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**Datasheet for the decision
of 18 February 2009**

Case Number: T 0855/06 - 3.4.01

Application Number: 97113397.0

Publication Number: 0807906

IPC: G06K 9/00, G07D 7/00

Language of the proceedings: EN

Title of invention:

Method and apparatus for discriminating and counting documents

Patentee:

Cummins-Allison Corp.

Opponent:

DE LA RUE INTERNATIONAL LIMITED

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

EPC Art. 84, 56

EPC R. 68(2), 67

Keyword:

-

Decisions cited:

T 0582/91, T 1067/97

Catchword:

-



Case Number: T 0855/06 - 3.4.01

DECISION
of the Technical Board of Appeal 3.4.01
of 18 February 2009

Appellant:
(Opponent)

DE LA RUE INTERNATIONAL LIMITED
De La Rue House, Jays Close
Viables, Basingstoke
Hants RG22 4BS (GB)

Representative:

Skone James, Robert Edmund
Gill Jennings & Every LLP
Broadgate House
7 Eldon Street
London EC2M 7LH (GB)

Respondent:
(Patent Proprietor)

Cummins-Allison Corp.
891, Freehanville Drive
Mount Prospect,
Illinois 60056 (US)

Representative:

Grünecker, Kinkeldey,
Stockmair & Schwanhäusser
Anwaltssozietät
Leopoldstrasse 4
80802 München (DE)

Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
3 April 2006 concerning maintenance of European
patent No. 0807906 in amended form.

Composition of the Board:

Chairman: B. Schachenmann
Members: P. Fontenay
G. Assi

Summary of Facts and Submissions

I. The appeal lies from the interlocutory decision of the opposition division to maintain the European patent No. 807 906 in an amended form. The corresponding patent application No. 97 113 397.0 was filed as a divisional application of earlier patent application No. 95 913 629.2, referred to hereinafter as the "parent application". The decision of the opposition division was announced during oral proceedings held on 31 January 2006 and dispatched on 3 April 2006.

II. The appellant (opponent) lodged an appeal against this decision by notice of appeal received by facsimile on 6 June 2006 and paid the prescribed appeal fee on the same day. The appellant requested that the impugned decision be set aside and the European patent be revoked in its entirety. The written statement setting out the grounds of appeal was filed on 24 July 2006.

The respondent (patentee) requested that the appeal be dismissed and the patent be maintained in an amended form according to a main request filed with letter of 16 January 2009. Alternatively, it requested that the patent be maintained on the basis of amended sets of claims according respectively to auxiliary requests I and II filed with the letter of 16 January 2009 or auxiliary requests III to VIII filed with letter of 12 December 2006, with the correction of clerical errors as requested by letter of 26 June 2008.

III. Both parties stressed in their submissions that the documents annexed to the interlocutory decision were not concordant with the actual outcome of the

opposition proceedings since they did not correspond to those upon which the decision was actually based. The respondent therefore requested in its reply to the statement setting out the grounds of appeal a correction of the Decision in accordance with Rule 89 EPC 1973.

By a decision according to Rule 89 EPC 1973 dated 4 October 2007, the opposition division corrected its previous interlocutory decision and issued a correspondingly amended version of the "Druckexemplar", reflecting the actual outcome of the proceedings before the opposition division. The Board acknowledged in a communication of 8 December 2008 that the documents annexed to the decision according to Rule 89 EPC 1973, with 5 claims, were consistent with the minutes of the oral proceedings before the opposition division.

IV. The following documents were relied on during the appeal procedure:

- D1: WO-A-93/23824;
- D2a: JP-A-56-136689;
- D2b: English translation of D2a;
- D3: EP-A-613 107;
- D4: EP-A-168 202;
- D5a: Invoice dated 25 March 1994;
- D5b: Delivery note dated 4 March 1994;
- D5c: "Autodeposit" Users Manual TCD9210 dated December 1993;
- D5d: Declaration by John A. Skinner dated 11 February 2004;
- D5e: Declaration by V. Glaser dated 20 October 2003;
- D5f: Declaration by V. Glaser dated 15 December 2008

D7: US-A-4 420 153.

V. According to corresponding requests of the appellant and the respondent, the parties were summoned to attend oral proceedings. They were held on 18 February 2009 before the Board at which both parties were represented.

