d) then updating said reference value to form a new reference value as a function of said average value and said predetermined value."

The independent claim of the first auxiliary request reads as follows:

"1. A mechanism for detecting double fed sheets having a first means (64, 70) for generating a signal representative of the instantaneous thickness of a sheet as said sheet is transported past said first means, second means (72), responsive to said first means for generating a sequence of samples of said signal, and third means (74), responsive to said samples, for determining if a double sheet is being transported past said first means (64, 70), said mechanism being characterised in that said third means is arranged for:

- a) determining an average thickness for at least one subsequence of said samples;
- b) comparing said average thickness to a predetermined reference value;
- c) if said average thickness is greater than said reference value, generating a double detect signal representative of a double fed sheet; and
- d) **if said average thickness is not greater than said reference value**, updating said reference value to form a new reference value as a function of said average **thickness** and said predetermined value, **said function comprising a weighted addition of (i) said average thickness multiplied by a scaling factor and (ii) said predetermined value, wherein the weighting is in favour of said**

predetermined value."

(Bold type indicates changes compared to main request.)

The independent claim of the second auxiliary request reads as follows:

"1. A mechanism for detecting double fed sheets having a first means (64, 70) for generating a signal representative of the instantaneous thickness of a sheet as said sheet is transported past said first means, second means (72), responsive to said first means for generating a sequence of samples of said signal, and third means (74), responsive to said samples, for determining if a double sheet is being transported past said first means (64, 70), said mechanism being characterised in that said third means is arranged for:

- a) determining an average thickness for at least one subsequence of said samples;
- b) comparing said average thickness to a predetermined reference value;
- c) if said average thickness is greater than said reference value, generating a double detect signal representative of a double fed sheet; and
- d) then updating said reference value to form a new reference value as a function of said average value and said predetermined value, said function comprising a weighted addition of (i) said average value multiplied by a scaling factor **of approximately 1.25** and (ii) said predetermined value, wherein the weighting **involves a multiplying factor of 7/8 for said predetermined value and a multiplying factor of 1/8 for said average value."**

(Bold type indicates changes compared to first auxiliary request.)

IV. Appellant I argued in written and oral submissions essentially as follows:

- (i) In the opposition proceedings the proprietor made a new main request which included a new independent claim which was more limited in scope than the independent claim as granted. The proprietor then shortly before the oral proceedings returned to the claims as granted as main request without explanation. This is an abuse of the procedure and leads to prolongation of the procedure. It is requested that the following question of law be put to the Enlarged Board of Appeal: "During opposition proceedings does the proprietor have the right to return to an earlier claim of broader scope than the one on file and, if yes, under which conditions?"
- (ii) Claim 1 as granted was not clear with respect to feature (d). It is the duty of all instances of the European Patent Office to ensure that claims are clear, irrespective of Article 100 and Rule 57a EPC.
- (iii) In their decision the Opposition Division interpreted feature (a) of claim 1 as requiring a subdivision of the samples into subsequences. This interpretation was not discussed by the parties and appeared for the first time in the decision of the Opposition Division. The right of the opponent to be heard was therefore not respected. For this reason the appeal fee should

be reimbursed.

- (iv) With respect to claim 1 of the main request each of documents D2, D4 and D14 takes away the novelty of this claim. In document D2 it is to be noted that there is a digital/analogue converter which therefore inherently produces samples of the instantaneous thickness. The features (a) to (d) are either implicitly disclosed in document D2 or self-evident for the skilled person. In documents D4 and D14 all the features of claim 1 are disclosed.
- (v) With respect to the first auxiliary request there is no basis in the application as filed for a general reference to a scaling factor since only specific values were disclosed.
- (vi) With respect to the second auxiliary request the claim is inconsistent in its terminology regarding the predetermined reference value and hence unclear. Also it is already known from document D2 to provide a scaling factor of 1.25 and a low value of the weighting of the new measurement for the updating of the reference value is necessary for slow changing situations.

