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**Datasheet for the decision
of 1 February 2016**

Case Number: T 1727/12 - 3.2.05

Application Number: 06076929.6

Publication Number: 1767375

IPC: B41J33/36, B41J33/54

Language of the proceedings: EN

Title of invention:

Tape drive and printing apparatus

Patent Proprietor:

Videojet Technologies, Inc.

Opponent:

Markem-Imaje Limited

Relevant legal provisions:

EPC 1973 Art. 100(b), 111(1)

Keyword:

"Biogen sufficiency" (Biogen Inc. v Medeva plc [1996] UKHL 18)

Sufficiency of disclosure (yes)

- burden of proof (see reasons 1.1)

- in the whole claimed range (see reasons 1.5)

Remittal to the opposition division

Decisions cited:

G 0009/91, T 0026/81, T 0133/85, T 0042/90, T 0409/91



**Beschwerdekammern
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Case Number: T 1727/12 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 1 February 2016

Appellant: Videojet Technologies, Inc.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
23 July 2012 concerning maintenance of the
European Patent No. 1767375 in amended form.**

Composition of the Board:

Chairman M. Poock
Members: O. Randl
D. Rogers

Summary of Facts and Submissions

- I. The appeal of the the patent proprietor is directed against the interlocutory decision of the opposition division on the amended form in which the patent No. 1 767 375 could be maintained.

The opposition division had found the main request (patent as granted) as well as the first and second auxiliary requests not to comply with the requirements of Article 100(b) EPC 1973. The third auxiliary request was found to satisfy the requirements of the EPC.

- II. The opponent (Markem-Imaje Ltd.) has also filed an appeal against the decision of the opposition division but has withdrawn the opposition and the appeal before filing a statement of grounds of appeal.

A third-party intervention was filed by Markem-Imaje GmbH during the appeal proceedings and subsequently withdrawn.

As all oppositions have been withdrawn and the patent proprietor is the sole remaining appellant, the prohibition of *reformatio in peius* applies.

- III. The appellant requested that the impugned decision be set aside and the patent be maintained as granted, and in the event that the patent is not maintained as granted, that oral proceedings be arranged. No auxiliary requests have been filed.

- IV. Claims 1 and 3 to 5 of the main request (patent as granted) read:

"1. A tape drive comprising two stepper motors (14,15), two tape spool supports (8,12) on which spools of tape (7,11) may be mounted, each spool being drivable by a respective one of said stepper motors (14, 15), and a controller (17) for controlling the energisation of the motors such that the tape may be transported in at least one direction between spools mounted on the spool supports (8,12), wherein the controller (17) is operative to energise both motors (14, 15) to drive the spools of tape in the direction of tape transport, to monitor tension in a tape being transported between spools (7, 11) mounted on the spool supports (8, 12) and to control the motors (14, 15) to maintain the monitored tension between predetermined limits."

"3. A tape drive according to claim 1 or 2, wherein means are provided to monitor the power supplied to at least one of the motors (14,15) and to calculate an estimate of tape tension from the monitored power."

"4. A tape drive according to claim 3, comprising a power supply (80), and a stepper motor drive means (81, 82) for supplying current sequentially to windings of the stepper motors (14, 15) from the power supply (80), the power being monitored by means (84, 86) for monitoring the magnitude of voltage and/or current supplied to the motors (14,15) and/or the motor drive means (81, 82)."

"5. A tape drive according to claim 4, comprising a regulated power supply (80) providing a substantially constant voltage to the stepper motor drive means (81,82), the monitoring means monitoring the magnitude of current supplied to the stepper motor drive means."

- V. The appellant argued that it was not entirely clear what the opposition division meant by "Biogen sufficiency" and why the objection was raised. The objection was completely without foundation on the facts of the case. Claim 1 was broader than the specific description but the skilled person could easily realise the invention using only the specification and his common general knowledge.

Reasons for the Decision

1. Sufficiency of disclosure

The opposition division distinguished between "classical insufficiency" and "Biogen sufficiency". It found the invention as exemplified in the patent specification to be disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

It then considered the subject-matter of claim 1 and found that "the skilled person would not be able to carry out the invention without using the tension monitoring disclosed in claims 3 to 5" (Grounds for the decision, sheet 9, third paragraph). From this lack of "Biogen sufficiency" it concluded that claim 1 did not meet the requirements of Articles 100(b) and 83 EPC 1973.