VI. Claim 1 according to the main request reads as follows (with feature identification letters, in bold, added by the Board):

"1. A currency discriminator that counts and discriminates bills comprising:

a) a discriminating unit by which bills are passed; the discriminating unit being adapted to flag unidentified bills; and

b) counters keeping track of the value of bills discriminated; and

j) one or more output receptacles for receiving bills after being discriminated by said discriminating unit;

c) wherein the discriminating unit is adapted to flag a bill having a predetermined characteristic by transferring the flagged bill to a location where it can be conveniently examined by an operator and then suspending the operation of the discriminator;

d) denomination selection elements to enable the operator with the depression of a single button to indicate the denomination of an unidentified but acceptable bill, to cause the value of the bill to be reflected in any appropriate counters, and to cause the discriminator to resume operation; and

e) a continuation selection element to enable the operator to cause the discriminator to resume operation

without adversely affecting any counters when an unidentified bill is determined to be unacceptable, and **f)** an examining station; and **g)** wherein said unidentified bill is transferred to the examining station before the discriminator halts, **h)** wherein the examination station allows access to said unidentified bill such that the bill may be removed from the currency discriminator; and **i)** wherein upon determination that a bill is acceptable, the bill is transferred to one of the one or more output receptacles.

Claim 1 according to auxiliary request I reads as follows (with feature identification letters (in bold) and underlines, indicating the main differences in relation to claim 1 of the main request, added by the Board):

1. A currency discriminator that counts and discriminates bills comprising:
 - a)** a discriminating unit by which bills are passed; the discriminating unit being adapted to flag unidentified bills; and
 - b)** counters keeping track of the value of bills discriminated; and
 - k)** an input receptacle for receiving a stack of bills;
and
 - j)** one or more output receptacles for receiving bills after being discriminated by said discriminating unit; and
 - l)** a transport mechanism for transporting said bills one at a time, from said input receptacle past said discriminating unit and to said one or more output receptacles; and

- f)** an examining station;
- c)** wherein the discriminating unit is adapted to flag a bill having a predetermined characteristic by transferring the flagged bill to the examining station where it can be conveniently examined by an operator and then suspending the operation of the discriminator; and
- d)** denomination selection elements to enable the operator with the depression of a single button to indicate the denomination of an unidentified but acceptable bill, to cause the value of the bill to be reflected in any appropriate counters, to cause the discriminator to resume operation, and to cause the transport mechanism to transfer the unidentified but acceptable bill from the examining station to one of the one or more output receptacles; and
- e)** a continuation selection element to enable the operator to cause the discriminator to resume operation without adversely affecting any counters when an unidentified bill is determined to be unacceptable;
- g)** wherein said unidentified bill is transferred to the examining station before the discriminator halts;
- h)** wherein the examination station allows access to said unidentified bill such that the bill may be removed from the currency discriminator; and
- i)** wherein upon determination that a bill is acceptable, the bill is transferred to one of the one or more output receptacles."

Claim 4 of auxiliary request I, as filed on 16 January 2009, reads:

"4. A method of discriminating and counting currency bills using a currency discriminator device comprising:

moving bills one at a time by means of a transport mechanism from an input receptacle past a discriminating unit and to one or more output receptacles; and
counting their value;
flagging an unidentified bill by transferring the flagged bill to a location where it can be conveniently examined by an operator and then suspending the operation of the discriminator;
wherein unidentified bills are transferred to an examining station before the discriminator halts, the examining station being the location where the unidentified bill can be conveniently examined by an operator;
the operator then examining the bill and determining whether the bill is acceptable or not and either:

(a) depressing an appropriate denomination selection element whereby the depression of a single button enables the operator to indicate the denomination of an unidentified but acceptable bill, to cause the value of the bill to be reflected in any appropriate counters, to cause the discriminator to resume operation, and to cause the transport mechanism to transfer the unidentified but acceptable bill from the examining station to one of the one or more output receptacles; or

(b) depressing a continuation selection element whereby the depression of the continuation selection element enables the operator to cause the discriminator to resume operation without adversely affecting any counters when an unidentified bill is determined to be unacceptable; and

wherein said unidentified bill which is determined to be unacceptable is removed from the examining station and from the currency discriminator; and wherein upon determination that a bill is acceptable, the bill is transferred to one of the one or more output receptacles."

The main and first auxiliary requests further include dependent claims 2-3 and 5 depending respectively on independent claims 1 and 4.

