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**Datasheet for the decision
of 24 March 2017**

Case Number: T 1538/12 - 3.2.05

Application Number: 08003699.9

Publication Number: 2045079

IPC: B41J2/175

Language of the proceedings: EN

Title of invention:

Ink cartridge determination system

Patent Proprietor:

Brother Kogyo Kabushiki Kaisha

Opponents:

PEARL. GmbH
Pelikan Hardcopy Production AG

Relevant legal provisions:

EPC Art. 100(c), 123(2)
EPC R. 80
RPBA Art. 13

Keyword:

Amendments - added subject-matter (yes)
Amendment occasioned by ground for opposition - (no)



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Case Number: T 1538/12 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 24 March 2017

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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
2 May 2012 concerning maintenance of the
European Patent No. 2 045 079 in amended form.

Composition of the Board:

Chairman P. Lanz
Members: S. Bridge
 D. Rogers

Summary of Facts and Submissions

- I. Three appeals were directed against the interlocutory decision of the opposition division stating that European patent No. 2 045 079 in amended form according to what was then auxiliary request 1 meets the requirements of the European Patent Convention.
- II. Two oppositions were filed against the patent as a whole based on Article 100(a) EPC (lack of novelty, Article 54 EPC and lack of inventive step, Article 56 EPC) and Article 100(c) EPC (added subject-matter extends beyond the content of the application as filed).
- III. Oral proceedings were held before the board of appeal on 24 March 2017.
- IV. The requests of appellant I (patent proprietor) were that the decision under appeal be set aside and, that as a main request, the patent be maintained as granted, or alternatively, that the patent be maintained upon the basis of one of auxiliary requests 8 (amended), 8b, 8c, 8d, 8e, all filed under cover of a letter dated 24 February 2017, or upon the basis of auxiliary request 8/8f filed at the oral proceedings before the Board on 24 March 2017, or upon the basis of auxiliary request 9, filed under cover of a letter dated 12 September 2012, or upon the basis of the tenth auxiliary request, filed at the oral proceedings before the board on 24 March 2017, or upon the basis of auxiliary request 11, filed under cover of a letter dated 24 February 2017.

The requests of appellants II and III (opponents 1 and 2) were that the decision under appeal be set aside and that the European patent No. 2 045 079 be revoked.

V. Claims 1 to 4 of the patent in suit as granted (main request) read as follows:

"1. An ink cartridge (10, 10'), comprising:
a front wall (161);
a first signal blocking portion (191) projecting away from the front wall (161);
a second signal blocking portion (189, 199) projecting from the front wall (161) in a direction of insertion (30) of the ink cartridge (10) into a recording apparatus (250); and
a third signal blocking portion (72), wherein the first signal blocking portion (191) is configured to either prevent a first signal from the recording apparatus (250) from passing therethrough or to alter a path of the first signal when the first signal blocking portion (191) receives the first signal,
the second signal blocking portion (189, 199) is configured to either prevent a second signal from the recording apparatus (250) from passing therethrough or to alter a path of the second signal when the second signal blocking portion (189, 199) receives the second signal, and
the third signal blocking portion (72) is configured to either prevent the second signal from passing therethrough or to

alter a path of the second signal when the third signal-blocking portion (72) receives the second signal."

"2. The ink cartridge (10, 10') of claim 1, wherein the third signal blocking portion (72) is configured to move with respect to each of the first signal blocking portion (191) and the second signal blocking portion (189,199)."

"3. The ink cartridge (10,10') of claim 2, further comprising a case (20) having at least a portion of an ink chamber (100) defined therein, wherein the ink chamber (100) is configured to store ink, and the third signal blocking portion (72) is positioned within the case (20) and is configured to move based on an amount of ink in the ink chamber (100)."

"4. The ink cartridge (10,10') of claim 43 *[sic]*, further comprising:

a case (20) having at least a portion of an ink chamber (100) defined therein, wherein the ink chamber (100) is configured to store ink, and the third signal blocking portion (72) is positioned within the case (20);

a movable member (21) configured to move relative to the case (20), wherein the movable member (21) comprises the first signal blocking portion (191) and the second signal blocking portion (189,199); and

at least one resilient member (23, 24) having a first end which is coupled to the case (20) and a second end which is coupled to the movable member (21)."