V. Appellant II argued in written and oral submissions essentially as follows:

- (i) Claim 1 of the main request is not novel over the disclosure of document D8. The detector detects the transmissibility of the paper under consideration and, in the case of paper sheets without printing this will be directly

proportional to the thickness. In document D8 the use of the disclosed apparatus with sheets other than ballot sheets is indicated in column 12, lines 29 to 35. It is acknowledged in the patent in suit, in column 1, lines 22 to 27 and column 3, lines 45 to 48, that thickness may be detected other than mechanically and in particular optically. The algorithm set out in document D8 corresponds to features (a) and (b) of claim 1. There is a double sheet detecting means which reacts to the result of the algorithm. It is inherent in the disclosure of document D8 that the updating of the reference value does not include the doubly detected sheets.

- (ii) With respect to the first auxiliary request there is no basis in the application as filed for incorporating features relating just to detecting the thickness when these features were only disclosed in combination with the corresponding features concerning detecting the length.

- (iii) With respect to the second auxiliary request the specific value for the scaling factor for the length should have been given as well as that for the average thickness. Also the respondent has already indicated with respect to the first auxiliary request that it would be obvious to the skilled person to provide a weighting. The particular choice of weighting specified in the claim does not involve an inventive step.

VI. Appellant III argued in written and oral submissions essentially as follows:

- (i) With respect to claim 1 of the main request each of documents D7 and D8 takes away the novelty of this claim. In particular with respect to document D8 the features of claim 1 are all disclosed therein.
- (ii) With respect to the first auxiliary request there is no basis in the application as filed for generalisation made in claim 1 on the basis of the single example in the description.
- (iii) With respect to the second auxiliary request the expression "approximately" mentioned in claim 1 is unclear.
- (iv) Claim 1 of the second auxiliary request does not involve an inventive step in view of document D8. Document D8 discloses a weighting and in the case of long term variations this would be changed to weight the existing measurements stronger than the new measurement. The particular value set out in the claim would be chosen if required.

VII. Appellant IV argued in written and oral submissions essentially as follows:

- (i) Although claim 1 is clear the Opposition Division interpreted the claim in their decision in a manner different to the clear meaning in that they effectively added the words "if not" at the beginning of feature (d). The claim should be considered in the form in which it was granted without any extra words or meanings. If the Board cannot agree to this interpretation of the claim the following question of law should be put to

the Enlarged Board of Appeal: "May claims which are clear and which can be interpreted without ambiguity be interpreted or expanded by the Opposition Division in the manner in which they did?"

- (ii) With regards to the main request document D8 takes away the novelty of claim 1. In this respect it should be noted that the patent in suit itself in column 1, line 26 refers to measuring the thickness of a sheet via its transparency, just as is done in document D8.
- (iii) With regards to claim 1 of the first auxiliary request the amendment does not include the length measurement. In column 4, lines 30 to 32 of the patent in suit reference is made to the reference values for the thicknesses and a reference length whereas the claim does not include the reference length.

VIII. The respondent argued in written and oral submissions essentially as follows:

- (i) Claim 1 of the main request is novel over each of documents D2, D4, D8 and D14.

With respect to document D8 there is no disclosure therein of (i) means for generating a signal representative of the instantaneous thickness of a sheet, (ii) means which updates the reference value to form a new reference value as a function of the average value of the subsequence of samples and the predetermined value, and (iii) means for generating a double

detect signal if the average thickness is greater than the reference value.

None of the other documents show all the features of claim 1.

- (ii) For the first auxiliary request it is true that claim 1 contains a generalisation from an example in the description. The skilled person however would recognise from the description in column 5, lines 19 to 31 that the specific value given therein is only a preferable value. This is recognisable because the paragraph starts off with the word "Preferably". The skilled person would also recognise that the long term variations referred to in the paragraph would require a heavier weighting to the previous measurements. There is no need to also incorporate the length measurement into claim 1 since claim 1 as originally filed referred only to the thickness measurement.