1.1 Burden of proof

A principle intrinsic to EPO proceedings is that the party who raises an objection bears the burden of proving it (see "Case Law of the Boards of Appeal of

the EPO", 7th edition, 2013, III.G.5.1.1). The application of this principle to opposition proceedings leads to the conclusion that the burden of proof in respect of the grounds for opposition raised by an opponent lies on the opponent. An opposition division may, in application of Article 114(1) EPC, of its own motion raise a ground for opposition not covered by the notice of opposition (see decision G 9/91 (OJ EPO, 1993, 408), point 16 of the reasons) or a *fortiori* raise new arguments in respect of a ground for opposition covered by the notice of opposition, but if it does so, it has to bear the burden of proof for its objections.

1.2 "Biogen sufficiency"

To the best knowledge of the board, the concept of "Biogen sufficiency" is not part of the established jurisprudence of the boards of appeal of the EPO and is not commonly used in EPO proceedings.

However, as an Internet search easily shows, the concept is well known in the UK. It has its origin in a decision handed down by the House of Lords on October 31, 1996 (Biogen v. Medeva, [1997] RPC 1). This decision concerned the patentability of a biotechnology invention and mentioned, as an *obiter dictum*, that under Article 83 of the EPC, the EPO had jurisdiction "to hold a patent invalid on the substantive ground that, as the EPO said in Exxon/Fuel Oils (T 409/91) [1994] OJ EPO 653, para. 3.3., the extent of the monopoly claimed exceeds the technical contribution to the art made by the invention as described in the specification" (point 80 of the decision).

Decision T 409/91 states:

"... in the Board's judgment, in order to fulfil the requirement of Art. 83 EPC, the application as filed must contain sufficient information to allow a person skilled in the art, using his common general knowledge, to carry out the invention within the whole area that is claimed." (Reasons, point 2), and

"Art. 84 EPC also requires that the claims must be supported by the description, in other words it is the definition of the invention in the claims that needs support. In the Board's judgment, this requirement reflects the general legal principle that the extent of the patent monopoly, as defined by the claims, should correspond to the technical contribution to the art in order for it to be supported, or justified (see T 133/85, OJ EPO 1988, 441). This means that the definitions in the claims should essentially correspond to the scope of the invention as disclosed in the description. In other words, as was stated in Decision T 26/81 (OJ EPO 1982, 211, point 4 of the reasons), the claims should not extend to subject-matter which, after reading the description, would still not be at the disposal of the person skilled in the art.

Consequently, a technical feature which is described and highlighted in the description as being an essential feature of the invention, must also be a part of the independent claim or claims defining this invention (see also Decision T 133/85, point 2 of the reasons)" (Reasons, point 3.3; it is this passage that is cited by Lord Hoffmann in *Biogen v. Medeva*)

As Lord Hoffmann's *obiter dictum* in *Biogen v. Medeva* expressly refers to the jurisprudence of the Boards of appeal, there was no need for the opposition division

to invoke the concept of "Biogen sufficiency". When using this concept, the opposition division should at least have explained what exactly was meant, namely that the extent of the monopoly claimed ought not to exceed the technical contribution to the art made by the invention as described in the specification.

The opposition division appears to have considered that claim 1 could not be said to be sufficiently disclosed within the whole scope of the claim because the only invention disclosed in the specification corresponded to the combination of claims 1 and 3 to 5.

- 1.3 First the board notes that the statement of decision T 409/91 cited in *Biogen v. Medeva* referred to the requirements of Article 84 EPC 1973 rather than to Article 83 EPC 1973 but then stated that "... since Art. 83 relates to the disclosure of the invention, whilst Art. 84 deals with the definition of the invention by the claims, the underlying purpose of the requirement of support by the description, insofar as its substantive aspect is concerned, and of the requirement of sufficient disclosure is the same, namely to ensure that the patent monopoly should be justified by the actual technical contribution to the art." (Reasons, point 3.3, fourth paragraph).

