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Datasheet for the decision of 15 September 2017

Case Number: T 0489/12 - 3.4.01

Application Number: 01830631.6

Publication Number: 1300798

IPC: G06K7/10

Language of the proceedings: EN

Title of invention:
Optical reading apparatus

Patent Proprietor:
Datalogic IP TECH S.r.l.

Opponent:
Leuze electronic GmbH & Co. KG

Headword:

Relevant legal provisions:
EPC 1973 Art. 100(a), 54(1), 54(2), 114(2)
EPC R. 76(2)(c)

Keyword:
Late-filed document - admitted (no)
Novelty - (yes)
Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:

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Case Number: T 0489/12 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 15 September 2017

Appellant: (Opponent)	Leuze electronic GmbH & Co. KG In der Braike 1 73277 Owen / Teck (DE)
Representative:	Ruckh, Rainer Gerhard Patentanwalt Jurastrasse 1 73087 Bad Boll (DE)
Respondent: (Patent Proprietor)	Datalogic IP TECH S.r.l. Via San Vitalino, 13 40012 Lippo di Calderara di Reno (BO) (IT)
Representative:	Porta, Checcacci & Associati S.p.A Via Trebbia, 20 20135 Milano (IT)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 30 January 2012 rejecting the opposition filed against European patent No. 1300798 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	G. Assi
Members:	T. Zinke
	D. Rogers

Summary of Facts and Submissions

I. An opposition was filed against European patent No. 1 300 798 as a whole.

II. The opposition was based on the ground for opposition of Art. 100(a) EPC 1973 for lack of novelty (Art. 54 EPC 1973) and for lack of inventive step (Art. 56 EPC 1973). As evidence the opponent filed documents D1 to D6, whereby documents D1 and D4 were considered each to disclose the subject-matter of claim 1 of the patent by itself, whereas in addition all documents together were considered to provide evidence for a public prior use of the claimed subject-matter by three devices (*"BCL40"*, *"BCL80"*, *"MA10"*) sold by the opponent prior to the filing date of the patent.

III. During the opposition proceedings, the opponent late-filed further documents D7, D7.1, D8 and D9 in order to provide evidence that the device *"MA10"* - as sold prior to the filing date of the opposed patent - already included a microprocessor.
Said documents D7, D7.1 and D8 were admitted into the opposition proceedings.

IV. The opposition division decided to reject the opposition.

From the documents cited in the opposition division's decision, the following ones are referred to in this decision:

D1: Technische Beschreibung des Strichcodeleser BCL 40 mit integriertem Decoder und Anschlusseinheit MA10 der Firma Leuze electronic GmbH + Co.KG,

allegedly made available to the public in July 1997 (see last page, D 079/01-07/97 Art. Nr. 500 27315);

D4: Operating Manual Bar Code Reader BCL80 with integrated decoder Connector Unit MA10, Firma Leuze electronic GmbH+Co.KG, allegedly made available to the public on July 1999 (see last page, GB 082/01-07/99 Artikel Nr. 500 28 138);

D7: Internal circuit design of the MA10;

D7.1: Internal circuit design of the MA10 with handwritten comments;

D8: Data sheet *"80C51 8-bit microcontroller family"*, Philips Semiconductors, published on 7 August 2000.

V. The appellant (opponent) filed an appeal against the opposition division's decision.

With the notice of appeal, the appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety.

VI. By submission of 17 October 2012 the respondent (patentee) requested, as a main request, that the appeal be dismissed. As a first, second and third auxiliary request, the respondent requested that the patent be maintained with corresponding sets of amended claims as filed together with the submission. The respondent further requested that documents D7, D7.1 and D8 should not have been admitted into the opposition proceedings.

VII. Summons to attend oral proceedings were issued on 3 May 2017.

On 12 July 2017, the Board issued a communication under Art. 15(1) RPBA, expressing its provisional opinion with regard to the parties' submissions and requests then on file.

VIII. With letter of 11 July 2017, but considered by the Board only after issuing the communication under Art. 15(1) RPBA, the respondent provided further arguments why documents D7, D7.1 and D8 should not have been admitted into the opposition proceedings.