- (iii) For the second auxiliary request document D8 does not disclose the weightings set out in claim 1. The formula in column 6, line 23 of the document does not have a weighting. Moreover, the document is concerned with the problem of ballot papers and does not consider the problem of drift. In document D2 the average thickness of a number of sheets is taken and not the average thickness of a single sheet. The problem of drift is not addressed in the document.

Reasons for the Decision

Main request

1. *Amendments*

1.1 Compared to claim 1 as granted claim 1 of the main request has been amended by changing "at least a subsequence of said samples" to "at least one subsequence of said samples" in feature (a) of the claim. In the claim as granted the expression "at least" applied to "a subsequence of samples". This meant that the complete sequence was not excluded. On the other hand, a single sample was excluded since the minimum requirement had been set in the claim at a subsequence, i.e. one subsequence. The amendment to "at least one subsequence" allows for one or a plurality of subsequences. The amendment therefore sets the same lower limit as was already present in the claim as granted whilst removing the possibility of no subsequence. Since a plurality of subsequences was also specifically disclosed in the application as filed there is no addition of subject-matter. The amendment does not therefore add to the content of the application as filed and thus conforms with Article 123(2) EPC. The amendment also complies with Article 123(3) EPC since subject-matter which was within the scope of claim 1 as granted is excluded from protection without giving to protection to any further subject-matter.

1.2 The amendment is clear since the expression "at least one" clearly includes the possibilities of just one subsequence or a plurality of subsequences.

1.3 Appellant I had objected to claim 1 as granted, and hence also to claim 1 of the main request on the basis

that the claim as granted was not clear. In the opinion of appellant I all instances of the European Patent Office, i.e. Examining Divisions, Opposition Divisions and Boards of Appeal are obliged to examine all claims for clarity, irrespective of the existence of Article 100 and Rule 57a EPC. The Board cannot agree with this view. The instances of the European Patent Office may only act within the powers accorded them by the European Patent Convention. With respect to opposition proceedings this power does not extend to clarity as this is not a ground of opposition listed in Article 100 EPC. Moreover, the proprietor would not be empowered to amend the patent on the basis of lack of clarity as amendments may only be effected if they are occasioned by a ground of opposition as set out in Article 100 EPC, cf. Rule 57a EPC. Clarity may only be examined in opposition proceedings and subsequent appeal proceedings in the context of Article 102(3) EPC which does not apply to the patent as granted.

2. *Novelty*

2.1 The respondent considered that compared to the disclosure of document D8 claim 1 was distinguished by three features. These features are that the device disclosed therein (i) does not include a means for generating a signal representative of the instantaneous thickness, (ii) does not include a means which updates the reference value to form a new reference value as a function of the average value of the subsequence of samples and the predetermined value, and (iii) does not generate a double detect signal if the average thickness is greater than the reference value.

The Board agrees with the respondent that the other

features of claim 1 are disclosed in document D8, but is of the opinion that the document also discloses the three features mentioned above.

2.2 In the device of document D8 the transmissibility to light of sheets is measured. The transmissibility is dependent upon the thickness of the sheet and the opacity of the sheet due to any printing. This value for transmissibility is compared to a reference value. For sheets without any printing, i.e. uniform opacity, the variation in transmissibility will be directly dependent upon the thickness. Although the document principally deals with ballot papers it is stated in column 12, lines 29 to 35 that other types of sheets may be considered and examined as to their normality and whether they have been incorrectly conveyed. An incorrect conveyance may be the conveyance of two sheets or of overlapping sheets, cf. column 6, lines 49 to 57. The basis for deciding such an incorrect conveyance is the thickness of the sheets as measured by the light transmissibility. The device disclosed in document D8 is therefore capable of generating a signal representative of the instantaneous thickness when unprinted sheets are fed therein.

