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**Datasheet for the decision  
of 11 April 2016**

**Case Number:** T 2154/12 - 3.2.05

**Application Number:** 06012968.1

**Publication Number:** 1772269

**IPC:** B41J2/175

**Language of the proceedings:** EN

**Title of invention:**

Ink Cartridge

**Patent Proprietor:**

Brother Kogyo Kabushiki Kaisha

**Opponent:**

Pelikan Vertriebsges. mbH & Co. KG

**Relevant legal provisions:**

EPC Art. 123(2)

RPBA Art. 13

EPC 1973 R. 67

**Keyword:**

Amendments - added subject-matter (yes)

Late-filed request - change of subject-matter

Reimbursement of appeal fee - substantial procedural violation  
(no)



**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 2154/12 - 3.2.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.05**  
**of 11 April 2016**

**Appellant:** Brother Kogyo Kabushiki Kaisha  
(Patent Proprietor) 15-1 Naeshiro-cho,  
Mizuho-ku  
Nagoya-shi, Aichi-ken 467-8561 (JP)

**Representative:** Prüfer & Partner mbB  
Patentanwälte Rechtsanwälte  
Sohnckestraße 12  
81479 München (DE)

**Respondent:** Pelikan Vertriebsges. mbH & Co. KG  
(Opponent) Werftstrasse 9  
30163 Hannover (DE)

**Representative:** Eugen Popp  
Meissner, Bolte & Partner GbR  
Widenmayerstraße 47  
80538 München (DE)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 6 September  
2012 revoking European patent No. 1772269  
pursuant to Article 101(3)(b) EPC.**

**Composition of the Board:**

**Chairman** M. Pooch  
**Members:** S. Bridge  
G. Weiss

## **Summary of Facts and Submissions**

I. The appeal was lodged against the decision of the opposition division revoking the European patent No. 1 772 269.

II. An opposition was filed against granted claims 1 to 12 based on Article 100(a) EPC (lack of novelty, Article 54 EPC 1973 and lack of inventive step, Article 56 EPC 1973).

The opponent withdrew its opposition with the letter dated 9 August 2013 and is not party to these appeal proceedings.

III. Oral proceedings were held before the board of appeal on 11 April 2016.

IV. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent in suit be maintained in amended form on the basis of the sets of claims respectively filed with letter dated 11 March 2016 as main request or auxiliary requests 2 to 6 or auxiliary request 1 submitted at the oral proceedings before the board.  
Furthermore, the appellant requested the reimbursement of the appeal fee.

V. Claim 1 according to the main request reads as follows:

"Ink cartridge (14) for use in an inkjet recording apparatus (11),  
said ink cartridge (14) being structured to be horizontally inserted into the ink jet recording apparatus in a mounting direction;  
said ink cartridge (14) comprising:

an ink supplying part (120) arranged on a front side (210b, 220b) of said ink cartridge (14) in the mounting direction for supplying ink from said ink cartridge to the ink jet recording apparatus,  
a detection part (140) arranged on said front side (210b, 220b) of said ink cartridge (14), said detection part (140) structured to be placed between two portions of an optical sensor (57) of the ink jet recording apparatus, the detection part consisting of a translucent material allowing light emitted from the optical sensor (57) to pass through the detection part (140), in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge (14), characterized in that  
said detection part (140) is arranged above said ink supplying part (120), when said ink cartridge (14) is in a mounting orientation,  
said detection part (140) comprises a pair of opposing surfaces (140a, 140b) for facing the two portions of the optical sensor, the opposing surfaces (140a, 140b) extending substantially vertically, when said ink cartridge (14) is in the mounting orientation, and  
said ink supplying part (120) projects from the front side (210b, 220b) of the ink cartridge (14) and has an opening (600a) at a position farther frontward in the mounting direction than the detection part (140), when said ink cartridge (14) is in the mounting orientation."

VI. Claim 1 according to auxiliary request 1 differs from claim 1 according to the main request in that, the text

"Ink cartridge (14) for use in an inkjet recording apparatus (11)"

is replaced by

"A system comprising an ink cartridge (14) for an ink jet recording apparatus and an accommodation member (50) for accommodating the ink cartridge (14) in the ink jet recording apparatus into which the ink cartridge (14) is horizontally mounted; the accommodation member (50) comprising: an extracting member (49) arranged at an inner side of the accommodation member (50) for extracting ink from the ink cartridge (14), and an optical sensor (57) arranged at an inner side of the accommodation member (50) and including a light emitting part (57a) and a light receiving part (57b) for detecting that the ink cartridge (14) is mounted to the accommodation member";

all instances of the expression "detection part" are replaced by the expression "irradiated part"

and the text

"the detection part consisting of a translucent material allowing light emitted from the optical sensor (57) to pass through the detection part (140), in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge (14) "

is replaced by

"the irradiated part allowing light emitted from the optical sensor (57) to pass through the irradiated part (140)".

VII. The respective claim 1 according to auxiliary requests 2 to 5, each concern an "ink cartridge (14) for use in

an inkjet recording apparatus (11)" and comprise the text

"a detection part (140) arranged on said front side (210b, 220b) of said ink cartridge (14), said detection part (140) structured to be placed between two portions of an optical sensor (57) of the ink jet recording apparatus, the detection part consisting of a translucent material allowing light emitted from the optical sensor (57) to pass through the detection part (140), in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge (14)".

VIII. The claims of auxiliary request 6 consists of granted claims 13 to 15 renumbered as claims 1 to 3.

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

*Main request and auxiliary requests 2 to 5*

The features of claim 1 according to the main request concerning the detection part 140 consisting of a translucent material without including the moving sensor arm 470 do not constitute an intermediate generalisation: The skilled person knows that there are other possibilities for detecting ink in addition to those involving a sensor arm 470. The patent application as filed does not rule out such additional possibilities, even if there is no explicit text disclosing ink detection without the moving sensor arm.

In addition, paragraph [0007] of the patent application as published implicitly discloses that the irradiated part is translucent by allowing light emitted from the light emitting part of the transmission optical sensor

to pass through the irradiated part and be received by the light receiving part of this sensor. Read as a whole, the patent application further requires the irradiated part and the detection part to be the same part.

Similarly, paragraph [0016] of the patent application as published discloses that the moving member *may* have a shading member, thereby implying that the invention may be practiced without the shading member so that the shading member is in fact optional.

The arguments presented in the context of the main request apply likewise to the respective claim 1 according to auxiliary requests 2 to 5.

Therefore, the subject-matter of claim 1 respectively according to the main request and auxiliary requests 2 to 5 satisfies the requirements of Article 123(2) EPC.

*Auxiliary request 1 - Admissibility*

Auxiliary request 1 constitutes a response to the findings of the board during oral proceedings and takes into account the preliminary opinion of the board notified with the summons to oral proceedings by including the accommodation member into the subject-matter of claim 1. Therefore, auxiliary request 1 should be admitted into the proceedings.

*Auxiliary request 6*

Auxiliary request 6 limits the claimed subject-matter to granted claims 13 to 15 which lie outside the scope of the opposition and hence outside the scope of the present appeal.

*Request for reimbursement of the appeal fee*

There was no opportunity to file auxiliary requests during the opposition proceedings and the opponent had the last word in the first instance proceedings. Since the opposition only concerned granted claims 1 to 12, the opposition division acted incorrectly in revoking the patent as granted as a whole. For these reasons, the request for reimbursement of the appeal fee is justified.

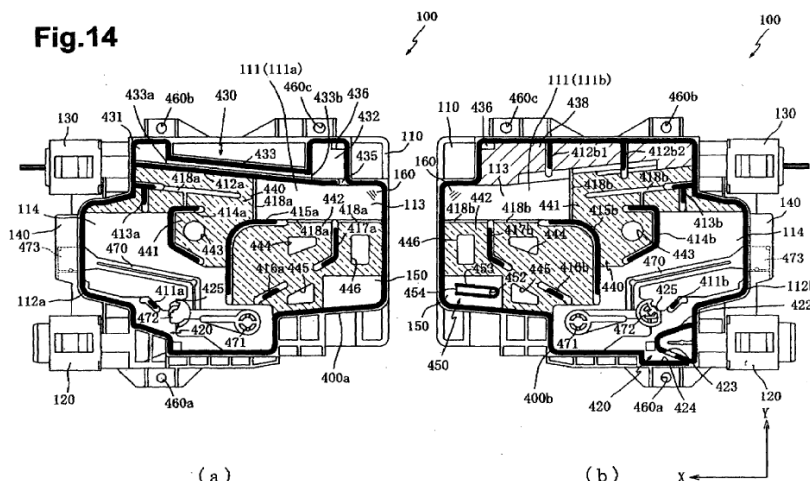


### Reasons for the Decision

1. *Main request*

1.1 Claim 1 according to the main request was amended with respect to granted claim 1 in that the "irradiated part" has been further limited to a "detection part consisting of a translucent material allowing light emitted from the optical sensor (57) to pass through the detection part (140), in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge (14)".

1.2 According to the appellant, the basis for this amendment can be found in paragraphs [0106] and [0292] of the patent application as published. These paragraphs are part of the detailed disclosure of embodiments of the invention, such as Figure 14.



As also noted by the appellant, all embodiments disclose a moving sensor arm 470 "in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge". In consequence, the cited paragraphs do not provide a basis for claiming a "detection part 140" "in order to detect the amount of ink remaining in an

*ink reservoir of the ink cartridge*" without the use of a moving sensor arm 470.

1.3 Paragraph [0007] of the patent application as published discloses that the "*irradiated part*" of the ink cartridge "*is positioned between the light emitting part and the light receiving part of the transmission optical sensor when the ink cartridge is mounted in the ink jet recording apparatus*" (column 2, lines 16 to 20). Since this paragraph does not disclose any ink detection function for the "*irradiated part*", it cannot provide a basis for a "*detection part*" being provided "*in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge*" without the use of a moving sensor arm 470.

1.4 Paragraph [0016] of the patent application as published discloses that "*the moving member may have a shading member, which is arranged at one end of the moving member and positioned in the inner space of the irradiated part, a floating member, which is arranged at another end of the moving member and moves according to the amount of residual ink in the ink storing chamber, and a support member, which is arranged between the shading member and the floating member*" (column 4, lines 7 to 14). When read as a whole, this sentence describes a possible relative arrangement of the shading member, the floating member and the support member on the *moving member* which is understood as the sensor arm 470 of the embodiment shown in figure 14. Since this paragraph does not describe the moving member as being optional for the detection of ink, it cannot provide a basis for a "*detection part*" being provided "*in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge*" without the use of a moving sensor arm 470.

- 1.5 There are no passages in the patent application as filed disclosing ink detection without a moving sensor arm 470.
- 1.6 It was further argued on behalf of the appellant that the patent application as filed does not rule out the possibility of means for "*detect[ing] the amount of ink remaining in an ink reservoir of the ink cartridge*" without a moving sensor arm 470 and that the skilled person knows that there are other possibilities for detecting ink in addition to those involving a sensor arm 470.

The fact that the application as filed does not explicitly rule out the possibility of means for "*detect[ing] the amount of ink remaining in an ink reservoir of the ink cartridge*" without a moving sensor arm 470 does not in itself amount to a direct and unambiguous disclosure of a "*detection part*" being provided "*in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge*" can be provided as part of the disclosed invention without the use of a moving sensor arm 470.

Similarly, the alleged knowledge of the skilled person cannot be substituted for the need to disclose the invention in the application as filed.

- 1.7 Thus, the feature of claim 1 (main request) limiting the "*irradiated part*" to a "*detection part*" "*in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge (14)*" without the use of a moving sensor arm 470 has no basis in the application as filed.

Therefore, the subject-matter of claim 1 according to the main request does not meet the requirements of Article 123(2) EPC.