VI. Amended dependent claim 3 of auxiliary request 8 (amended) reads:

"3. The ink cartridge determination system of claim 1, the ink cartridge further comprising:

a case (20) having at least a portion of an ink chamber (100) defined therein, wherein the ink chamber (100) is configured to store ink, and the third signal blocking portion (72) is positioned within the case (20);

a movable member (21) configured to move relative to the case (20), wherein the movable member (21) comprises the first signal blocking portion (191) and the second signal blocking portion (189,199); and

at least one resilient member (23, 24) having a first end which is coupled to the case (20) and a second end which is coupled to the movable member (21), wherein the third signal blocking portion is configured to move based on an amount of ink in the ink chamber (100) and

the third signal blocking portion (72) is configured to move with respect to each of the first signal blocking portion (191) and the second signal blocking portion (189,199)."

VII. Amended dependent claim 2 of auxiliary request 8b reads the same as dependent claim 3 of auxiliary request 8 (amended).

VIII. Amended dependent claim 2 of auxiliary request 8c reads the same as dependent claim 3 of auxiliary request 8 (amended), except for the text "*wherein the third signal blocking portion is configured to move based on an amount of ink in the ink chamber (100) and*" which has been deleted.

IX. Amended dependent claim 3 of auxiliary request 8d reads the same as dependent claim 3 of auxiliary request 8 (amended).

X. Amended dependent claim 2 of auxiliary request 8e reads the same as dependent claim 2 of auxiliary request 8c , except for the text "*a case (20) having at least a portion of an ink chamber (100) defined therein, wherein the ink chamber (100) is configured to store ink, and the third signal blocking portion (72) is positioned within the case (20);*" which has been deleted.

XI. Claim 1 of auxiliary request 8/8f reads as follows:

"An ink cartridge determination system, comprising;
an ink cartridge (10, 10'), comprising:
a front wall (161);
a first signal blocking portion (191) projecting away from the front wall (161);
a second signal blocking portion (189, 199) projecting from the front wall (161) in a direction of insertion (30) of the ink cartridge (10) into a recording apparatus (250); and
a third signal blocking portion (72), wherein the first signal blocking portion (191) is configured to either prevent a first signal from the recording apparatus (250) from passing therethrough or to alter a path of the first signal when the first signal blocking portion (191) receives the first signal,
the second signal blocking portion (189, 199) is configured to either prevent a second signal from the recording apparatus (250) from passing therethrough or to alter a path of the second signal when the second signal blocking portion (189, 199) receives the second signal, and

the third signal blocking portion (72) is configured to either prevent the second signal from passing there-through or to alter a path of the second signal when the third signal blocking portion (72) receives the second signal;

and a recording apparatus (250) comprising:

a cartridge mounting portion (276) configured to mount the ink cartridge (10, 10');

a first sensor (235) disposed in the cartridge mounting portion (276) and comprising a first signal-emitting element configured to emit the first signal and a first signal-receiving element configured to receive the first signal, wherein the first signal blocking portion (191) is configured to either prevent the first signal from passing therethrough or to alter the path of the first signal at least during a mounting of the ink cartridge (10, 10') to [sic] the cartridge mounting portion (276), wherein an intensity of the first signal received by the first signal-receiving element when the first signal is prevented from passing through the first signal blocking portion (191) or the path of the first signal is altered by the first signal blocking portion (191) is different from an intensity of the first signal received by the first signal-receiving element when the first signal is not prevented from passing through the first signal locking [sic] portion (191) or the path of the first signal is not altered by the first signal blocking portion (191);

a second sensor (230) disposed in the cartridge mounting portion (276) and comprising a second signal-emitting element configured to emit the second signal and a second signal-receiving element configured to receive the second signal, wherein the second signal blocking portion (189, 199) is configured to either prevent the second signal from passing therethrough or to alter the path of the second signal during the