2.3 According to claim 1 a thickness average is compared to a predetermined, i.e. already existing, reference value. Then this reference value is updated on the basis of a function depending upon the said average thickness and the existing reference value. This new reference value will become the predetermined value for comparison with the next thickness average. In document D8 the average value $D_{k,i}$ is compared with $D_{\max_{k-1,i}}$ and $D_{\min_{k-1,i}}$ (see column 6, lines 32 to 38). This means that the thickness average is compared to a predetermined,

i.e. already existing, reference value. The reference value is updated by taking the existing reference value Dr_{k-1} and the thickness value $D_{k,i}$ and combining these in accordance with the formula given in column 3, line 23 to obtain a new reference value $Dr_{k,i}$ which will be used for comparison with the next thickness average (as indicated in column 6, lines 32 to 38). Thus, updating carried out in accordance with document D8 is exactly as specified in claim 1. The respondent argued in his submission of 3 January 2003 and in the oral proceedings that the claim specifies for updating the reference value a combination which, in the terminology of document D8, would be a combination of $Dr_{k-1, i}$ and $D_{k-1,i}$. The Board cannot agree with this view for the following reasons. The reference value used in the comparison with $D_{k,i}$ is the predetermined reference value, i.e. the existing reference value $Dr_{k-1,i}$ which was determined by incorporating the previous thickness average $D_{k-1,i}$ into the still earlier predetermined reference value, i.e. $D_{k-2,i}$. This predetermined reference value $Dr_{k-1,i}$ is then according to feature (d) of claim 1 combined with the thickness average. Since this is the thickness average which has not yet been incorporated into the reference value it must be considered to be the thickness average $D_{k,i}$. Any other interpretation of feature (d) would be inconsistent with feature (b) of the claim. Therefore the Board considers that the argument of the respondent that the claim has the meaning that $Dr_{k,i}$ is a combination of $Dr_{k-1, i}$ and $D_{k-1,i}$ is inconsistent with the wording of the claim.

2.4 With regards to feature (iii) the claim specifies that a comparison is made to see if the average thickness is greater than a reference value. In document D8 the

light transmissibility is being considered. This parameter is representative of the thickness in that the transmissibility is inversely related to the thickness. In document D8 the transmissibility average is compared to a reference value D_{min} and if it is lower than this value then a double sheet is detected and signalled (see column 6, lines 50 57). Since the average transmissibility is being compared to a minimum this is nothing other than the average thickness being compared to a maximum. The Board therefore also considers that feature (iii) is disclosed in document D8.

- 2.5 Therefore, the features which the respondent considered distinguished claim 1 from the teaching of document D8 are, in the opinion of the Board, disclosed in this document. The subject-matter of claim 1 is thus not novel in the sense of Article 54 EPC.

First auxiliary request

3. *Amendments*

- 3.1 There are two aspects to the amendments to claim 1 of this request. The first aspect is the introduction of a scaling factor of undefined value. The second aspect is the definition of a weighted addition with the weighting being in favour of the predetermined value.

- 3.2 With respect to the scaling factor, a factor is mentioned in column 4, lines 38 to 40 as being applicable to determine the reference values. This factor is described as "preferable approximately 1.25". In column 5, lines 23 to 26 reference is made to multiplying the average thicknesses and length by "the

appropriate factors (i.e. approximately 1.25 and 1.50)". This is done to prepare the average thickness value for combination with the existing reference value to form a new reference value. The indication of 1.25 in the latter case must be seen a reference back to the example of 1.25 in the former case. In the former case the value of 1.25 is only a preferred value. It follows therefore that the reference in the latter case must also be the preferred value since nothing else is consistent. In the opinion of the Board therefore there was a general disclosure of a scaling factor and a specific disclosure of a value of approximately 1.25 for the scaling factor.

- 3.3 Concerning the weighting factor the respondent has freely admitted that the only express disclosure is of a weighting of $1/8$ to $7/8$. Nevertheless, the respondent considers that the skilled person will recognise that this is just one example and that this was disclosed in connection with long term variations. The Board would first note that the claim specifies that the weighting should be in favour of the predetermined value which means a weighting of more than $1/2:1/2$. Even if the skilled person were to recognise that to compensate long term drift requires a weighting with much more in favour of the previous measurements and much less in favour of a new measurement as suggested by the respondent, this would not lead to a weighting of more than $1/2:1/2$, but rather a weighting of, for example, more than $4/5:1/5$. However, no particular minimum weighting for the previous predetermined value was given in the application as filed and the skilled person would not deduce more than $1/2:1/2$ as that is too low a weighting for the previous predetermined value to compensate for long term drift.