VII. In a letter dated 6 February 2009, the appellant objected to the admissibility of the main request and auxiliary requests I and II which, in its view, were late filed and contravened the dispositions of Article 84 EPC 1973 and Article 123(2) EPC. At the oral proceedings the appellant further elaborated on these issues and also argued that the subject-matter of claim 1 according to the main request and auxiliary request I was not inventive in view of document D1 in combination with documents D2 or D3. Finally, in the event that the Board was not convinced by this argumentation, the appellant reiterated its intention to object to the patentability of the claimed discriminator on the basis of a prior use, namely, the prior sale to the Sparkasse in Wismar (Germany) of the "cashmaster deposit 3D/UV" product (cf. documents D5a to D5f, referred to in the following as D5).

VIII. In this decision reference is made to the provisions of the EPC 2000, which entered into force as of 13 December 2007, unless the former provisions of the EPC 1973 still apply to pending applications.

Reasons for the Decision

1. The appeal is admissible.
2. *Late filed requests*
 - 2.1 The filing of the main request and auxiliary requests I and II with letter of 16 January 2009 followed the issuance by the Board of Appeal of a provisional opinion pursuant to Article 15(1) RPBA in which the attention of the parties had been drawn to potential deficiencies of the requests then on file with regard to clarity, added subject-matter and inventive step. While the Board acknowledges that, as stressed by the appellant, some of the aspects developed in said communication had already been raised by the appellant in its statement setting out the grounds of appeal, it nevertheless accepts the argument of the respondent that it was confident to be able, at this early stage of the appeal procedure, to convince the Board that the objections were not justified. It was only after the Board appeared to share some of the concerns expressed by the appellant that the respondent considered it expedient to correct its strategy and modify some of its requests accordingly.

The Board does not consider, under these circumstances, the behaviour of the respondent to be abusive or unreasonable. On the contrary, if a respondent/patentee reacted to the statement of grounds of appeal by filing, just as a precautionary measure, various auxiliary requests taking account of all the objections raised, a proliferation of requests

would result. Such an approach would clearly be detrimental to the procedural economy of the appeal procedure, which should rather concentrate on matters the Board considers of significance and susceptible of affecting its outcome.

2.2 Consequently, the main request and auxiliary requests I and II filed on 16 January 2009 constitute the reaction to the communication of the Board of 8 December 2008. They were filed within the date set in said communication, i.e. one month before the oral proceedings, and directly address issues raised therein. Moreover, they do not affect the general framework of the appeal procedure as defined by the initial reply of the respondent to the grounds of appeal (Article 12(b) RPBA). For these reasons, in the exercise of its discretionary power, the Board admits the main request and auxiliary requests I and II into the appeal procedure (Article 13(1) RPBA).

3. *Main request*

3.1 *Added subject-matter*

3.1.1 Claim 1 of the main request specifies that the currency discriminator comprises one or more output receptacles for receiving bills after that they have been discriminated by the discriminating unit. This definition constituted, according to the appellant, added subject-matter under Article 123(2) EPC since the original application disclosed, respectively, in association with Figure 3, an embodiment with one output receptacle but without any reject receptacle and, in association with Figure 2, an embodiment with

a plurality of output receptacles and one reject receptacle. In particular, the feature of a plurality of output receptacles in claim 1 of the main request constituted, in the appellant's view, an unallowable generalisation of the embodiment of Figure 2 since it also covered the option of a plurality of output receptacles without reject receptacle.

3.1.2 The Board does not agree with this analysis and notes that the application as filed explicitly refers, in independent claims 1 and 6, to "one or more output receptacles" without incorporating the additional feature of a reject receptacle, thus providing the support required under Article 123(2) EPC.

3.1.3 Although the original parent application (EP-95 913 629) does not provide the corresponding basis for the objected feature, the Board considers that the requirements of Article 76(1) EPC 1973 are nevertheless met. Reference is made to figure 57 in the original parent application as published under the PCT (cf. WO-A-95/24691) and to the corresponding description on page 135, line 15 to page 136, line 21, which correspond, respectively, to figure 2 and the passage in column 10, line 33 to column 11, line 30 of the published application EP-A-807 906 underlying the patent in suit.

