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**D E C I S I O N**  
**of 19 January 2005**

**Case Number:** T 0682/03 - 3.2.7

**Application Number:** 00119924.9

**Publication Number:** 1084804

**IPC:** B26D 3/08

**Language of the proceedings:** EN

**Title of invention:**  
Apparatus and method for making labels

**Applicant:**  
BROTHER KOGYO KABUSHIKI KAISHA

**Opponent:**  
-

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 123(2), 54, 56

**Keyword:**  
"Extension of subject-matter beyond content of application as  
filed (no), novelty (yes), inventive step (yes)"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0682/03 - 3.2.7

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.7  
of 19 January 2005

**Appellant:** BROTHER KOGYO KABUSHIKI KAISHA  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 12 February 2003  
refusing European application No. 00119924.9  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** P. A. O'Reilly  
**Members:** H. E. Hahn  
E. Lachacinski

## Summary of Facts and Submissions

- I. The applicant lodged an appeal against the decision of the Examining Division to refuse the European patent application No. 00 119 924.9.

The Examining Division held that the claims 1 and 6 as filed on 12 December 2002 containing the feature "a single drive unit that drives the switching device to switch the state of the cutter between the full cutting state and the half cutting state" represented an unallowable generalization of the feature "the state of the cutter is switched by the driving source for moving the cutting unit across the sheet" and thereby contravened Article 123(2) EPC.

- II. With a communication dated 22 September 2004 and annexed to the summons to oral proceedings the Board presented its negative opinion with respect to an amended single request which was filed on 13 June 2003 together with the grounds of appeal dated 11 June 2003. The amended claims 1 and 6 of this request were considered to contravene Article 123(2) EPC.

- III. Oral proceedings before the Board of Appeal were held on 19 January 2005.

- (i) The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the following documents:

Description:

pages 1 and 2 as filed with letter of  
15 December 2004

pages 3 to 5 and 16 as filed during the oral  
proceedings on 19 January 2005

pages 6 to 15 as originally filed

Claims:

1 to 7 as filed during the oral proceedings on  
19 January 2005

Drawings: figures 1 to 17 as originally filed.

(ii) The independent claims 1 and 6 under  
consideration as filed on 19 January 2005  
read as follows:

"1. A label making apparatus (100) that makes labels  
by performing a full cutting and a half cutting on a  
sheet (13), comprising:

a frame (12) having a pair of side walls (10, 9)  
respectively disposed at opposite sides of the sheet  
(13)

a single cutter (43) that cuts the sheet (13)  
along a desired line;

a switching device (154) that switches a state of  
the cutter (43) between a full cutting state and a half  
cutting state, the cutter (43) performing the full  
cutting in the full cutting state and the half cutting  
in the half cutting state wherein the sheet is cut  
partway in a direction of a thickness of the sheet (13),  
on the sheet (13);

only one drive source (35, 124) reciprocating a  
cutting unit (30) comprising the cutter (43) in a

direction substantially perpendicular to a transport direction of the sheet (13) to move the cutting unit (30) to a first switching position adjacent to one side wall (10) where the cutter (43) is switched to the full cutting state through bumping the cutting unit (30) against the side wall (10) at the end of the traveling path and to move the cutting unit (30) to a second switching position adjacent to another side wall (9) where the cutter (43) is switched to the half cutting state through bumping the cutting unit (30) against the other side wall (9) at the end of the traveling path; and

a controller (114) that controls the drive source (35, 124) so that the half cutting is performed a predetermined number of cuts on the sheet (13) before the full cutting is performed thereon."

