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**Datasheet for the decision
of 15 February 2011**

Case Number: T 2044/07 - 3.4.03

Application Number: 99959772.7

Publication Number: 1151420

IPC: G07D 7/12

Language of the proceedings: EN

Title of invention:

Valuable paper distinguishable by a validator for
discriminating bills

Applicant:

JAPAN CASH MACHINE CO., LTD.

Headword:

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Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Added subject-matter"

Decisions cited:

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Catchword:

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Case Number: T 2044/07 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 15 February 2011

Appellant:

JAPAN CASH MACHINE CO., LTD.
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 2 July 2007
refusing European patent application
No. 99959772.7 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: G. Eliasson
Members: T. Häusser
T. Bokor

Summary of Facts and Submissions

- I. The appeal concerns the decision of the examining division refusing European patent application No. 99 959 772.
- II. In a communication annexed to the summons to oral proceedings, as requested by the appellant, the board was of the provisional opinion that the subject-matter of claim 2 of the main and auxiliary request extended beyond the content of the application as filed (Article 123(2) EPC). Furthermore, it appeared that the subject-matter of claim 1 of the main and auxiliary request would not involve an inventive step.

Thereupon the appellant informed the board that he would not be represented at the oral proceedings, that the request for oral proceedings was withdrawn, and that a decision of the board was awaited in due course.

- III. Oral proceedings were held in the absence of the appellant.
- IV. The appellant requested in writing that the decision under appeal be set aside and a patent be granted on the basis of the following documents:

Main request:

- claims 1-7 of the CLAIM SET A filed with the grounds of appeal dated 12 November 2007.

Auxiliary request:

- claims 1-8 of the CLAIM SET B filed with the grounds of appeal dated 12 November 2007.

V. The wording of claims 1 and 2 of the main request reads as follows:

"1. Use of a validator (10) of the type provided in gaming or gambling accommodations for authenticating bills,

the validator (10) having a sensor means (16) for detecting a distinctive visible portion of a bill which is for example in portrait, watermark, indication of denomination or serial number inserted into the validator (10), in order to dispense winnings from a gaming machine in the form of valuable papers (50),

wherein the valuable paper (50) is one selected from tokens and substitutes for currency,

the valuable paper (50) comprises on at least one surface of the paper (50) a characteristic pattern (51) detectable by the sensor means (16) of the validator (10) to validate the valuable paper (50) inserted into and examined by the validator (10),

characterized in that the characteristic pattern (51) is printed on the valuable papers (50) with invisible transparent or semi-transparent ink that contains a detectable ingredient for absorbing or reflecting infrared or ultraviolet rays or fluorescent material for producing an optical change,

the valuable paper (50) has its width substantially the same as that of the bill,

the characteristic pattern (51) of the valuable paper (50) is formed on substantially the same position in width as that of the distinctive portion of the bill,

the sensor means (16) comprises an optical sensor (41) for detecting the characteristic pattern (51) on

the valuable paper (50) and the distinctive portion of the bill."

"2. Use of a validator (10) as claimed in claim 1, characterized in that the characteristic pattern (51) is printed on the valuable paper (50) and invisibly covered and concealed with a mask coating (52) printed on the characteristic pattern (51), the mask coating (52) is formed with an ingredient permeable by infrared or ultraviolet ray."

The wording of claims 1 and 2 of the auxiliary request reads as follows:

"1. Use of a validator (10) of the type provided in gaming or gambling accommodations for authenticating bills, the validator (10) having a sensor means (16) for detecting a distinctive visible portion of a bill which is for example in portrait, watermark, indication of denomination or serial number inserted into the validator (10), in order to dispense winnings from a gaming machine in the form of valuable papers (50), wherein the valuable papers (50) are inserted into and examined by the validator (10), the valuable papers (50) comprising on at least one surface of the paper (50) a characteristic pattern (51) detectable by the sensor means (16) of the validator (10) to validate the valuable papers (50) inserted into the validator (10), characterised in that the characteristic pattern (51) comprises a bar code printed on the valuable papers (50) with invisible transparent or semi-transparent ink that contains a detectable ingredient for absorbing or reflecting infrared or ultraviolet ray or fluorescent material for producing an optical change."

