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**Datasheet for the decision
of 14 February 2007**

Case Number: T 0774/04 - 3.4.03

Application Number: 95307010.9

Publication Number: 0706096

IPC: G03G 15/00

Language of the proceedings: EN

Title of invention:
Dual path sheet feeder system

Patentee:
Xerox Corporation

Opponent:
Océ-Technologies B.V.

Headword:
-

Relevant legal provisions:
EPC Art. 56

Keyword:
Inventive step (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 0774/04 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 14 February 2007

Appellant: Océ-Technologies B.V.
(Opponent) St. Urbanusweg 43
NL-5914 CC Venlo (NL)

Representative: -

Respondent: Xerox Corporation
(Patent Proprietor) Xerox Square
Rochester, NY 14644 (US)

Representative: Skone James, Robert Edmund
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
6 April 2004 concerning maintenance of European
patent No. 0706096 in amended form.

Composition of the Board:

Chairman: G. Eliasson
Members: E. Wolff
J. Van Moer

Summary of Facts and Submissions

I. This is an appeal against the decision of the opposition division to maintain European patent number EP-B-0706096 in amended form.

II. The following documents among others were cited in the opposition procedure:

D2: US 4,924,265 A;

D3: XEROX Disclosure Journal, vol. 19, No. 4,
page 333-336.

III. Claim 1 of the patent as maintained reads as follows:

"1. Paper handling apparatus having a processing section (6); a predetermined output location; and a paper feeder system for delivering sheets to the predetermined output location; the feeder system comprising:

a sheet supply tray (10);

a first sheet feeding apparatus associated with said sheet supply tray for dispensing sheets therefrom;

an auxiliary sheet feeding supply tray (11); and

a second sheet feeding apparatus associated with said auxiliary sheet feeding supply tray for dispensing sheets therefrom;

wherein each of the sheet supply tray and auxiliary sheet feeding supply tray are arranged to be manually loadable by a user;

characterised in that:-

the feeder system is a dual path paper feeder system for selectively delivering the sheets to the predetermined output location, the dual path paper

feeder system comprising a movable decision gate (31) positioned adjacent the second sheet feeding apparatus for directing sheets dispensed from said auxiliary sheet feeding supply tray along a predetermined path of travel, said movable gate being selectively positionable between a first position for transporting the sheets to the processing section (6) prior to delivery to the predetermined output location (8), and a second position for transporting the sheets directly to the predetermined output location (8) without passing the processing section (6)."

III. In the decision under appeal the opposition division was of the opinion that document D2 did not disclose a dual path feeder system for selectively delivering sheets from an auxiliary tray to either the processing section or alternatively, directly to the output location.

The opposition division did not doubt that document D2 disclosed the possibility of bypassing the processing section for special sheets. However, absent any pertinent features shown in the drawing of Figure 1, the feature of by-passing the processing section had to be considered an alternative to the construction shown and described with reference to the drawings. In this alternative construction, auxiliary tray 92 was directly connected to the output tray 100 without any connection to the conveyor 98 to the registration rolls 70. Document D2 therefore disclosed two different single path systems. In one system, the path from the auxiliary tray 92 was a common path with the path 66 from supply tray 67 to the output tray 100 as shown in Figure 1. The alternative system proposed in document

D2, but not shown in the drawings, had a separate path which, without any link to the paper path 66, connected tray 92 directly with output tray 100. There was no explicit disclosure in D2 of a combination of these two alternative single path systems.

- IV. Oral proceedings were held in the absence of the parties who had previously informed the board that they would not attend the oral proceedings.

The appellant opponent requested in writing that the decision under appeal be set aside and that European patent EP-B-0 706 096 be revoked.

The respondent proprietor requested in writing that the appeal be dismissed.

- V. The written arguments of the appellant opponent can be summarised as follows:

Document D2 disclosed printing apparatus for making print sheets including a dual path sheet feeder. The claimed invention differed from the apparatus disclosed in document D2 only in the provision of a decision gate. Selecting a path by means of a decision gate was known from document D3. Hence, the claimed invention lacked an inventive step.

- VI. The respondent proprietor agreed with the opposition division's conclusion that document D2 disclosed only a single path sheet feeder; the alternative paper paths referred to had to be understood as relating to alternative single path constructions of the feeder mechanism.

The respondent proprietor further argued that as document D2 was a US patent, it was subject to the "best mode" requirement. It would therefore be entirely reasonable to expect that had the draughtsman intended to cover the concept of a dual path system he would have shown this in the described embodiment.

Reasons for the Decision

1. The appeal is admissible.
2. *Novelty*
 - 2.1 The novelty of the claimed invention was not in dispute.
3. *Inventive step*
 - 3.1 Document D2 is considered closest prior art and discloses a paper handling apparatus which, in the words of claim 1 of the patent, has a processing section (section D, Figure 1); a predetermined output location (tray 100); and a paper feeder system for delivering sheets to the predetermined output location (paper path through elements 68, 66, 70 and 72); the feeder system comprising: a sheet supply tray (tray 67), a first sheet feeding apparatus associated with said sheet supply tray for dispensing sheets therefrom (separation roll at supply tray 67, as shown in Figure 1); an auxiliary sheet feeding supply tray (tray 92); and a second sheet feeding apparatus associated with said auxiliary sheet feeding supply tray for dispensing sheets therefrom (separation roll at supply

- tray 92, as shown in Figure 1); wherein each of the sheet supply tray and auxiliary sheet feeding supply tray are arranged to be manually loadable by a user (self evident from document D2 as a whole).
- 3.2 The appellant opponent further submitted that, contrary to the opinion of the opposition division, document D2 also disclosed a dual path feeder system for selectively delivering sheets from the auxiliary tray 92 to either the processing section D or alternatively, directly to the output location 100.
- 3.2.1 Column 5, lines 33 to 38 of document D2 reads: *"In a preferred embodiment, the cover sheet or insert is an alternate paper that may or may not be imaged. In a preferred embodiment the special inserts from the tray 92 are conveyed to the registration station to the output tray 100. However, for inserts or dividers, the normal imaging and development process is inhibited."*
- 3.2.2 It is beyond doubt, therefore, that the disclosure in document D2 envisages the possibility that some insert sheets undergo the imaging process while others do not.
- 3.2.3 A closely following passage (column 6, lines 7 to 11) reads: *"It should be understood that it is within the scope of the invention to bypass the registration station and feed the inserts directly from the tray 92 to the output tray 100 for those inserts in which no imaging is required."*
- 3.2.4 The board is satisfied that, even though an alternative paper path is not as such shown in Figure 1, the skilled person would understand from document D2 that

two paths from the paper tray 92 to the output tray 100 may be provided such that insert sheets go through the processing section if they require imaging or bypass it if imaging is not required.

The board therefore agrees with the appellant opponent, that the above passage in document D2 (see paragraphs 3.2.1 and 3.2.3 above) must be understood as referring to insert sheets travelling either through the imaging section, of which the registration rolls 70 are a part, or directly to the output tray without passing through the imaging section. Contrary to the opinion of the opposition division (see III above), the two paper paths described are alternative paths within a single apparatus, rather than mutually exclusive alternative constructions.

3.2.5 The conclusion that document D2 discloses apparatus having a dual path paper feeder mechanism is further reinforced by the passage in claim 1 of document D2 which states in its last paragraph that the improvement in a copying machine comprises "means responsive to a first signal from the detecting means for providing insert sheets from the second supply station ..., the control including the option to provide the insert sheets to the transfer station or directly to the output tray."

3.2.6 As to the respondent proprietor's argument concerning the "best mode" requirement (see VI above), it is the board's view that the decision as to what a document discloses to the skilled person cannot ultimately depend on whether or not the disclosure in question

complies with any particular disclosure requirement imposed by US patent law.

3.2.7 For these reasons the board concludes that document D2 discloses a dual path paper feeder.

3.3 The subject matter of claim 1 thus differs from that of document D2 in that a movable decision gate is positioned adjacent a sheet feeding apparatus of an auxiliary sheet feeding supply tray. Document D2 does not disclose how the two paper paths of the dual paper feeder are actually started out of an initially common feed path.

3.4 Expressed in terms of the problem-solution approach, the objective problem to which the invention provides a solution relates to providing suitable means for directing insert sheets from a common initial path along one or the other of two possible paper paths.

3.5 Documents D3 demonstrably relates to the same field of technology as the claimed invention. The skilled person faced with the problem of finding means for selecting along which of two alternative paper paths an insert sheet has to travel, in order to pass through the imaging section or bypass that section and travel directly to the output tray, would therefore consider this document to be relevant prior art.

3.6 Document D3 discloses a movable decision gate 30 that serves to select along which of two paper paths 23 or 32 a sheet originating in paper tray 22 and travelling along a common initial paper path 23a is to travel (see Figure). In document D2 the problem is to direct insert

sheets from an output tray to one or the other of the two possible paper paths of the dual path sheet feeder, that is either to the registration rolls or alternatively directly to the output tray.

3.7 The positioning of the movable decision gate along the path, directly behind the paper tray as in the claimed invention or some way along a common path as in document D3, is determined merely by the desired geometry of the paper flow path and hence is a matter of routine considerations.

3.8 No inventive contribution was therefore required of the skilled person to use a decision gate of the kind shown in document D3 in a completely analogous manner in the apparatus of document D2.

3.9 For these reasons the invention claimed in claim 1 of the patent does not, in the board's judgement, involve an inventive step as required by Article 56 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside
2. The patent is revoked.

Registrar

Chair

S. Sánchez Chiquero

G. Eliasson