The Board therefore concludes that it cannot be unambiguously derived from the application as filed that there is a weighted addition of the average thickness multiplied by a factor and the predetermined value wherein the weighting is in favour of said predetermined value.

- 3.4 Claim 1 of the first auxiliary request does not therefore comply with Article 123(2) EPC and hence cannot be allowed.

Second auxiliary request

4. *Amendments*

- 4.1 Appellant III has objected to the clarity of claim 1 of the request since reference is made in the claim to a scaling factor of "approximately 1.25". In the opinion of the Board the skilled person would have no difficulty in interpreting the term "approximately" in the circumstances.

- 4.2 Appellant I pointed out that the predetermined reference value was referred to later in the claim sometimes as "said reference value" and sometimes as "said predetermined value". In the opinion of the Board however such loose use of the expressions does not render the claim unclear. No reader of the claim would have doubted that "said reference value" and "said predetermined value" refer to "the predetermined reference value" which preceded them. In the first place the use of the word "said" makes it clear that no new feature is being introduced. In the second place the inclusion of the terms "reference" and "predetermined" brings the reader unerringly to "the

predetermined reference value" since that is the only previously stated expression employing either of these terms. Claim 1 of the request is therefore clear in this respect.

- 4.3 Appellant II considered that the claim did not comply with Article 123(2) EPC since the part of the description which referred to the scaling factor of approximately 1.25 only did so in combination with specifying a scaling factor for the length of 1.50. The part of the description of the application as filed on which the amendment is based (page 7, lines 1 to 12) does indeed refer to both the average thickness and the length. Claim 1 as originally filed was concerned only with the average thickness and did not mention the length. The length was first mentioned in claim 2 as originally filed. The skilled reader would thus understand that the average thickness and the length were not two parameters which had to be considered in combination, but that they could be considered independently. Consequently, the skilled reader would understand that the scaling factors and weightings for the average thickness, as mentioned in the above cited part of the description, could be applied without simultaneously applying the scaling factors and weightings for the length. In the opinion of the Board therefore claim 1 as amended complies with Article 123(2) EPC.

5. *Novelty*

Novelty of claim 1 of this request was not contested.

6. *Inventive step*

- 6.1 In the opinion of the Board document D8 is the nearest prior art document. This document discloses all the features of claim 1 the of main request. Claim 1 of this auxiliary request further included the feature that reference value is updated "if said average thickness is not greater than said reference values". This feature, according to the respondent, merely states explicitly what was already implicitly meant by claim 1 of the main request. The Board also agrees that this feature does not constitute a limitation on the subject-matter of the claim and was acknowledged by the respondent to be known from document D8. Document D8 further discloses multiplying the average thickness by a scaling factor. This is done within the calculation performed in column 6 line 29 wherein the value $D_{min_{n,i}}$ is established by multiplying $Dr_{n,i}$ by a scaling factor $(1-1/b)$, wherein $D_{min_{n,i}}$ already includes the thickness average from the formula in column 6, line 23. Document D8 also discloses that the average thickness and predetermined value are added together with a weighting of $1/2$ of the predetermined value and $1/2$ of the average value as set out in column 6, line 23.
- 6.2 Claim 1 of the request is therefore distinguished from the disclosure of document D8 in that the scaling factor is 1.25 and that the adding together of the existing predetermined value and the average thickness is with a weighting of $7/8:1/8$ respectively.
- 6.3 The scaling factor serves to avoid false alarms due to vibrations etc. in the thickness measuring sensor. No particular significance is given in the patent for the value of 1.25. Moreover, this value is disclosed for the same purpose in document D2 on page 7, lines 8 to 18, wherein it is explained that a 25% tolerance level

is allowed to either side of a measured thickness level. The provision of the scaling factor of 1.25 cannot therefore be considered to involve an inventive step.