"6. A label making method for making labels by performing a full cutting and a half cutting on a sheet (13) using an apparatus having a frame (12) having a pair of side walls (10, 9) respectively disposed at opposite sides of the sheet (13) comprising:

cutting the sheet (13) along a desired line; switching a state of a single cutter by a switching device (154) between a full cutting state and a half cutting state, the cutter (43) performing the full cutting in the full cutting state and the half cutting in the half cutting state wherein the sheet (13) is cut partway in a direction of a thickness of the sheet (13), on the sheet (13); and

controlling only one drive source (35, 124) reciprocating a cutting unit (30) comprising the cutter (43) in a direction substantially perpendicular to a transport direction of the sheet (13) to move the

cutting unit (30) to a first switching position adjacent to one side wall (10) where the cutter (43) is switched to the full cutting state through bumping the cutting unit (30) against the side wall (10) at the end of the traveling path and to move the cutting unit (30) to a second switching position adjacent to another side wall (9) where the cutter (43) is switched to the half cutting state through bumping the cutting unit (30) against the other side wall (9) at the end of the traveling path so that the half cutting is performed a predetermined number of cuts on the sheet (13) before the full cutting is performed thereon."

IV. The most relevant documents of the prior art were considered to be:

D1 = GB-A-2 313 081

D2 = JP-U-2 14 952

V. The appellant argued essentially as follows:

The amendments of claims 1 and 6 are based on page 3, lines 8 to 10; page 7, lines 17 to 18; page 9, lines 9 to 16 and line 34 to page 10, line 2 of the specification as filed and therefore meet the requirements of Article 123(2) EPC. The amendments made to claims 1 and 6 result in claims which are narrower in scope than those according to a suggestion made by the Examining Division (namely the inclusion of the feature "the drive unit for moving the cutter drives the switching device at the ends of the travelling path of the cutter") which was stated to be inventive (see decision, point 3 of the reasons). Therefore the

subject-matter of the present claims 1 and 6 is likewise novel and inventive, particularly with respect to the most relevant documents D1 and D2.

## Reasons for the Decision

### 1. *Admissibility of amendments (Article 123(2) EPC)*

The independent claims 1 and 6 of the sole request are based on the subject-matter of the originally filed claims 1 and 6, respectively.

The additional features of "a **single cutter (43)**", "a **frame (12) having a pair of side walls (10, 9) respectively disposed at opposite sides of the sheet (13)**" and "wherein the sheet is cut partway in a **direction of a thickness of the sheet (13)**" of claims 1 and 6 can be found at page 3, lines 8 to 9; page 6, lines 5 to 8; page 7, line 35 to page 8, line 2 and can be derived from figures 2, 3 and 9 of the specification as filed. The additional features of claims 1 and 6 "only one drive source (35, 124) reciprocating a cutting unit (30) comprising the cutter (43) in a direction substantially perpendicular to a transport direction of the sheet (13) to move the cutting unit (30) to a first switching position adjacent to one side wall (10) where the cutter (43) is switched to the full cutting state through bumping the cutting unit (30) against the side wall (10) at the end of the traveling path and to move the cutting unit (30) to a second switching position adjacent to another side wall (9) where the cutter (43) is switched to the half cutting state through bumping the cutting unit (30) against the

**other side wall (9) at the end of the traveling path"** can be found at and/or derived from page 3, lines 14 to 28; page 7, lines 16 to 18; page 9, lines 9 to 20 and line 34 to page 10, line 7; and figures 2 to 9 of the specification as filed.

The dependent claims 2 to 5 and 7, into which the corresponding reference signs have been incorporated, are based on the originally filed claims 2 to 5 and 7, respectively.

Hence the requirements of Article 123(2) EPC are met for the claims 1 to 7.

## 2. *Novelty*

- 2.1 The label making apparatus according to document D1 includes a cutting mechanism comprising two cutters (102, 104) (see abstract; claims 1 to 10 and figures 1 to 16). The label making apparatus according to document D2 comprises a first drive unit for moving a single cutter and a second electric drive, such as a solenoid, for switching the cutter between the full cutting and the half cutting state (see figure 1).
- 2.2 The other two documents cited in the Search Report are less relevant than documents D1 and D2. The first one does not concern a label making apparatus while the second one represents an Article 54(3) and (4) EPC document which, however, does not disclose a controller for controlling the only one drive source which switches the cutting state of the single cutter.



2.3 Therefore, the subject-matter of claims 1 and 6 is novel with respect to the disclosure of the available documents.

3. *Inventive step*

3.1 *Closest prior art*

The closest prior art is represented by document D2, identified in the present application at page 1, lines 26 to 28 and at page 2, lines 9 to 13, which discloses a label making apparatus comprising one cutter that can perform both the half cutting and the full cutting. The apparatus comprises a first drive for moving the cutter. Another electric drive, such as a solenoid, is provided to adjust the single cutter in a cutting unit in its vertical position. The electric drive for the vertical movement causes a complicated structure of the label making apparatus.

The subject-matter of claim 1 is thus distinguished from the apparatus according to document D2 by the only one drive source (35, 124) for reciprocating the cutting unit (30) comprising the single cutter (43) between a pair of opposed side walls (10, 9) respectively disposed at opposite sides of the sheet (13), the said movement of the cutting unit is used for switching the state of the cutter at a first switching position to the full cutting state by bumping the cutting unit against one side wall (10) at the end of the traveling path and at a second switching position to switch the cutting state to the half cutting state by bumping the cutting unit at the end of the traveling

path against the other side wall (9). The same conclusion is valid for process claim 6.

3.2 *Problem to be solved*

The Board concurs with the statement in the application that the problem to be solved is to provide a label making apparatus which can make a plurality of labels which are easy to handle using a single cutter with a simple structure and a method for using the same (cf. application, page 2, lines 17 to 19).

3.3 *Solution to the problem*

The problem is solved by the label making apparatus as defined in claim 1 and the label making process as defined in claim 6.

3.4 The Board considers that the subject-matter of the independent claims 1 and 6 is not obvious for the person skilled in the art for the following reasons:

Taking account of the available documents the solution to use only one drive source for reciprocating the cutting unit comprising the single cutter and for switching the cutter to either the full cutting state or the half cutting state at switching positions by bumping the cutting unit at the end of the traveling path against a wall of a pair of opposite side walls, is not considered to be derivable from any combination thereof, particularly not from a combination of documents D2 and D1.

Such a combination of documents D2 and D1 is not considered to be obvious for the skilled person since the technical concepts of these two documents are totally different. Document D2 teaches an apparatus comprising a single cutter which is switched from one cutting state to the other by an electric drive and which needs another drive for its movement over the sheet to be cut while document D1 teaches to use two cutters, one for each cutting state. Document D1 thereby implies two drive sources, one for each cutter, but does not need any switching device which changes the cutting state of any of the two cutters. Hence these two technical concepts of documents D2 and D1 are not combinable and even if the skilled person for whatever reason were to combine them, he would not arrive at the claimed solution. The skilled person would have to completely change the said two technical concepts without having any incentive to do so.

- 3.5 The amendments to claims 1 and 6 as made during the oral proceedings before the Board are in line what the Examining Division stated would be novel and inventive with respect to documents D1 and D2 (see reasons of the decision, point 3). The claims 1 and 6 as amended before the Board are more restricted than those suggested by the Examining Division due to the additional limitations caused by the definition of the reciprocating movement of the cutting unit in a direction substantially perpendicular to a transport direction of the sheet between the pair of side walls of the frame and the switching of the cutting state taking place at switching positions adjacent one of said walls by bumping the cutting unit against the wall.

The finding of the Board is therefore consistent with the finding of the Examining Division.

4. Therefore, the subject-matter of the independent claims 1 and 6 involves an inventive step within the meaning of Article 56 EPC.
- 4.1 The same applies to the subject-matter of the dependent claims 2 to 5 and 7 which define further preferred embodiments of the apparatus according and of the process according to claims 1 and 6, respectively.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to grant a patent in the following version:

Description:

pages 1 and 2 as filed with letter of 15 December 2004  
pages 3 to 5 and 16 as filed during the oral  
proceedings on 19 January 2005  
pages 6 to 15 as originally filed

Claims:

1 to 7 as filed during the oral proceedings on  
19 January 2005

Drawings:

figures 1 to 17 as originally filed.

The Registrar:

The Chairman:

G. Nachtigall

P. O'Reilly