"2. Use of a validator (10) as claimed in claim 1, characterised in that the bar code is printed on the valuable paper (50) and invisibly covered and concealed with a mask coating (52) printed on the bar code, the mask coating (52) is formed with an ingredient permeable by infrared or ultraviolet ray."

VI. The appellant argued essentially as follows:

There was a basis in the description for defining the distinctive portion of the bill as being, for example a portrait, watermark, indication of denomination or serial number. As these were all visible markings, and the distinctive portion was now defined more particularly in claim 1 of the main request and claim 1 of the auxiliary request, these claims met the requirements of Article 123(2) EPC.

None of the documents cited in the decision under appeal disclosed the use of a validator of banknotes for dispensing winnings in the form of valuable papers from a gaming machine. The valuable papers were of no value outside the gaming establishment and enabled the establishment to avoid providing large amounts of banknotes from a gaming machine, thus providing improvements in security.

Reasons for the Decision

1. Admissibility

The appeal is admissible.

2. Amendments

2.1 The application is concerned with a valuable paper 50 comprising on a surface a characteristic pattern 51, which is detectable by a sensor 16 in order to determine the authenticity of the paper (page 1, last line - page 2, line 9).

2.2 The application also discloses two alternatives for preventing forgery of the valuable paper 50 (page 2, lines 27-29):

- (1) The characteristic pattern can be printed with invisible transparent or semi-transparent ink (page 7, lines 1-2). Thereby the user is prevented from discerning the characteristic pattern, thus preventing forgery of the valuable paper (page 7, lines 12-13).
- (2) The characteristic pattern can be covered by a mask coating (page 7, line 27 to page 8, line 2). In this way the characteristic pattern 51 is concealed, so that it cannot be discerned; forgery of the valuable paper is thus prevented (page 2, lines 27-29 and page 7, lines 27-29).

The first alternative is implemented in the first embodiment (Figure 3 and page 7, lines 1-13), whereas the second alternative is implemented in the second embodiment (Figures 4 and 5, and page 7, line 14 to page 8, line 5) and in the third and fourth embodiments (Figures 6 and 7, and page 8, lines 6-11).

2.3 In claim 1 of the main request it is specified that:

- (i) "the characteristic pattern (51) is printed on the valuable papers (50) with invisible transparent or semi-transparent ink",

which corresponds to the first alternative mentioned above under point 2.2.

On the other hand, in claim 2 of the main request it is specified that:

- (ii) "the characteristic pattern (51) is printed on the valuable paper (50) and invisibly covered and concealed with a mask coating (52) printed on the characteristic pattern (51)",

which corresponds to the second alternative mentioned above.

Claim 2 of the main request is dependent on claim 1 of the main request and thus includes all features of claim 1. Claim 2 relates therefore to the combination of the features (i) and (ii).

However, the combination of these features has not been disclosed in the application as filed. Furthermore, as both alternatives achieve the same goal of preventing forgery, it would appear superfluous to use a combination of both alternatives to achieve that goal. The combination of the features (i) and (ii) is therefore not directly and unambiguously derivable from the application as filed. Claim 2 of the main request

therefore contains subject-matter which extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

2.4 Similarly, in claim 1 of the auxiliary request it is specified that:

(i)' "the characteristic pattern (51) comprises a bar code printed on the valuable papers (50) with invisible transparent or semi-transparent ink",

which corresponds again to the first alternative mentioned above under point 2.2.

In claim 2 of the auxiliary request it is specified that:

(ii)' "the bar code is printed on the valuable paper (50) and invisibly covered and concealed with a mask coating (52) printed on the bar code",

corresponding to the second alternative mentioned above.

Claim 2 of the auxiliary request is dependent on claim 1 of the auxiliary request and thus relates to the combination of the features (i)' and (ii)'. .

For reasons corresponding to those mentioned above under point 2.3 the combination of the features (i)' and (ii)' is not directly and unambiguously derivable from the application as filed. Claim 2 of the auxiliary

request therefore contains subject-matter which extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

2.5 Therefore, neither the main request nor the auxiliary request is allowable in view of the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Sánchez Chiquero

G. Eliasson