Case T 409/91 was an *ex parte* case, which means that the argument based on the common purpose of Articles 83 and 84 EPC 1973 is unproblematic, because an application can be refused for lack of compliance with each of Articles 83 and 84 EPC 1973. The present case, however, is an opposition appeal case, which means that it is necessary to clearly distinguish the requirements of Article 83 EPC 1973 (sufficiency of disclosure) and Article 84 EPC 1973 (clarity and support in the description). Lack of clarity and lack of support are

not grounds for opposition under Article 100 EPC 1973 and cannot be transformed into such grounds by means of teleological considerations. It is, therefore, irrelevant to the present case whether claim 1 has sufficient support in the description; the only question to be raised under Article 100(b) EPC 1973 is whether the opposed patent discloses the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

1.4 The opposition division has justified its dismissal of the main request as follows:

"The patent only discloses how to monitor the tension in the tape by monitoring the power supplied to the motors by monitoring the magnitude of current using a regulated power supply, since the patent does not give any technically enabling disclosure to use another method to monitor the tension in the tape and since claim 1 is claiming a controller operative to monitor tension in the tape without monitoring the power supplied to the motors (claim 3) by monitoring the magnitude of current (claim 4) using a regulated power supply (claim 5), the skilled person would not be able to carry out the invention without using the tension monitoring disclosed in claims 3 to 5. Moreover, there is no hint in the available prior art how to maintain the tension without contacting the tape. The only solution to maintain the tension for the skilled person would be the one above identified (sic). The subject matter of claim 1 of the main request does not meet the requirements of articles 100(b) and 83 EPC." (Grounds for the decision, sheet 9, third paragraph; emphasis of the division).

1.5 The board is not persuaded by this reasoning of the opposition division, for the following reasons:

Claim 1 is directed at a tape drive. This drive comprises a controller which is *inter alia* operative to monitor tension in the tape and to control the motors to maintain the monitored tension between predetermined limits.

Claim 3 adds that the power supplied to at least one of the stepping motors is monitored and used to calculate an estimate of the tension of the tape, so as to monitor the tension of the tape.

Claim 4 further adds that the monitoring of the power is itself indirect, because the directly monitored quantities are the magnitude of voltage and/or current supplied to the motors and/or the motor drive means.

According to claim 5, a constant voltage is supplied to the stepper motor and what is monitored is the magnitude of current supplied to the stepper motor drive means.

The statement of the opposition division according to which "... claim 1 is claiming a controller operative to monitor tension in the tape without monitoring the power supplied to the motors (claim 3) by monitoring the magnitude of current (claim 4) using a regulated power supply (claim 5) ..." (emphasis added by the board) is not correct because claim 1 does not comprise any such disclaimer. Claim 1 simply does not state how the tension is monitored; it certainly does not exclude monitoring as described in claims 3 to 5.

The statement of the opposition division that "the skilled person would not be able to carry out the invention without using the tension monitoring disclosed in claims 3 to 5" may be correct, but is not sufficient to justify the conclusion of the opposition division that the skilled person is thus hindered from carrying out the invention. The argument would be correct if there clearly were other options than what is disclosed in the dependent claims or in the patent specification and if the skilled person would not know how to carry them out. This has, however, not been established by the opposition division - although it bore the burden of proof. The opposition division has presumed the existence of alternatives and the impossibility for the skilled person to carry them out. The objection, therefore, appears to be purely speculative and, as a consequence, unfounded.

The same holds true for the argument according to which there is no hint in the available prior art how to maintain the tension without contacting the tape. The fact that the skilled person is aware of only one way of maintaining the tension (which it knows how to carry out) cannot possibly justify an objection under Article 100(b) EPC 1973.

1.6 Thus the board has reached the conclusion that the opposition division has not established that claim 1 of the main request fails to comply with the requirements of Article 100(b) EPC 1973.

2. Remittal to the opposition division

In the present case the opposition division dismissed the main request exclusively for lack of compliance

with Articles 100(b) and 83 EPC 1973 and left the other issues undecided.

Since proceedings before the boards of appeal are primarily concerned with the examination of the contested decision, remittal of the case to the opposition division in accordance with Article 111(1) EPC 1973 is normally considered by the boards in cases where the opposition division has issued a decision solely upon a particular issue and leaves substantive issues such as novelty (Article 54 EPC 1973) or inventive step (Article 56 EPC 1973) undecided.

The board, therefore, considers it appropriate to remit the case to the first instance for consideration of the undecided issues.

3. Request for oral proceedings

In its statement of grounds of appeal, item 4, the appellant has made the following statement:

"In the event that the Patent is not to be maintained in the form in which it was granted, the Proprietor requests oral proceedings."

The decision to remit the case to the opposition division for further prosecution does not imply that the patent will not be maintained as granted. According to the established jurisprudence of the boards of appeal, the appellant is not adversely affected by this decision, so that there is no need to grant the auxiliary request for oral proceedings (see "Case Law of the Boards of Appeal of the EPO", 7th edition, 2013, III.C.2.5, in particular decision T 42/90).

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.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated