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**Datasheet for the decision
of 13 October 2006**

Case Number: T 0831/04 - 3.4.03

Application Number: 97900402.5

Publication Number: 0875045

IPC: G07D 7/00

Language of the proceedings: EN

Title of invention:
Sensing device

Patent Proprietor:
MEI, Inc.

Opponent:
GIESECKE & DEVRIENT GmbH

Headword:
Sensing/MEI Inc.

Relevant legal provisions:
EPC Art. 84

Keyword:
-

Decisions cited:
G 0009/91

Catchword:
-



Case Number: T 0831/04 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 13 October 2006

Appellant:
(Opponent)

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Respondent:
(Patent Proprietor)

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Representative:

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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
29 April 2004 concerning maintenance of
European patent No. 0875045 in amended form.

Composition of the Board:

Chairman: R. G. O'Connell
Members: E. Wolff
T. Bokor

Summary of Facts and Submissions

I. This is an appeal by the opponent as sole appellant against the maintenance of European patent 875 045 in amended form.

II. Oral proceedings were held before the board on 13 October 2006.

III. Claim 1 of the patent as granted reads:

"1. A device (50) for sensing the optical characteristics of a document moving relative to the device in a transport path, said device comprising:

a plurality of groups of light sources (8; 10), each said group generating light of a different wavelength and the light sources of each said group being spaced across a light-generating area optically coupled to said transport path by a first light path;

a plurality of light detectors (12) spaced across a light-detecting area optically coupled to said transport path by a second light path different to said first light path, said light detectors being arranged to receive light from a plurality of discrete detection areas on said transport path; and

a unitary light guide (16; 18) defining at least part of said first light path, said light guide having a light-receiving end, reflective sides, and a light-emitting end,

wherein the said light generating area is optically coupled to the light-receiving end of the light guide, the light guide conveying light generated by each of said light sources towards said transport path."

IV. Claim 1 of the final main request submitted during the oral proceedings reads (insertions bold, deletions struckthrough):

"1. A device (50) for sensing the optical characteristics of a ~~document~~ **banknote** moving relative to the device in a transport path, said device comprising:

light sources arranged to form a linear source array (8, 10), said light sources consisting of a plurality of groups of light sources (8; 10), each said group generating light of a different wavelength and the light sources of each said group and of the linear source array being spaced across a light-generating area optically coupled to said transport path by a first light path;

a plurality of light detectors (12) spaced across a light-detecting area optically coupled to said transport path by a second light path different to said first light path, said light detectors being arranged **to form a linear detector array disposed parallel to said source array and being arranged to receive light from a plurality of discrete detection areas on said transport path;** and

a unitary light guide (16; 18) defining at least part of said first light path, said light guide having a light-receiving end, reflective sides, and a light-emitting end,

wherein the said light generating area is optically coupled to the light-receiving end of the light guide, the light guide conveying light generated by each of said light sources towards said transport path."

Claim 1 of the final auxiliary request submitted during the oral proceedings appends a paragraph to claim 1 of the main request which it is not necessary to reproduce here.

- V. One month before the oral proceedings, the appellant opponent submitted a further document

E23 = Japanese published application 06225081

and a machine translation of the whole document, and requested that the board admit the document into the proceedings for the reason that it was highly relevant. The appellant opponent explained that the document had recently been brought to his attention by a customer of his client.

Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of document E23
 - 2.1 Initially the respondent proprietor objected strongly to the introduction of Document E23 as belated. The board indicated however that it was minded to admit the document for the reason that it appeared *prima facie* to be highly relevant for deciding on the novelty of claim 1 as maintained by the opposition division and asked the respondent proprietor whether he wished the case to be remitted to the opposition division in the event that the board should so decide. The representative replied that a remittal would not be acceptable to his client in view of the expense and delay involved particularly as it could lead to two further oral proceedings - with travel and hotel costs; he therefore reluctantly agreed to the document being admitted as being the lesser evil in the circumstances. It was accordingly admitted.
3. Amendment of the claims
 - 3.1 Having regard to the late submission of E23, the board allowed the respondent proprietor several opportunities to amend the claims in order to distinguish the claimed invention from the disclosure of this document. Following consecutive amendments, each objected to by the appellant opponent as not complying with the provisions of the EPC for reasons the board found persuasive, the board accorded the proprietor a final opportunity to file amended claim requests. In response,

the respondent proprietor filed the main and auxiliary request now on file.

4. Clarity (Article 84) EPC
 - 4.1 Amendments made to a claim in opposition appeal proceedings are to be fully examined by the board for compliance with the requirements of the EPC. (G 9/91, paragraph 19 of the reasons).
 - 4.2 The appellant opponent submitted that it was not clear what was referred to by "light sources of each said group and of the linear source array being spaced across a light-generating area ..." in the second paragraph of claim 1. Earlier in the same paragraph, the light sources were said to be "arranged to form a linear source array", the light sources further "consisting of a plurality of groups of light sources (8, 10), each said group generating light of a different wavelength". It was therefore totally unclear, what was meant by "the light sources of each said group and of the linear source array" being spaced across a light-generating area. The plain meaning of the expression was that spaced across the light generating area were not only those sources which were arranged in groups, but also other, non-grouped sources forming part of the array for which, however, there was no basis anywhere in the application.
 - 4.3 The objection applies also to the auxiliary request.
 - 4.4 The board accepts the appellant's argument that referring to light sources of the array as apparently distinct from light sources that are arranged in groups

of different colours introduces a lack of clarity into claim 1 of both the main and the auxiliary request. This lack of clarity is further compounded in that earlier in the same paragraph, it is not wholly clear whether the light sources in the phrase "light sources consisting of a plurality of groups of light sources" are in both instances the same, or, given the absence of a clear antecedent in respect of the second occurrence of the term, different.

5. The board is cognisant of the fact that the point in question may appear to be one which could have been resolved by yet further amendment. However, the board has a duty to conduct the proceedings in an impartial manner and had therefore to acknowledge the force of the appellant's submission that the respondent had already been given ample and repeated opportunity to frame appropriate amendments. Hence the board closed the debate without allowing the respondent proprietor any further attempts to overcome the objections which, in the judgement of the board, were rightly raised by the appellant opponent.
6. For the foregoing reasons the board concludes that claims 1 of the main and auxiliary requests do not meet the clarity requirement of Article 84 EPC.
7. It may appear regrettable, even harsh, that a patent should be revoked for what some may view as a "formalistic" requirement of clarity, especially when the asymptotic approach to a clear claim had almost reached its goal. The board's answer to such a sentiment is that in the fundamental social contract at the heart of the modern patent system the consideration

required of the applicant or proprietor is not only the disclosure of the alleged invention, but also the definition of the scope of protection sought. It would be neither logical nor legal to gloss over this definitional requirement in order to proceed to a consideration of the issues of novelty and inventive step so as to decide a case in a more "satisfying" way.

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

R. G. O'Connell