- 6.4 The feature that the predetermined value is updated together with a weighting of $7/8$ of the predetermined value and $1/8$ of the average value solves the problem of dealing with long term drift, as indicated in column 5, lines 19 to 31 of the patent in suit. The problem of long term drift is a well known problem. Also, the solution to the problem is well known. As already indicated by the respondent with respect to claim 1 of the first auxiliary request the skilled person would realise that there should be a higher weighting towards the existing predetermined value with a lower weighting towards the new thickness measure. This consideration is consistent with the teaching of document D2 that fifty readings should be used when dealing with gradually changing characteristics, as indicated on page 4, lines 10 to 16. By using fifty readings this ensures that the effect of an one reading is diminished.

In the opinion of the Board therefore it would be an obvious measure for the skilled person to arrange that the updating of the reference value should be more heavily weighted in favour of the existing reference value and less in favour of the new average thickness.

The claim further specifies a particular weighting in favour of the existing value. The description of the patent gives no indication of any special effect to be achieved by the particular value specified and the respondent has not offered any submission in this

direction. The Board concludes therefore that the particular value of $7/8:1/8$ is one which a skilled person would choose without exercising any inventive skill.

6.5 Therefore, the subject-matter of claim 1 of the second auxiliary request does not involve an inventive step in the sense of Article 56 EPC.

7. *Referral of questions of law to the Enlarged Board of Appeal*

7.1 With regards to the question proposed by appellant I the Board notes that the proprietor in the opposition proceedings returned to the independent claim as granted after opponent I (appellant I) had objected under Article 123(2) EPC to the amendments made in the new request. Such a retrograde step was surely to be expected by the opponent and indeed desired. The return to the patent as granted as main request took place more than one month before the oral proceedings which had already been appointed. Opponent I therefore had plenty of time to prepare for the new situation at the oral proceedings, which in any case was the situation when opponent I prepared his opposition. There was no abuse or prolongation of the procedure, as oral proceedings had already been appointed and could take place as appointed. In such a clear situation this Board considers it unnecessary to put a question of law to the Enlarged Board of Appeal.

7.2 With regards to the question proposed by appellant IV in the opinion of the Board claim 1 as granted was not clear in the sense that it did not make technical sense. The Board considers that the skilled person

would interpret the claim in a sense similar to that taken by the Opposition Division with respect to feature (d). Since the question proposed by appellant IV concerns a different situation to the one under consideration the referral of a question of law to the Board of Appeal is superfluous.

8. *Right to be heard*

Appellant I considered that his right to be heard under Article 113(1) EPC had not been respected by the Opposition Division. In the opinion of appellant I the Opposition Division in their decision interpreted the independent claim in a surprising manner which had not before been indicated neither in the written nor in the oral proceedings. However, an Opposition Division must always interpret all aspects of a claim in a decision regarding novelty and inventive step. It cannot be expected that the Opposition Division explains every aspect of their interpretation beforehand. The argument that the interpretation of the Opposition Division was surprising cannot be followed since that is a matter of opinion. The Opposition Division may well have considered their interpretation to be self-evident giving no cause for special interpretation. If a party relies for part of their case on a particular interpretation of a claim then it is up to that party to argue this interpretation explicitly in the proceedings. Moreover, Article 113(1) EPC refers only to grounds or evidence. Appellant I has not shown that the interpretation of the claim by the Opposition Division constituted new grounds or evidence as opposed to new arguments. The Board therefore considers that the right to be heard of appellant I has been respected.

Since the right to be heard of appellant I has been respected a reimbursement of the appeal fee is not equitable in the sense of Rule 67 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The requests of appellants I and IV for referral of questions of law to the Enlarged Board of Appeal and the request of appellant I for reimbursement of the appeal fee are rejected.

The Registrar:

The Chairman:

D. Spigarelli

A. Burkhart