mounting of the ink cartridge (10, 10') to [sic] the cartridge mounting portion (276), and the third signal blocking portion (72) is configured to either prevent the second signal from passing therethrough or to alter the path of the second signal when the mounting of the ink cartridge (10, 10') to [sic] the cartridge mounting portion (276) is completed, wherein an intensity of the second signal received by the second signal receiving element when the second signal is prevented from passing through the second signal blocking portion (189, 199) or the third signal blocking portion (72) or the path of the second signal is altered by the second signal blocking portion (189, 199) or the third signal blocking portion (72) is different from an intensity of the second signal received by the second signal-receiving element when the second signal is not prevented from passing through the second signal blocking portion (189, 199) or the third signal blocking portion (72) or the path of the second signal is not altered by the second signal blocking portion (189, 199) or the third signal blocking portion (72); and a determiner configured to determines [sic] information associated with the ink cartridge (10, 10') based on the intensity of the second signal received by the second signal-receiving element at a time that the intensity of the first signal received by the first signal-receiving element initially changes during the mounting of the ink cartridge (10,10') to [sic] the cartridge mounting portion (276)."

- XII. Claim 1 of auxiliary request 9 only differs from claim 1 of the main request in that the text "*a movable member (21) having*" is inserted before the text "*a front wall (161);*".

XIII. Claim 1 of the tenth auxiliary request substantially differs from claim 1 of the main request in that the following text is added at the end of the claim:

"the first signal blocking portion and the second signal blocking portion are configured to move with respect to the third signal blocking portion, and the ink cartridge further comprises:
a case (20) having at least a portion of an ink chamber (100) defined therein, wherein the ink chamber is configured to store ink, and the third signal blocking portion is positioned within the case (20);
a movable member (21) configured to move relative to the case (20), wherein the movable member (21) comprises the first signal blocking portion and the second signal blocking portion; and
at least one resilient member having a first end which is coupled to the case and a second end which is coupled to the movable member (21)."

XIV. The arguments of appellant I in the written and oral proceedings can be summarised as follows:

Main request

The amendments in claim 1 concerning the signal blocking portions projecting from the front wall have a basis in paragraph [0078] of the application as published. Adding these features constitutes an intermediate limitation in that the claim is restricted by adding features which were originally disclosed in specific embodiments. Paragraph [0128] of the application indicates that the described embodiments are to be considered merely as exemplary of the invention and that it should be understood by those skilled in the art that other variations and modifications of the exemplary

embodiments may be made without departing from the scope of the invention. Blocking the signals forms an essential part of the invention. It is advantageous for detection by the recording apparatus when the signal blocking portions project from the front wall. The skilled person understands that the front wall is the only structural feature which is needed to relate the projecting first and second signal blocking portions. The movable member 21 addresses different issues not related to the blocking of the signals. The patent proprietor should not have to include all the features of the embodiment. Decision T 711/13 relates to a different case. Claim 1 does not include any added subject-matter.

Auxiliary requests 8 (amended), 8b, 8c, 8d and 8e

The dependent claims were implicitly objected to, because the opponents requested the revocation of the patent as a whole. The amended dependent claims in these requests are occasioned by the ground for opposition under Article 100(c) EPC for the following reason. Since the movable member 21 is not mentioned in claim 1, the third signal blocking portion 72 could be interpreted as being part of the second signal blocking portion. Granted dependent claim 2 mentions that the third signal blocking portion 72 is movable without mentioning movable member 21, with the effect that claim 2 thereby adds subject-matter which was not originally disclosed. Thus, it was necessary to combine the granted dependent claims 2 to 4, so that the subject-matter claimed in the amended dependent claim sets out the *movable* third signal blocking portion 72 in combination with the movable member 21 and thus corresponds to the embodiment set out in the description. Therefore, the amended dependent claims are

occasioned by the ground for opposition under Article 100(c) EPC and these requests should be admitted into the proceedings.

Auxiliary request 8/8f

In view of the non-admittance of auxiliary requests 8 (amended), 8b, 8c, 8d and 8e, appellant I requests as new auxiliary request 8/8f that the patent be maintained in the version that the opposition division had deemed to meet the requirements of the EPC (corresponding to withdrawn but not abandoned auxiliary request 8 filed with the grounds of appeal). New auxiliary request 8/8f should be admitted into the proceedings, because the primary purpose of an appeal procedure is to check the decision rendered by a lower instance.