IX. With further submissions the appellant and the respondent discussed the issues raised in the communication under Art. 15(1) RPBA and the letter of 11 July 2017.

X. Oral proceedings before the Board took place on 15 September 2017.

The final request of the appellant was that the decision under appeal be set aside and the patent be revoked in its entirety.

The final requests of the respondent were, as a main request, that the appeal be dismissed or alternatively the decision under appeal be set aside and the patent be maintained upon the basis of auxiliary requests 1 to 3, all filed under cover of a letter dated 17 October 2012. In addition, the respondent requested that documents D7, D7.1 and D8 not be admitted into the appeal proceedings.

XI. Claim 1 of respondent's main request, i.e. claim 1 of the patent as granted, reads, using the feature

analysis F1 to F13 as provided by the opposition division in its decision:

F1: *"Optical reading apparatus, comprising"*
F2: *"a light emitting section,"*
F3: *"a light receiving section,"*
F4: *"an outside interface section,"*
F5: *"a first unit housing at least one of the emitting section and the receiving section,"*
F6: *"a second unit housing at least the outside interface section,"*
F7: *"the first unit and the second unit being mutually connectable,"*
F8: *"a first microprocessor means housed within said first unit, and"*
F9: *"a second microprocessor means housed within said second unit"*
characterized by
F10: *"being automatic,"*
F11: *"in that said first microprocessor means controls the components of at least one of the emitting section and the receiving section"*
F12: *"and said second microprocessor means controls the components of at least the outside interface section, and"*
F13: *"in that each of the first and the second units comprises storage means storing the setting parameters of the respective components."*

Claims 2 to 29 of respondent's main request depend on claim 1.

Reasons for the Decision

1. Applicable law

This decision is issued after the entry into force of the EPC 2000 on 13 December 2007 whereas the application was filed before this date. Reference is thus made to the relevant transitional provisions for the amended and new provisions of the EPC, from which it can be derived which Articles and Rules of the EPC 1973 are still applicable to the present application and which Articles and Rules of the EPC 2000 are to apply. When Articles or Rules of the former version of the EPC are cited, their citations are followed by the indication *"1973"* (cf. EPC, Citation practice).

2. The appeal is admissible.

3. Admissibility of late filed documents D7, D7.1, D8 and D9 in appeal proceedings

3.1 The appellant submitted documents D7, D7.1, D8 and D9 during the opposition proceedings, but after the nine-month time limit for filing the opposition under Art. 99(1) EPC. According to Art. 114(2) EPC 1973 it lies in the discretion of the opposition division to admit such late-filed documents into the opposition proceedings. In the decision under appeal the opposition division admitted documents D7, D7.1 and D8 but not D9 since this document was only published after the filing date of the patent and, hence, did not represent prior art.

With regard to documents D7, D7.1 and D8, the opposition division argued that they *"have been*

published well before the priority date of the patent in suit und therefore do represent prior art in the sense of Art. 54(2) EPC." Further, since these documents provided a detailed overview of the interior design of the *"MA10"*, which was crucial for a good understanding of the devices as described in prior art document D1 and D4, these documents were not considered as new evidence, but rather as "*evidence helping to better understand the prior art D1 and D4 already submitted in due time".* Therefore, the opposition division admitted documents D7, D7.1 and D8 into the proceedings (cf. decision under appeal, Reasons, section 2).

3.2 The opposition division has a discretion in this regard. A board of appeal should only overrule the opposition division's conclusion if it considers that the discretion was exercised in an undue or unreasonable way according to wrong principles (cf. Case Law of the Boards of Appeal of the EPO, 8th edition, section IV.C.1.2, pages 934ff.)

3.3 With its letter of 17 October 2012, submitted during the present appeal proceedings, the respondent for the first time raised objections against the admissibility of documents D7, D7.1 and D8. Since the opposition division had decided in favour of the respondent in its decision, after having admitted these documents into the proceedings, the opposition division evidently saw no reason to provide an explicit opportunity for the respondent to comment on this aspect during first instance proceedings. Hence, it is equitable to hear the respondent on the question of admissibility of these documents during appeal proceedings.