Although disclosing output receptacles in combination with a reject receptacle, the Board holds admissible the generalisation resulting from the selection of the feature of the plurality of output receptacles and its introduction in claim 1, while omitting the reject receptacle. According to the established jurisprudence

of the boards of appeal, the selection of a feature presented originally in combination with other features does not constitute added subject-matter if the skilled person would recognize that there was clearly no close functional or structural relationship between the selected and remaining features (cf. decisions T 582/91, point 2.2; T 1067/97, point 2.1).

In the present case, a particular structural relationship between the various types of receptacles is not apparent from the parent application as filed. The irrelevance of the structure of the reject and output receptacles is further confirmed by the fact that this aspect is not even addressed therein. There is also no specific functional relationship between both kinds of receptacles since each collecting action is being carried out independently from the other.

For these reasons, the selection of the feature as to the plurality of the output receptacles, while omitting the feature of the reject receptacle, and its introduction in claim 1 of the main request does not contravene the requirements of Article 76 EPC 1973.

3.2 *Inventive step*

- 3.2.1 The Board concurs with the view expressed by the appellant and agreed with by the respondent that document D1 discloses a currency discriminator which reproduces features a, b, c, e and j of claim 1 according to the main request (cf. Figure 1; page 8, lines 9-19; page 12, lines 20-29, page 22, lines 25-31; page 23, lines 21-27; page 25, lines 6-14). Concerning

feature j, it was stressed that solely the alternative of one output receptacle was disclosed in D1.

3.2.2 The Board further shares the analysis put forward by the appellant according to which features f, g, h, and i are also disclosed in D1. This analysis relies essentially on the view that the output stacker in D1 can be equated with the examining station recited in claim 1. In fact, although referring to two different units (output receptacle(s) and an examining station), the wording of claim 1 does not exclude that these units may be embodied by one and the same entity. This interpretation of the claim is based on the findings that:

α) it does not affect the technical understanding of the claimed invention with regard to the technical problem it intends to solve (cf. patent specification, paragraphs [0014], [0015]), and

β) the wording of the claim does not imply that the examining station and output receptacle(s) are necessarily positioned at different locations.

3.2.2.1 It is firstly noted, with regard to finding α), that the terms "examining station" and "output receptacle(s)" used to define the two entities are not mutually excluding each other. Both items could also be defined in functional terms as, respectively, a station allowing the flagged bill to be examined and one or more receptacles for collecting output bills. Since these functions, as such, are not incompatible and could therefore be performed by the same device, the Board concludes that the terminology used in the claim to define the two concepts is not sufficient, as

such, to establish that the two concepts necessarily refer to different entities.

3.2.2.2 Concerning aspect β) particular attention is drawn to feature (i) of the claim according to which: "upon determination that a bill is acceptable, the bill is transferred to one of the one or more output receptacles". This feature appears to suggest that the one or more output receptacles are situated at a location which is not identical with the location where the bills are determined to be acceptable, i.e. the examining station. However, nothing in the wording of claim 1 permits to establish that the only location to judge the acceptability of the bills is the examining station. This interpretation is corroborated by the description according to which a first check to distinguish between identified (acceptable) and unidentified bills is carried out by the discriminating (and authenticating) unit before the unidentified bills eventually reach the examining station (cf. patent specification, column 8, lines 31-40; column 9, lines 30-47). This first authenticating and discriminating step can, as well, be equated with an acceptability check.

3.2.2.3 It is finally emphasized that feature (i) should be interpreted in the context of a device claim, i.e. as a feature corresponding to a functional limitation of the claimed discriminator according to which said discriminator determines whether the bill is acceptable and then reacts accordingly by transferring it to the one or more output receptacles. This interpretation would imply, in the light of the description, that the location for determining the

acceptability of the bills indeed corresponds to the discriminating unit where the bills are to be identified. The converse conclusion, namely that this location corresponded to the examining station, would be at odds with the description, which does not make the transfer of the bill after examination conditional on its acceptability (said criterion being assessed by an operator, i.e. externally of the discriminator), but on the depression of the selection element (cf. patent specification, column 9, lines 2-10; column 9, line 58 - column 10, line 9).

3.2.2.4 Consequently, the current wording of claim 1 of the main request does not exclude that the examining station and the output receptacle(s) relate to one and the same entity.

