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**Datasheet for the decision
of 25 July 2013**

Case Number: T 1686/09 - 3.4.03

Application Number: 03020692.4

Publication Number: 1378869

IPC: G07D11/00

Language of the proceedings: EN

Title of invention:

Leaflets handling apparatus

Applicant:

Hitachi-Omron Terminal Solutions, Corp.

Headword:

Relevant legal provisions:

EPC 1973 Art. 76(1), 56

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (no)

Inventive step - after amendment

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1686/09 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 25 July 2013

Appellant: Hitachi-Omron Terminal Solutions, Corp.
(Applicant) 6-3, Osaki 1-chome,
Shinagawa-ku,
Tokyo (JP)

Representative: Strehl Schübel-Hopf & Partner
Maximilianstrasse 54
80538 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 23 February
2009 refusing European patent application No.
03020692.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: G. Eliasson
Members: S. Ward
T. Bokor

Summary of Facts and Submissions

- I. The appeal is against the decision of the Examining Division refusing European patent application No. 03 020 692 on the ground that the claimed subject-matter did not involve an inventive step within the meaning of Article 56 EPC 1973. The application under appeal is a divisional application based on the earlier European patent application No. 98 118 654 (hereinafter: the parent application).
- II. The following documents cited by the Examining Division are referred to in this decision:
- D2: US 5 553 320 A
D6: DE 195 36 481 A
D7: GB 2 124 005 A
- III. The Board sent the appellant a summons to oral proceedings and a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) containing a preliminary discussion of the requests filed with the statement of grounds of appeal in the light of the requirements of Article 76(1) EPC 1973 and Article 123(2) EPC, and a provisional view on the question of inventive step (Article 56 EPC 1973).
- IV. The appellant filed a further letter dated 25 June 2013 together with a new main request comprising a single claim, and auxiliary requests 1-4, each comprising a single claim.
- V. Oral proceedings were held before the Board on 25 July 2013. At the end of the oral proceedings the appellant filed an amended description and changed the

order of the requests, so that **the new main request is that the decision under appeal be set aside and that a patent be granted based on the following version:**

- **Description: Pages 1-5,5a,6-80 as filed during oral proceedings**
- **Claims: Claim 1 filed as New Auxiliary Request 2 with the letter dated 25 June 2013**
- **Drawings: Figs. 1-15 as originally filed.**

The new auxiliary requests 1 and 2 correspond to the main request and auxiliary request 1 filed with the letter dated 25 June 2013. The auxiliary requests 3 and 4 remain as filed with the letter dated 25 June 2013.

VI. Claim 1 according to the main request (i.e. claim 1 of auxiliary request 2 filed with the letter dated 25 June 2013) reads:

A leaflets handling apparatus (1g) comprising:
an upper portion including port means (2g) for receiving or delivering leaflets, checking means (3) for checking the authenticity of said leaflets and a temporary custody unit (4g) for holding temporarily the leaflets checked by said checking means (3);
a transport path (5g) for transporting the leaflets passed through said checking means (3); and
a lower portion disposed below said upper portion (1g) and including a plurality of leaflet storing units (8g, 9g) for storing the leaflets,
wherein

said lower portion is assembled as a unitary block distinctively from said upper portion,
said lower portion is enclosed with a harder housing than said upper portion,
the plurality of leaflet storing units in the lower portion include a recycling leaflet storing unit (8g) and a reject leaflet storing unit (9g),

characterised in that
the recycling leaflet storing unit (8g) includes a
stacking/separating mechanism (81-88) for storing the
leaflets received from the port means (2g) as a stack
and for delivering the stacked leaflets separately to
the port means (2g),
the reject leaflet storing unit (9g) includes a
stacking mechanism for storing rejected leaflets as a
stack,
the recycling leaflet storing unit (8g) and the reject
leaflet storing unit (9g) are arrayed each in an
upstanding disposition in a horizontal row, so that the
leaflets can be stacked in the vertical direction in
each of the leaflet storing units (8g, 9g), and
the leaflet storing units (8g, 9g) are mounted
removably and all have substantially the same outer
dimensions, so that they can be mutually exchanged with
each other and disposed in an arbitrarily selected
combination relative to said transport path (5g).