3.4 With the submission of documents D7, D7.1 and D8, the appellant tried to provide further evidence that the device *"MA10"*, as it was allegedly sold prior to the filing date of the opposed patent and described in documents D1 and D4, already included a microprocessor as claimed in features F9 and F12.

Whereas a microprocessor (*"MC8.87C52"*) is indeed shown as a part of the device *"MA10"* in documents D7 and D7.1, it has to be considered that, besides a date of *"27.07.1995"* (cf. columns 6 and 7 of the box in the bottom-right corner), and a copyright notice of *"1995"*, these documents also include further dates, as e.g. *"18.01.05"* and *"20.12.07"* in column 4 of said box, with the remark *"AENDERUNG"* (changes), as pointed out by the respondent in its letter of 17 October 2012. Further, these parts of documents D7 and D7.1, which are crucial in order to determine their valid date and the content of the changes are very difficult to read. It should also be noted that doubts remain as to whether documents D7 and D7.1, which appear to be internal documents, were made public.

3.5 The appellant has neither commented in writing nor during oral proceedings on the different dates found on these documents that appear to indicate when changes were made. In addition, the appellant has neither provided a more legible version of these documents, nor any explanation or evidence that, even without the changes mentioned above, the *"MA10"* included a microprocessor already before the filing date of the present patent. It was only stated that the documents had been rightly admitted into the opposition proceedings in order to allow a better understanding of the contents of documents D1 and D4, as submitted

during the opposition period (cf. letter of 11 August 2017, section I.).

3.6 It is noted that said technical drawings had been drawn by the appellant itself. For this reason, the appellant, being aware of the respondent's objections, could and also should have submitted legible copies and, moreover, the evidence that the drawings had clearly been completed prior to the filing date of the opposed patent.

3.7 During first instance proceedings before the opposition division, the issue of what precisely documents D7 and D7.1 disclosed at what date was not raised. It seems that since the opposition division decided to reject the opposition even after having admitted documents D7, D7.1 and D8 into the opposition proceedings, this issue was not considered to be critical..

However, when exercising its discretion, the opposition division should have checked, whether the valid date of documents D7, D7.1 and D8 is really the *"27.07.1995"*, as alleged by the opponent (cf. letter of 20 July 2011, section, page 2 and 3). When looking for evidence of this date in documents D7 and D7.1, it should have been recognized that a column *"AENDERUNG"* with dates after the filing date of the opposed patent is present as well. Since the valid date of a document is critical as regards whether it can be considered as prior art, the opposition division should have clarified the issue concerning the date before admitting these documents into the proceedings.

3.8 Due to the fact that it is not possible to determine beyond any doubt which changes were made to documents D7 and D7.1 in 2005 and which in 2007 (both dates being

after the filing date of the opposed patent), these documents can not be used to provide evidence for the internal structure of the device *"MA10"* sold prior to the filing date of the opposed patent.

Document D8 is prior art, but its relevance is strongly related to documents D7 and D7.1, since it only discloses details of the microprocessor present in D7 and D7.1. Due to the unknown changes made to documents D7 and D7.1 in 2005 and 2007, it is not shown that such a microprocessor was present in the *"MA10"* in the version available before the filing date of the opposed patent.

3.9 Hence, the decision of the examining division to admit these documents was not correct and is set aside. These documents are not admitted into the appeal proceedings.

4. Respondent's main request

4.1 Claim interpretation

4.1.1 In the appealed decision, the opposition division interpreted feature F13 in that *"both the first and second units comprise a memory, and each memory comprises a complete backup of relevant parameters for both of the units. When either one of the units is to be replaced, then from the memory of the remaining unit the backup parameters can be downloaded into the replaced unit"* (cf. reasons, section 3.3, page 13, third paragraph, emphasis added). It thus concluded that feature F13 as interpreted in this way was not disclosed in document D1.

4.1.2 In the statement setting out the grounds of appeal, the appellant relied on the same interpretation of feature F13.

4.1.3 With the letter of 11 August 2017, the appellant further argued that using the definite article *"the"* would imply that only parameters of the first unit were meant, since no hint was given what is meant with a "*setting parameter*" of the second unit (cf. section II.).

4.1.4 With its letter of 1 September 2017 the respondent submitted, however, that with the wording of claim 1 it was only claimed that the respective storage means store the setting parameters of the own components and *"that a cross-copy of the parameters is preferably made (in an advantageous embodiment) in order to easily cope with possible failure of one the units. See e.g. current claims 8 and 9. It is after such a copy has been made, that each unit stores the setting parameters of both units."* (cf. page 2, penultimate paragraph).

4.1.5 The skilled person, when reading a claim, would try to arrive at an interpretation of the claim that is technically sensible and takes into account the whole disclosure of the patent (cf. Case Law of the Boards of Appeal of the EPO, 8th edition, section II.A.6.1).

4.1.6 Even without explicit examples for setting parameters of the *"respective component of the second unit"* (i.e. the outside interface section as the only component of the second unit in claim 1) being provided, the person skilled in the art would know that setting parameters of an outside interface unit might comprise, for instance, an address and/or a transfer protocol for

this interface unit, as convincingly argued by the respondent during oral proceedings.

4.1.7 The use of the word "*respective*" in feature F13 also needs to be considered when interpreting the claim. The interpretation as proposed by the opposition division that each storage means stored the setting parameters of the components of both units does not take into due account the word "*respective*". This word implies that each of the units comprises storage means storing the setting parameters of the components in said unit. This interpretation is in line with the description, in which (cf. paragraph [0111] of the B1-patent specification) it is envisaged that the setting parameters of a new second unit can be copied to the new second unit, without the need to carry out the calibration procedures once again. In this case, it is not described as necessary that also the setting parameters of the components of the first unit are transferred, i.e. at least when replacing the unit, the storage means of the second unit only store the setting parameters of the components of the second unit.

4.1.8 This interpretation is also not in contradiction with claim 8 and the corresponding parts of the description (cf. for instance paragraphs [0115] and [0116] of the B1-patent specification), which deals with the transfer of the setting parameters of the respective units between the respective storage means. Whereas it is possible that all setting parameters of all the components of the first and the second unit could be stored in the respective storage means and transferred together, an easier replacement of the respective units would be achieved by only transferring the setting parameters from the to-be-replaced unit to the non-replaced unit and then afterwards back to the new unit.

4.1.9 The use of the definite article *"the"* in *"storing the setting parameters"* of feature F13 moreover implies that all setting parameters of the components are stored in the storage unit.

4.1.10 Therefore, the interpretation of feature F13 is that the first unit comprises (first) storage means storing at least all of the setting parameters of the components of the first unit, the same analogically applying to the second unit.

4.2 Novelty (Art. 54(1),(2) EPC 1973)

4.2.1 Without considering documents D7, D7.1 and D8 that are not admitted into the proceedings (see above), there is no evidence that features F9, F12 and F13 are disclosed in any one of the documents D1 and D4 nor in the product *"MA10"* that was allegedly publicly available prior to the filing date of the opposed patent.

4.2.2 Neither document D1 nor D4 discloses a microprocessor in the *"MA10"*, which corresponds to the *"second unit"* of claim 1 (see feature F6).

The opponent argued that the microprocessor was disclosed in Figs. 6.18 and 6.19 on page 35 and in Fig. 7.2 on page 42 of document D1 and in Figs. 6.19 and 6.20 on page 36 and Fig. 7.2 on page 43 of D4 (cf. opposition, page 5, paragraphs 1 and 2, page 9, paragraphs 7 and 8).

However, neither in Figs. 6.18 and 6.19 of document D1 nor in Figs. 6.19 and 6.20 of document D4 is a processor shown as part of the device *"MA10"*. In these figures it is only mentioned *"zum Prozessor"* (to the

processor) without specifying where this particular processor is located. Nowhere in these documents is a processor mentioned in the device *"MA10". Rather*, only a processor (*"Dekoder"*, *"decoder"*) in the other devices *"BCL40"* and *"BCL80"* is disclosed (cf. page 13 of document D1 or D4, respectively). Since the device *"MA10"* ist only used together with one of the other devices *"BCL40"* or *"BCL80"*, but never as a stand-alone device, this *"processor"* mentioned in figures 6.18 and 6.19 of D1 or figures 6.19 and 6.20 of D4 might be the processor of the devices *"BCL40"* or *"BCL80"*.

Further evidence that the device *"MA10"* does not include a processor is that in Figs. 7.2 of D1 and D4 only EEPROMs are shown in *"MA10"*, whereas for the *"BCL40"* and *"BCL80"* a *"RAM"*, i.e. a working memory of a processor, is shown. Therefore, also in these figures there is no disclosure of a processor in the device *"MA10"*.

Hence, features F9 and F12 were not disclosed before the filing date of the opposed patent in documents D1 and D4, and hence, also not in the device *"MA10"*.

4.2.3 In the appealed decision the opposition division decided with regard to feature F13 that it was not disclosed in documents D1 and D4, because

(a) not all setting parameters of the second unit (*"MA10"*) were stored in storage means, since at least one settable parameter (*"Geräteadresse"*) was set using a hardware switch (cf. reasons, page 14, first two paragraphs), and

(b) no setting parameters of the *"MA10"* (*"second unit"*) were stored in storage means of the *"BCL40"* or *"BCL80"* (*"first unit"*) (cf. reasons, section 3.3, F13, pages 12-16).

As discussed above, claim 1 should not be interpreted in a way that the storage means of a unit stores the setting parameters of the respective other unit. Hence, the opposition division's finding in (b) is incorrect.

However, the opposition division's finding in (a) is convincing. Feature F13 is neither realised in document D1, nor in D14 nor in the *"MA10"*, since due to the realization of setting the device address (*"Geräteadresse"*) by a hardware switch, this particular setting parameter is not stored in a storage means, whereas feature F13 claims that all setting parameters of the components of the second unit are stored in the second storage means.

4.2.4 In the statement setting out the grounds of appeal, the appellant only provided arguments with regard to argumentation (b), but no counter-argument against argumentation (a) was given. Neither in the letter of 11 August 2017 nor during oral proceedings was any further argument in this regard provided.

4.2.5 Hence, the subject-matter of claim 1 differs from the disclosures of documents D1, D4 or the device *"MA10"* as publicly available prior to the filing date of the opposed patent, since features F9, F12 and F13 are not realized therein. Therefore, claim 1 is novel.

4.3 Inventive step (Art. 56 EPC 1973)

4.3.1 Lack of inventive step as a ground for opposition was raised in the opposition (cf. EPA Form 2300.2 of 14 May 2007, section VI, page 2) against the patent as a whole. Whereas the opponent in the detailed statement of grounds only raised general lack of inventive step

objections against the dependent claims, it is established jurisprudence that:

"In a case where a patent has been opposed under Article 100(a) EPC on the grounds of lack of novelty and inventive step having regard to a prior art document, and the ground of lack of novelty has been substantiated pursuant to Rule 55(c), a specific substantiation of the ground of lack of inventive step is neither necessary - given that novelty is a prerequisite for determining whether an invention involves an inventive step and such prerequisite is allegedly not satisfied - nor generally possible without contradicting the reasoning presented in support of lack of novelty.

In such a case, the objection of lack of inventive step is not a fresh ground for opposition and can consequently be examined in the appeal proceedings without the agreement of the patentee (see point 3.1 of the reasons)."

(cf. e.g. T0131/01 published OJ EPO, 2003, 115, headnote, R.55(c) EPC 1973 being identical to Rule 76(2)(c) EPC).

4.3.2 In the appealed decision, the opposition division did not deal with the ground of lack of inventive step for claim 1, since no arguments by the opponent were available in this regard at that time (cf. reasons, section 5, page 17).

4.3.3 With the submission of 11 August 2017, however, the appellant provided detailed arguments with regard to lack of inventive step of claim 1 (cf. section IV, pages 6 to 8).

4.3.4 Since lack of inventive step was not discussed in first instance proceedings, it is equitable to remit the case to the opposition division for further prosecution. In this respect, at the oral proceedings the appellant raised no objections and the respondent had no comments.

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 for further prosecution.

The Registrar: The Chairman:

R. Schumacher G. Assi

Decision electronically authenticated