3.2.2.5 A consequence of the above analysis is that features f to i of claim 1 of the main request are anticipated by document D1. More specifically, the system stacker (20) disclosed in D1 defines an examining station (feature f) to which an unidentified bill is transferred before the discriminator halts (feature g) as recited in claim 1 (cf. D1, page 22, lines 25-31; page 23, lines 21-25 and page 24, lines 22-29). As derivable from the passage in D1, on page 26, lines 13-16, the system stacker (examining station) allows access to the unidentified bill such that it may be removed from the currency discriminator as recited in feature (h). Moreover, upon determination, following the scanning process, that a bill is acceptable, the bill is transferred to the output receptacle as recited in feature (i) (cf. D1, page 8, lines 9-19).

3.2.3 The above analysis implies that the only difference between the claimed subject-matter and the discriminator disclosed in D1 resides in feature (d) concerning the denomination selection elements.

The technical effect provided by this feature is to permit that the value of unidentified but acceptable bills be taken into account and normal operation of the discriminator be resumed thereafter.

The problem solved therefore consists in improving the efficiency of the discriminator when treating unidentified bills (cf. patent specification, paragraphs [0015], [0016]).

3.2.4 Document D2a (cf. translation D2b) relates to a sorting apparatus which incorporates a discriminating and counting unit. It directly addresses the problem associated with unidentified bills (cf. D2b, page 3, lines 9-12) and discloses that an operator may indicate the denomination of an unidentified but acceptable bill by depressing a corresponding switch so that the counters take the actual value of the bill into account and the system resumes operations thereafter (cf. D2b, page 5, line 23 - page 6, line 2; page 7, lines 2-6 and 18-20).

3.2.5 The Board holds the view that a proper application of the problem solution approach requires that the merit of the claimed subject-matter be assessed on the sole basis of the addition of feature (d) concerning the denomination selection elements, which constitutes the only distinguishing feature over D1. It thus rejects the respondent's argumentation that a sorting out of

single features should be avoided considering, under the present circumstances, that the denomination selection means were closely associated to the feature of the examining station. In the respondent's opinion, the provision of an examining station, allowing an operator to remove and carry out an additional examination of the bill, conferred on the claimed discriminator its specificity with regard to the prior art, which specificity should necessarily be acknowledged when deciding upon the inventive merits of the invention.

These arguments did not convince the Board. The aspects referred to by the respondent relate to a specific use of the claimed discriminator, when compared with the system of D1. However, although reflected by the wording employed in the claim to define various features of the discriminator, this specific use has no bearing on structural or functional limitations of the claimed discriminator which would define further distinctions over the system of D1: despite the fact that D1 does not address the issue of examining the "no call" bills, as stressed by the respondent, the system stacker disclosed therein is, in effect, well adapted for allowing such an examination to take place. Consequently, the definition of the technical problem to be solved must not reflect the aspect of examination of unidentified bills as such since, in this respect, it can not rely on any concrete structural or functional difference between the claimed subject-matter and the closest prior art (D1).

3.2.6 It follows that the skilled person would consider the teaching of D2a only insofar as it permits to solve the technical problem defined in point 3.2.3 above. This implies that, although D2a consistently emphasizes that discrimination and counting is made without removal of the bills (cf. D2b page 3, line 22 - page 4, line 5; page 8, lines 5-10), the skilled person would only take over the functionality associated to the denomination selection means disclosed therein, while keeping the ability of the system of D1 as to a free access to unidentified bills.

For these reasons, the subject-matter of claim 1 derives in an obvious manner from a combination of D1 with D2a and is therefore not inventive in the sense of Article 56 EPC 1973.

4. *First auxiliary request*

4.1 *Added subject-matter - Article 123(2) EPC; Article 76 EPC 1973*

4.1.1 The analysis made above in relation with the main request as regards a generalisation resulting from the omission of the reject receptacle in claim 1, insofar as it refers to the alternative of a multiplicity of output receptacles, applies *mutatis mutandis* to claim 1 of auxiliary request I. The absence of the feature as to the reject receptacle thus does not lead to added subject-matter.

4.1.2 The appellant underlined that the application as filed did not disclose that the discriminating unit

transfers the flagged bill to the examining station, as recited in claim 1 of auxiliary request I.

Although this feature as to the ability of the discriminating unit to transfer the flagged bill to the examining station was already present, as such, in claim 1 as granted, added subject-matter would result, in the appellant's view, from the introduction in claim 1 of auxiliary request I of the feature of the transport mechanism. This amendment would lead to a definition according to which it was the discriminating unit which transfers the flagged bill to the examining station. This feature was, however, devoid of any support in the application as filed.