Claim 1 of this request concerns the cartridge determining system and includes both the cartridge and the recording apparatus. The arguments presented in the context of the main request carry over to claim 1 according to auxiliary requests 8/8f which therefore does not include any added subject-matter.

Auxiliary request 9

Paragraph [0078] of the application as filed only requires the second signal blocking portion to project from the front wall. The subject-matter of claim 1 according to auxiliary request 9 now includes the movable member 21 and therefore does not add any subject-matter which was not originally disclosed in the application as filed.

Tenth auxiliary request

The subject-matter of claim 1 according to the tenth auxiliary request combines granted claims 1 and 4 and therefore does not contain any subject-matter which was not originally disclosed in the application as filed.

- XV. The arguments of appellants II and III in the written and oral proceedings can be summarised as follows:

Main request

A similar case was decided in decision T 711/13 and the logic set out therein applies likewise to the present case. Claim 1 as filed contained no structural features of the signal blocking portions. By omitting to indicate that the front wall is that of the moving member 21, the added features have been arbitrarily isolated from structural features to which they are linked, as disclosed in the application as filed. Dependent claim 6 as originally filed discloses that the movable member 21 comprises the first and second signal blocking portions. Contrary to the text of paragraph [0078] of the application as filed, the corresponding figures disclose a second blocking portion which is spaced from the front wall instead of projecting from it. In omitting the movable member 21, claim 1 as granted comprises subject-matter which was not originally disclosed.

Auxiliary requests 8 (amended), 8b, 8c, 8d, and 8e

Granted dependent claims 2 to 4 were identically originally filed as claims 3, 5 and 6. The subject-matter of these claims as such cannot be objected to under Article 100(c) EPC. Furthermore, amendments to these dependent claims thus cannot overcome an objection under

Article 100(c) EPC which was raised against a higher ranking claim. Therefore, any amendments to these dependent claims in auxiliary requests 8 (amended), 8b, 8c, 8d, and 8e are not occasioned by the ground for opposition under Article 100(c) EPC. These dependent claims were not objected to. Therefore, the amendments to granted dependent claims 2 to 4 made in auxiliary requests 8 (amended), 8b, 8c, 8d, and 8e do not meet the requirements of Rule 80 EPC. In consequence, auxiliary requests 8 (amended), 8b, 8c, 8d, and 8e are clearly not allowable and should not be admitted into the proceedings.

Auxiliary request 8/8f

Appellant I reconfirmed at the beginning of the oral proceedings before the board that auxiliary request 8 (filed with the grounds of appeal) had been withdrawn with the letter of 24 February 2017. It is contrary to procedural efficiency to accept that such a withdrawn request be re-introduced later in the same oral proceedings. New auxiliary request 8/8f should not be admitted into the proceedings at this late stage.

The arguments presented in the context of the main request carry over to claim 1 according to auxiliary request 8/8f which therefore still includes the same added subject-matter.

Auxiliary request 9

Paragraph [0078] of the application as filed cannot be read in isolation. Paragraph [0076] of the application as filed clearly requires that the movable member comprises the second signal blocking portion. Although the subject-matter of claim 1 according to auxiliary

request 9 includes the movable member 21, it still adds subject-matter which was not originally disclosed in the application as filed, namely, that the projecting first and second signal blocking portions are not necessarily part of the movable member 21.

Tenth auxiliary request

Appellants II and III do not object to either the claims of the tenth auxiliary request or the amended description.

Reasons for the Decision

1. *Main request - Article 100(c) EPC*

1.1 The following structural features (hereinafter *the projecting features*) of the signal blocking portions of claim 1 as granted (main request)

"a first signal blocking portion (191) projecting away from the front wall (161)"

and

"a second signal blocking portion (189, 199) projecting from the front wall (161) in a direction of insertion (30) of the ink cartridge (10) into a recording apparatus (250)"

require that the first and second signal blocking portions are *"projecting from the front wall"*, where the front wall is generically defined in an earlier feature of granted claim 1 as *"a front wall (161)"*.

Claim 1 as filed did not specify any structural features of the signal blocking portions. Such structural features of the signal blocking portions were only disclosed in the application as filed in the context of

the detailed description of the exemplary embodiments (figures 2(a) to 3(b) and 4(a) to 6 of the application as filed) or in dependent claim 6 as filed.

As pointed out by appellant I, paragraphs [0078] and [0079] describe the signal blocking portions as projecting from the front wall 161. However, the description of an embodiment must be read as a whole and paragraph [0073], which also belongs to the description of the same embodiment, clearly discloses that this front wall 161 is part of the movable member 21. In consequence, contrary to the opinion of appellant I, there is a clear structural union of the first and second signal blocking portions with the movable member 21, since they project from its front wall 161. There are no statements in the application as filed that the first and second signal blocking portions may project from an arbitrary front wall, i.e. from a front wall which is not necessarily part of movable member 21.

It thus also follows that, contrary to the opinion of appellant I, the omission of movable member 21 from the subject-matter of claim 1 requires a modification of the other features of claim 1: since the above *projecting features* were originally disclosed as being part of the movable member 21, these features would have to be omitted together with the movable member 21.

Appellant I's arguments that the movable member 21 has clearly different functions and/or is not necessary or essential for solving the problem of inaccurate cartridge detection on the part of the recording apparatus (application as published, column 1, lines 46 to column 2, line 10) cannot help a claim in which at least some features (namely the above *projecting features*), which were originally disclosed as features of the

movable member 21, are included in the subject-matter of claim 1 while omitting the movable member itself.

The combination of features "*a front wall (161)*" and the above *projecting features* of claim 1 as granted (main request) thus constitutes an intermediate generalisation in that the first and second signal blocking portions may project from a front wall which need not be part of the movable member 21. Such a generalisation has no basis in the application as filed. The skilled person is thus confronted with the added information that the movable member 21 is optional and that an ink cartridge without a movable member exhibits a front wall from which the first and second signal blocking portions project. Although the skilled person may understand that a front wall, which may be the front wall of a cartridge without a movable member 21, is the only structural feature which is needed to relate the projecting first and second signal blocking portions, this fact was not directly and unambiguously disclosed in the context of an ink cartridge in this generality in the application as filed.

General statements at the end of the description (e.g. paragraph [0128], application as published: "*other variations and modifications of the exemplary embodiments described above may be made*" or "*other embodiments will be apparent to those skilled in the art*") do not constitute, and thus cannot replace, a direct and unambiguous disclosure of the particular generalisation included in claim 1 as granted. The general statements at the end of the description are furthermore open ended and attempt to burden the skilled reader with having to work out which combinations of features from the detailed embodiments might be claimed together, while the applicant is supposedly dispensed from having

to present his invention in terms more general than mere detailed description of particular embodiments.

1.2 In consequence, the subject-matter of claim 1 as granted (main request) comprises added subject-matter contrary to Article 100(c) EPC 1973.

2. *Admissibility of auxiliary requests 8 (amended), 8b, 8c, 8d and 8e*

2.1 Amended dependent claim 3 (auxiliary requests 8 (amended) and 8d), respectively amended dependent claim 2 (auxiliary requests 8b, 8c and 8e) was submitted for the first time after appellant I had filed its grounds of appeal. It combines that subject-matter of dependent claims 2, 3 and 4 as granted which is not included in the respective claim 1 of the corresponding auxiliary request. Auxiliary requests 8 (amended), 8b, 8c, 8d and 8e thus constitute an amendment to appellant I's case.

According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

2.2 The amendments are contrary to Rule 80 EPC: The amended dependent claims cannot address the ground of opposition under Article 100(c) EPC (as argued on behalf of appellant I), because dependent claims 2, 3 and 4 as granted correspond identically to dependent claims 3, 5 and 6 as filed: The subject-matter of dependent claims 3, 5 and 6 as filed, by virtue of having been filed as such, cannot constitute subject-matter which extends

beyond the content of the application as filed. This also means that the subject-matter of identical dependent claims 2, 3 and 4 as granted cannot constitute subject-matter which extends beyond the content of the application as filed either. In consequence, no amendment to granted dependent claims 2, 3 and 4 is needed for compliance with the requirements of Article 100(c) EPC.

2.3 Appellant I's proposed interpretation of granted dependent claim 2 based on a broad interpretation of the higher ranking claim 1 is incorrect, because the claimed combination of features of claims 2 and 1 must be interpreted as a whole and not piecemeal with the features of claim 1 isolated from those of claim 2. The additional subject-matter of granted claim 2 (*wherein the third signal blocking portion is configured to move with respect to each of the first signal blocking portion and the second signal blocking portion*) thus rules out the possibility of the third signal blocking portion being part of the second signal blocking portion when considering the subject-matter of claims 1 and 2 in combination. In consequence, the case of added subject-matter which appellant I believed to have identified does not arise.

2.4 Appellants II and III considered that appellant I argued, that the subject-matter of dependent claims, granted as filed, may have given rise to further, follow-on objections under Article 100(c) EPC, when a higher ranking claim, that is referred back to, is itself subject to objections under Article 100(c) EPC. However, in such a situation, amendments to lower ranking dependent claims cannot serve to overcome objections under Article 100(c) EPC raised against a higher ranking claim, because the subsequent wording of a

lower ranking dependent claim does not influence the subject-matter of a higher ranking claim.

2.5 In consequence, amended dependent claims 3 (auxiliary requests 8 (amended) and 8d), respectively claims 2 (auxiliary requests 8b, 8c and 8e) were not occasioned by the ground for opposition under Article 100(c) EPC. Since no other ground for opposition under Article 100 EPC was advanced for these amendments either, these amendments do not meet the requirements of Rule 80 EPC.

2.6 Since auxiliary requests 8 (amended), 8b, 8b, 8d and 8e do not meet the requirements of Rule 80 EPC, they are not allowable. Introducing such requests into the procedure would be contrary to the need for procedural economy. The board therefore exercises its discretion under Article 13(1) RPBA to not admit auxiliary requests 8 (amended), 8b, 8c, 8d and 8e into the procedure.

3. *Auxiliary request 8/8f*

3.1 Admissibility

3.1.1 The request of appellant I during the oral proceedings before the board to reinstate auxiliary request 8 (but now named auxiliary request 8/8f) filed with the statement of grounds of appeal, after auxiliary request 8 had been replaced by the new auxiliary requests 8 (amended), 8b, 8c, 8d and 8e (filed with letter of 24 February 2017) amounts, in terms of procedure, to the very late filing of a new request.

Appellants II and III contended that the board should not allow appellant I to revert to a withdrawn request.

As stated above, appellant I's request to have one of its former requests considered has the status of a newly filed request. Hence it is necessary for the board to consider the admissibility of this request as it would with any late filed request. In this particular case, however, besides the criteria set out in Article 13(1) RPBA, the board also has to consider whether the fact that the newly filed request had previously been withdrawn during the appeal proceedings was per se a reason not to admit the request, in particular, when this request corresponds to the version of the patent upon which the opposition division had decided.

- 3.1.2 Regarding the criteria set out in Article 13(1) RPBA the board takes the following aspects into consideration.

History of the request

Auxiliary request 8, (now called auxiliary request 8/8f), corresponds to the version of the patent for which the interlocutory decision of the opposition division stated that it meets the requirements of the EPC.

In its preliminary opinion the board indicated that it was not persuaded that auxiliary request 8 met the grounds of opposition of Article 100(a) EPC and that the grounds of opposition of Article 100(c) EPC also needed to be discussed.

With the letter of 24 February 2017 appellant I replaced auxiliary request 8 initially filed with the grounds of appeal by auxiliary requests 8 (amended), 8b, 8c, 8d and 8e.

During the discussion of the admissibility of auxiliary requests 8 (amended), 8b, 8c, 8d and 8e, the board, after hearing all parties, noted that these requests did not meet the requirements of Rule 80 EPC. The board therefore decided that these new requests are not admitted.

The contents of the request

As stated above, the claims of this new request correspond to those of auxiliary request 8, which had been dealt with, both in the contested decision and the provisional opinion of the board. Appellants II and III are thus familiar with the subject-matter of the claims of this request.