2. *Auxiliary requests 2 to 5*

The respective claim 1 according to auxiliary requests 2 to 5 each comprises the passage:

*"a detection part (140) arranged on said front side (210b, 220b) of said ink cartridge (14), said detection part (140) structured to be placed between two portions of an optical sensor (57) of the ink jet recording apparatus, the detection part consisting of a translucent material allowing light emitted from the optical sensor (57) to pass through the detection part (140), in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge (14)".*

Thus, each claim 1 according to auxiliary requests 2 to 5 has been amended to at least limit the "irradiated part" of granted claim 1 to a "detection part" "in order to detect the amount of ink remaining in an ink reservoir of the ink cartridge (14)" without the use of a moving sensor arm 470.

In consequence, the reasons advanced with respect to claim 1 according to the main request in point 1 above carry over correspondingly to the respective claim 1 according to auxiliary requests 2 to 5.

Therefore, the subject-matter of the respective claim 1 according to auxiliary requests 2 to 5 does not meet the requirements of Article 123(2) EPC.

3. *Auxiliary request 1 - Admissibility*

Auxiliary request 1 was only filed at the end of the oral proceedings before the board.

This request constitutes a fresh case, because the subject-matter of claim 1 consists of a new mixture of the subject-matters of granted claims 1 and 13 which has never before been presented in this manner either in the opposition proceedings or during the appeal. In particular, the "*detection part*" is no longer being claimed and instead the claim language reverts to the broader "*irradiated part*" which was not the subject-matter of any of the requests relating to the opposed subject-matter pending at the beginning of the oral proceedings before the board. The board thus cannot be expected to deal with such an unexpected change of subject-matter this late in the appeal oral proceedings.

In consequence, auxiliary request 1 is not admitted into the proceedings (Article 13(3) RPBA).

4. *Auxiliary request 6*

Auxiliary request 6 limits the claimed subject-matter to granted claims 13 to 15 (suitably renumbered as claims 1 to 3) which lie outside the scope of the opposition and hence outside the scope of the present appeal.

Since the description has been adapted to the subject-matter of granted claims 13 to 15 (suitably renumbered as claims 1 to 3), this request succeeds without further examination.

5. *Request for reimbursement of the appeal fee*

5.1 It was advanced on behalf of the appellant that there was no opportunity to file auxiliary requests during the opposition proceedings and the opponent had the last word in the first instance proceedings.

The board notes that with the letter dated 20 January 2010 the appellant filed an amended set of claims 1 to 14 as main request during the opposition proceedings.

With the letter dated 30 July 2010 the opponent responded to this amended set of claims 1 to 14.

The decision of the opposition division was issued on 6 September 2012.

Since the decision was issued more than two years after the last reply of the opponent, the board considers that the appellant had had enough time to file further requests, including a request for oral proceedings. Since the appellant had not done so, it was not up to the opposition division to elicit additional requests from a party in an inter-partes procedure.

5.2 It was further advanced on behalf of the appellant that the opposition division acted incorrectly in revoking the patent as granted as a whole, given that the opposition only concerned granted claims 1 to 12.

The principle of party disposition only allows the opposition division to decide upon requests as filed by the parties. Since the appellant only had a single request during the opposition procedure, and the opposition division decided that this request contained

a claim 1 which did not meet the requirements of the EPC, the opposition division had no choice but to refuse this request as a whole, which, in the absence of any other requests, resulted in the revocation of the patent.

It is only in the present appeal proceedings, that the appellant filed auxiliary requests, including one (auxiliary request 6) limiting the subject-matter to the non-opposed parts of the patent in suit.

- 5.3 It follows that the opposition division did not commit a substantial procedural violation. In consequence, none of the arguments advanced on behalf of the appellant justify the request for reimbursement of the appeal fee (Rule 67 EPC 1973 applicable here).

## 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:
  - claims 1 to 3 filed with letter dated 11 March 2016 as auxiliary request 6;
  - description, page 2 submitted at the oral proceedings;
  - description, pages 3 to 76 of the patent specification;
  - figures 1 to 67 of the patent specification.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



N. Schneider

M. Poock

Decision electronically authenticated