The Board observes, firstly, that the feature as to the transport mechanism is disclosed in the original application (cf. column 10, lines 38-41; column 11, lines 36-51; figures 2, 3) and that a corresponding basis exists in the original parent application. Secondly, contrary to the appellant's view, the introduction of the feature concerning the transport mechanism in claim 1 of auxiliary request I does not modify the technical understanding associated to the feature of the discriminating unit, as already recited in granted claim 1. More specifically, the indication that the discriminating unit transfers the flagged bill to the examining station is not affected by the added statement according to which the transport mechanism and discriminating unit constitute distinct entities.

Since the Board, contrary to the appellant's view, cannot identify in the amendments which have been

carried out in claim 1 of auxiliary request I any new technical information constitutive of new subject-matter in the sense of Article 123(2) EPC, it concludes that the objection is not substantiated.

4.2 *Clarity*

According to the appellant, the introduction in claim 1 of auxiliary request I of the feature of the transport mechanism would also lead to a lack of clarity of the claimed discriminator. In particular, the fact that the definition of the transport mechanism did not refer to the examining station would render the indication in claim 1 that the transport mechanism transfers the unidentified bill from the examining station to the output receptacle(s) unclear since the claim was silent as to the manner this functionality would be performed.

The appellant's analysis seems to rely on the assumption that the absence of any reference to the examining station in the definition of the transport mechanism implied that a transport of bills between the examining station and other units of the claimed discriminator would not be possible. However, this position is in no way corroborated by the actual wording of the claim and therefore rejected by the Board.

In fact, the terms of the claim and, more specifically, the definition of the transport mechanism does not imply that it is restricted to the transport of bills between the units actually recited in this definition. There is, hence, no contradiction

between the definition of the transport mechanism and the indication that bills are transported from the examining station to the output receptacles.

Furthermore, the absence of any reference to the examining station in the definition of the transport mechanism is fully consistent with the embodiments of figures 2 and 3 of the patent specification according to which a transport of the bill to the output receptacle(s) via the examining station does not systematically occur but is limited to unidentified bills.

In the absence of any contradiction in the wording of claim 1 of the first auxiliary request, the Board concludes that the requirements of Article 84 EPC 1973 as to clarity are met.

4.3 *Inventive step*

- 4.3.1 The explicit mention in claim 1 of auxiliary request I that the depression of a single button causes the transport mechanism to transfer the unidentified but acceptable bill from the examining station to one of the one or more output receptacles excludes that the two units might correspond to one and the same entity. Therefore, the analysis of D1, relied on in relation with the main request, does not apply to claim 1 of auxiliary request I.

Consequently, the claimed discriminator distinguishes from the device of D1, firstly, by feature (d), secondly, in that it further comprises an examining station located upstream of the output receptacle(s) which allows access to unidentified bills such that

said bills may be removed from the discriminator and, finally, in that upon depression of a single button the transport mechanism transfers the unidentified but acceptable bill from the examining station to the one or more output receptacles.

- 4.3.2 The provision of an examining station upstream of the one or more output receptacles permits access to the examining station and the bill it contains, before it reaches the output receptacle.

The problem solved by this configuration is to allow the operator to remove the bill from the examining station and carry out a further examination of the bill, whether manually or by means of more sophisticated authentication means, before resuming operation.

- 4.3.3 According to the appellant, the fact that in D2a the unidentified bills were counted and sorted by an operator without being removed from the examining station (cf. D2b page 8, lines 5-10) or that, in D3, the access to the examining station (tray 105) led to a cancellation of the transaction, did not affect the analysis according to which a combination of D1 with D2a or of D1 with D3 would lead to the claimed subject-matter. In the appellant's view, when taking over the teaching of D2a, the skilled person would keep the possibility disclosed in D1 of allowing access to the unidentified bill. Similarly, when combining D1 with D3, the skilled person would keep the ability of the discriminator of D1 of resuming operation after the detection and removal of unidentified bills.

With regard to D3, the appellant emphasized that the wording of claim 1 of auxiliary request I did not exclude an intermediate stacking of the unidentified bills in the examining division. The introduction in D1 of the temporary store 105 of D3, which stored the discriminated bills before they were passed to a deposit region, would thus effectively lead to the claimed subject-matter.

The respondent objected to this analysis in that it did not take into account the relationship existing between feature (d) and the features relating to the examining station. Particular emphasis was drawn to the amended wording of feature (d) specifying the interaction between the various elements of the discriminator.

The Board concurs with the respondent in its finding that this interaction, which defines further contributions of the invention over the prior art as disclosed in D1, should be acknowledged when deciding on the inventive merits of the invention. It therefore dismisses the argumentation of the appellant which consisted in defining, on the basis of the identified differences, partial problems to be solved independently.

Independently of the presence of one or a plurality of output receptacles, the examining station allows, in accordance with the claimed invention, a further examination of the bill (discrimination and/or authentication) to be carried out externally of the

discriminator (e.g. by the operator), while permitting operation to be resumed thereafter.

Neither D2a nor D3 suggests to carry out an external examination of unidentified bills. Consequently, a combination of D1 with D2a or D3 and any ensuing adaptation of the discriminator of D1 in view of D2a or D3, required in order to arrive at the claimed subject-matter, would only result from ex post facto considerations.

It follows that the provision of an examining station upstream of the one or more output receptacles in the discriminator of D1 is not obvious to a person skilled in the art (Article 56 EPC 1973), starting from Document D1 as closest prior art and taking into account the teaching of documents D2a and D3.

- 4.3.4 The analysis developed above applies *a fortiori* to claim 4 of auxiliary request I as to the method of discriminating and counting currency bills, since it explicitly incorporates the steps of an operator examining and determining whether the bill is acceptable and removing unacceptable bills from the examining station.

Claim 4 of auxiliary request I therefore meets the requirements of Article 56 EPC 1973 in view of a combination of document D1 with D2a or of D1 with D3.

5. *Prior use - substantial procedural violation - remittal to the first instance - reimbursement of the appeal fee*

5.1 At the oral proceedings, the appellant declared that it also objected to the patentability (novelty, inventive step) of claim 1 of auxiliary request I on the basis of the prior use identified above as D5. It emphasized that the facts and evidence relating to this prior use had already been filed with the notice of opposition and that the objection based thereupon had never been abandoned. The indication in point 2 of the minutes of the oral proceedings before the opposition division that the opponent requested revocation of the patent as a whole on the grounds of lack of inventive step over a combination of D1 with D2 or D1 with D3 was certainly not to be construed as limiting the scope of the opposition. The appellant further pointed out that its intention and requests constantly sought to obtain the revocation of the patent as a whole, as was actually confirmed by point 9 of said minutes, and that it never dropped this additional attack. The representative of the respondent indicated during the oral proceedings before the Board of Appeal that he was not able to recall that the appellant/opponent had withdrawn any of its objections during the oral proceedings before the opposition division.

The Board further notes that repeated references to the prior use are made in section "Facts and Submissions" of the impugned decision (cf. points 2, 3.6, 4.2, 4.6, 4.7, 4.11 to 4.13). These paragraphs contain a summary of the parties' arguments with regard to this alleged prior use and do not mention any abandonment of this objection against the granted patent. Consequently, since it cannot be inferred from the file wrapper that the objections relying on D5

have been abandoned and since such abandonment can also not be presumed, the lack of reasoning, with regard to this line of argumentation, in the decision under appeal constitutes a substantial procedural violation (Rule 68(2) EPC 1973).

- 5.2 The appellant declared during the oral proceedings before the Board that it wished to obtain a decision of the opposition division on that issue so as to have the possibility to later adapt its argumentation before the Board of Appeal. For these reasons, relying on the generally recognized procedural principle to have a matter decided by two instances, the appellant requested remittal of the case to the first instance for further prosecution.

Taking note that the respondent agreed to have the issue of prior use decided by two instances and therefore agreed to the request for remittal, the Board decided, in the absence of special reasons to the contrary, that the case be remitted to the first instance for further prosecution (Rule 11 RPBA).

- 5.3 Since the appeal filed by the appellant is allowable insofar as it leads to the setting aside of the impugned decision and since a substantial procedural violation affected the proceedings before the opposition division, reimbursement of the appeal fee is equitable (Rule 67 EPC 1973).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.
3. The reimbursement of the appeal fee is ordered.

The Registrar

The Chairman

R. Schumacher

B. Schachenmann