In addition, the claims of the new request substantially correspond to the claims of the version of the patent that the opposition division deemed to meet the requirements of the EPC.

The subject-matter of claim 1 of the request is thus not new in the proceedings and could be dealt with in the oral proceedings. Under these circumstances the new request, in spite of being a late-filed request in the proceedings, does not in fact change the case as made out in the statement of grounds and does not introduce further complexity. It can be dealt with by appellants II and III and the board without any delay.

Accordingly the requirements of Article 13(1) and (3) RPBA are not an obstacle to the reintroduction of the request at this stage.

3.1.3 The board also had to consider whether the fact that the new request corresponds to a withdrawn request is, in addition to the requirements of Article 13 RPBA, enough to render the request inadmissible.

The board decided to exercise its power of discretion and exceptionally admit auxiliary request 8/8f (which had been dealt with in the contested decision) into the proceedings in this particular case. In the light of the negative conclusion on whether this request fulfills the requirements of Article 123(2) EPC set out below, no purpose is served by the board setting out at length its reasons for admitting this request.

3.2 Article 123(2) EPC

The "*ink cartridge determination system*" of amended claim 1 according to auxiliary request 8/8f comprises an ink cartridge with the combination of the *projecting features* of the signal blocking portions and the "*front wall (161)*" of granted claim 1.

In consequence, the arguments set out in point 1 above in the context of the main request carry over to the subject-matter of amended claim 1 according to auxiliary request 8/8f, in that the combination of the *projecting features* of the signal blocking portions and the "*front wall (161)*" of the cartridge include the same intermediate generalisation in that the first and second signal blocking portions may project from a front wall which need not be part of the movable member 21.

In consequence, the subject-matter of claim 1 according to auxiliary request 8/8f comprises added subject-

matter contrary to the requirements of Article 123(2) EPC.

4. *Auxiliary request 9 - Article 123(2) EPC*

- 4.1 As already noted in point 1 above, paragraph [0078] of the application as filed concerning an embodiment of the invention cannot be read in isolation. Paragraph [0076] of the application as filed belongs to the description of the same embodiment and requires that the movable member comprises the second signal blocking portion. The more general formulation of claim 6 as filed (corresponding to claim 4 as granted) also requires that the movable member comprises the first and second signal blocking portions.

Although the subject-matter of claim 1 according to auxiliary request 9 now includes the movable member 21, it still adds subject-matter which was not directly and unambiguously disclosed in the application as filed, namely that the projecting first and second signal blocking portions are not necessarily part of the movable member 21: the fact that first and second signal blocking portions can project from the front wall does not necessarily mean that the movable member comprises the first and second signal blocking portions.

In view of the above, a remittal to the department of first instance for further prosecution as requested in writing by appellant I with the letter of 24 February 2017 is not deemed appropriate.

The subject-matter of claim 1 according to auxiliary request 9 does not meet the requirements of Article 123(2) EPC.

5. *Tenth auxiliary request*

The subject-matter of granted claim 4 (identical to claim 6 as filed) is now included in the subject-matter of claim 1 as granted. In consequence, the claim sets out that the movable member comprises the first and second signal blocking portion. Paragraph [0078] provides a basis for the second signal blocking portion to project from the front wall (of the movable member) and paragraph [0079] provides a basis for first signal blocking portion to project from the front wall (of the movable member). Thus the subject-matter of claim 1 according to the tenth auxiliary request meets the requirements of Article 123(2) EPC.

The description was adapted to the claims of the tenth auxiliary request.

Appellants II and III did not raise any objections against the tenth auxiliary request and the board has no reasons to object either.

In view of the above, a remittal to the department of first instance for further prosecution as requested in writing by appellant I with the letter of 24 February 2017 is not deemed appropriate.

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 maintain the patent as amended in the following version:

Description:

Pages 3 to 13 of the patent specification.
Pages 2 and 14 received during the oral proceedings of 24 March 2017.

Claims:

No. 1 to 6 of the tenth auxiliary request received during the oral proceedings of 24 March 2017.

Drawings:

Figures 1 to 22(b) of the patent specification.

The Registrar:

The Chairman:



D. Meyfarth

P. Lanz

Decision electronically authenticated