Reasons for the Decision

1. The appeal is admissible.

2. **Article 76(1) EPC 1973 - Main Request**
Much of the subject-matter of claim 1 of auxiliary
request 2 filed with the letter dated 25 June 2013
corresponds to subject-matter existing in claim 1 of
the main request refused by the Examining Division. In
the decision under appeal, no objections under Article
76(1) EPC 1973 or Article 123(2) EPC were raised
against this subject-matter by the Examining Division,

and the Board sees no reason to depart from this position.

In addition, the following features have been added to claim 1 of the present main request:

- a transport path (5g) for transporting the leaflets passed through said checking means (3);
- the recycling leaflet storing unit (8g) and the reject leaflet storing unit (9g) are arrayed each in an upstanding disposition in a horizontal row, so that the leaflets can be stacked in the vertical direction in each of the leaflet storing units (8g, 9g); and
- the leaflet storing units (8g, 9g) are mounted removably and all have substantially the same outer dimensions, so that they can be mutually exchanged with each other and disposed in an arbitrarily selected combination relative to said transport path (5g).

It is evident from the second of these additional features that claim 1 is now directed to "Embodiment 8" corresponding to the subject-matter found on page 75, line 19 to page 76, line 20 of the description of the parent application and generally depicted in figure 15.

In the description, one embodiment ("Embodiment 1") is described in exhaustive detail (page 14, line 15 to page 64, line 7). The skilled reader would understand, however, that those features and options explained in detail in relation to Embodiment 1 (for example, the third additional feature mentioned above), are equally applicable to other embodiments, for example Embodiment 8, and that a repetitious description of such features has been omitted from the latter embodiments merely for reasons of brevity (in this regard see page 76, lines

16 to 20). Moreover, it is clear that Embodiment 8 is not to be seen as being limited to the exact arrangement depicted in figure 15. For example, other combinations of storage units may be employed in an upstanding disposition in a horizontal row in the lower unit (see e.g. page 77, line 23 to page 78, line 2).

Finally, Embodiment 8 is not limited to the exact transport path arrangement depicted in figure 15, as explained on page 77, lines 13 to 22. A wide variety of transport paths are disclosed in the description and drawings, and the skilled person would understand that the general definition of the transport path in its broadest aspect is that found on page 7, lines 11 to 12 in relation to "a general aspect of the present invention", a definition corresponding to the first of the additional features mentioned above.

The Board is therefore satisfied that the subject-matter of claim 1 of the main request contains nothing that is not directly and unambiguously derivable from the parent application as filed, and consequently the requirements of Article 76(1) EPC 1973 are met.

3. Article 123(2) EPC - Main Request

The description and figures as originally filed are the same for both the present application and the parent application. Hence, for the reasons mentioned above *mutatis mutandis*, the Board is also satisfied that the requirements of Article 123(2) EPC are met.

4. Inventive Step - Main Request

The following discussion of inventive step relates to claim 1 of auxiliary request 2 filed with the letter dated 25 June 2013. The main request of the appellant

submitted during oral proceedings before the Board was for the grant of a patent with this sole claim.

The appellant stated in the oral proceedings that the preamble of claim 1 is disclosed in document D6, which is seen as the closest prior art. The Board agrees with this assessment.

Claim 1 therefore differs from the closest prior art in the following features:

- a) the recycling leaflet storing unit (8g) includes a stacking/separating mechanism (81-88) for storing the leaflets received from the port means (2g) as a stack and for delivering the stacked leaflets separately to the port means (2g),
- b) the reject leaflet storing unit (9g) includes a stacking mechanism for storing rejected leaflets as a stack,
- c) the recycling leaflet storing unit (8g) and the reject leaflet storing unit (9g) are arrayed each in an upstanding disposition in a horizontal row, so that the leaflets can be stacked in the vertical direction in each of the leaflet storing units (8g, 9g), and
- d) the leaflet storing units (8g, 9g) are mounted removably and all have substantially the same outer dimensions, so that they can be mutually exchanged with each other and disposed in an arbitrarily selected combination relative to said transport path (5g).

In document D6 the recycling storing units (34,36) are of the winding type, and the reject storing units (38,42) are of unspecified construction, but appear to be merely collecting bins (column 3, lines 9-29).

However, features corresponding to those listed as features (a)-(c), above, can be identified in other prior art documents on file.

Document D7 (see e.g. figure 2) discloses a bank note transaction apparatus comprising storage cassettes (16,17,18 and 19) of the stacking/separating type (see e.g. figures 8 and 11). The cassettes may all be used for recycling (page 12, lines 84-106); one cassette may be designated for storing rejected notes (page 10, lines 95-120).

Document D2 (see e.g. figures 2,3) discloses an automatic cash transaction machine having a recycle box 23 and a bill cassette (22), which may also be used to recycle notes of a different denomination (a reject box is indicated at 26). The recycle box (23) and a bill cassette (22) are situated in a lower portion of the machine and take the form of stacking/separating type units which are arrayed each in an upstanding disposition in a horizontal row, the notes being stacked in the vertical direction.

Hence, starting from document D6, a skilled person *could* arrive at features (a)-(c) of claim 1 by taking from document D7 the notion that both the recycling storage units and the reject storing unit may be implemented as stacking type units, and taking from document D2 the idea that all of the stacking type units may be arrayed in an upstanding disposition in a horizontal row in the lower portion.

This leads to the question whether a skilled person actually *would* find it obvious to combine the features of these three documents in the manner set out in the previous paragraph. This would normally require an

analysis of the problems solved by these features, and a discussion of whether the prior art provides any hints or indications to solve these problems in the claimed manner.

In the present case, however, the Board does not feel obliged to enter deeply into this question, as, even if a plausible argument exists that such a combination is obvious, this would still leave a further claimed feature (feature d) unaccounted for. Moreover, this feature does not appear to be disclosed in any of the cited prior art.

According to feature (d), the leaflet storing units (i.e. the reject leaflet storing unit and the recycling leaflet storing unit previously introduced in the claim) are mounted removably and all have *substantially the same outer dimensions*, so that they can be *mutually exchanged* with each other and *disposed in an arbitrarily selected combination relative to said transport path*.

Although the storage cassettes (31,33) in document D6 are exchangeable (column 3, lines 5-7), these cassettes both appear to have the same purpose and neither is disclosed as being a recycling storage unit or a reject storing unit.

As noted above, the cassettes (16,17,18,19 or 20,21,22,23) of document D7 may serve as recycling storage units or reject storing units, and are removable via rear door (2a), as explained on page 2, lines 46-49. However, it is clearly shown in figure 2 that these cassettes are designed so that they have *different* outer dimensions. Nor can this be plausibly dismissed as being merely an accidental or irrelevant

feature, as the same feature is clearly evident in all of the other embodiments disclosed in document D7 (see figures 9-13). In contrast to the subject-matter of feature (d) as defined above, the cassettes of document D7 are constructed in such a manner that they may *not* be mutually exchanged with each other and disposed in an arbitrarily selected combination relative to the transport path.

Document D2 discloses a recycle box (23) and a bill cassette (22) which are removable, but they are not disclosed as being mutually exchangeable. In any event, the reject box (26) has a very different form and would not be mutually exchangeable with either the recycle box or the bill cassette. The other prior art cited during examination similarly fails to disclose recycling storage units and reject storing units which have the same outer dimensions and which can be mutually exchanged with each other.

The appellant's argument that this feature is advantageous in providing greater flexibility is plausible. This effect may also be inferred from the description (see e.g. page 49, lines 2-26).

In summary, having regard to the available prior art, for the skilled person to arrive at the features of claim 1 would require a combination of three documents (D6, D7 and D2) and the provision of a further feature which is not disclosed in the prior art on file. The Board does not find it plausible that such a course of action would be obvious to the skilled person, and consequently finds that claim 1 involves an inventive step in the sense of Article 56 EPC 1973.

As a result, it is not necessary for the Board to consider the other requests which, following the re-ordering made by the appellant at the end of the oral proceedings before the Board, now constitute lower-ranking requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to grant a patent in the following version:
 - Description: pages 1-5,5a,6-80 as filed during the oral proceedings
 - Claim(s): Claim 1 filed as New Auxiliary Request 2 with letter dated 25 June 2013
 - Drawings: Figs. 1-15 as originally filed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated