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**Datasheet for the decision
of 17 December 2019**

Case Number: T 0344/16 - 3.2.05

Application Number: 10168523.8

Publication Number: 2230087

IPC: B41F13/00, B41K3/10, B41K3/12

Language of the proceedings: EN

Title of invention:
Numbering device for typographic numbering having a releasable indexing mechanism

Patent Proprietor:
KBA-NotaSys SA

Opponent:
Paul Leibinger GmbH & Co. KG Nummerier- und Markierungssysteme

Headword:

Relevant legal provisions:
EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (main request - yes,
auxiliary request - no)

Decisions cited:

G 0001/06, G 0002/10, J 0015/85

Catchword:



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Boards of Appeal
Chambres de recours

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Case Number: T 0344/16 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 17 December 2019

Appellant:
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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
8 December 2015 concerning maintenance of the
European Patent No. 2230087 in amended form.**

Composition of the Board:

Chairman M. Pooock
Members: P. Lanz
 C. Brandt

Summary of Facts and Submissions

- I. Appeals were lodged by the opponent and the patent proprietor against the interlocutory decision of the opposition division on the maintenance of European patent No. 2 230 087 as amended according to auxiliary request 1.
- II. During the opposition proceedings, the opponent had raised the grounds for opposition according to Article 100(a) EPC in conjunction with Article 54 or Article 56 EPC (lack of novelty and lack of inventive step) as well as Articles 100(b) and 100(c) EPC.
- III. Oral proceedings were held before the board of appeal on 17 December 2019.
- IV. Appellant I (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

Appellant II (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request filed with the statement of grounds of appeal of 14 April 2016, or on the basis of the auxiliary request dated 11 November 2019.

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

"A numbering device (1) for carrying out numbering in sheet-fed or web-fed numbering presses, said numbering device (1) comprising a casing and a numbering unit (6) with rotatable numbering wheels (7) carrying alpha-numerical symbols thereon, which numbering wheels (7)

are disposed next to each other and rotate about a common rotation axis, said numbering device further comprising electro-mechanical actuation means for setting the position of said numbering wheels (7), wherein said electro-mechanical actuation means are entirely located within an inner space of the casing of said numbering device (1) and are mechanically autonomous, said electro-mechanical actuation means comprising a plurality of independent driving means (15, 18-23; 23*) for actuating a corresponding plurality of said numbering wheels (7), wherein said numbering device (1) further comprises a releasable indexing mechanism (7a', 510, 520) for mechanically aligning and maintaining the position of said numbering wheels (7) during a numbering operation, once the numbering wheels (7) have been rotated to their target positions, wherein said releasable indexing mechanism (7a', 510, 520) is an electromagnetically-actuated mechanism, wherein said releasable indexing mechanism (7a', 510, 520) comprises an indexing member (510) which is actuated by means of an electromagnetic energizing coil (520), and wherein said indexing member (510) and electromagnetic energizing coil (520) are located inside said numbering wheels (7) for cooperation with indexing grooves (7a') provided on an inner periphery of the numbering wheels (7)."

VI. Compared with the main request, claim 1 according to the auxiliary request comprises the following additional features:

"... and wherein the numbering wheels (7) are mounted for rotation about a common shaft (17; 17*) which is supported at both ends onto bearings provided in side frame parts (3, 3'; 303) of the casing, ..."

VII. The arguments of appellant I (opponent) can be summarised as follows:

During the examination proceedings the feature of the electro-mechanical actuation means being entirely located within an inner space of the casing of the numbering device was added to claim 1. However, according to paragraph [0028] of the divisional application this aspect was not claimed. Following the general practice of the EPO, this statement in the divisional application was equivalent to an abandonment. This was also reflected in the granted patent, where paragraphs [0028] to [0031] did not refer to the abandoned aspect. Under these circumstances, third parties would rely on the statement in the published application that the aspect of the location of the electro-mechanical actuation means was definitively abandoned. Decision J 15/85 found that third parties could rely that no protection could be sought in a subsequent application for subject-matter which was still present but not any longer claimed in the earlier application. In decisions G 1/05 and G 1/06 (see Reasons 11.2) the Enlarged Board of Appeal held that content which had been omitted in an earlier application could not be re-introduced into this or a subsequent application. In view of this, the inclusion of the previously abandoned feature relating to the location of the electro-mechanical actuation means in claim 1 of the main request and the auxiliary request went beyond the disclosure in the divisional application as filed and was therefore not allowable.

In the divisional application as filed (see paragraph [0032] of the published application), the electro-mechanical actuation means were disclosed as being completely located within an inner space of the

numbering device, thus forming a very compact arrangement. Paragraph [0024] equally emphasised the necessity of the numbering device having a small size. According to all embodiments the electro-mechanical actuation means were entirely located within the numbering device. Thus, in the divisional application as filed the inner space was defined by reference to the compact numbering device, whereas the present claim defined the inner space in view of an undefined casing, which could be substantially bigger than the numbering device. According to paragraphs [0018] and [0019] of the published application it was difficult to integrate the stepping motors within the numbering device. Moreover, with a casing having an undefined size the original effect of a very compact arrangement was not necessarily achieved. Already for these reasons, the claim amendment violated the provisions of Article 123(2) EPC (see decisions T 17/86 and T 284/94). In the divisional application as filed, there was no direct and unambiguous disclosure of the generalised definition of the inner space according to the present claim, as required by the gold standard emphasised in decision G 2/10. Consequently, the subject-matter of claim 1 of the main request went beyond the content of the application as filed.

Regarding claim 1 of the auxiliary request it was noted that according to both variants of the casing (see paragraph [0069] of the published application) the shaft of the numbering unit was supported in the side frame parts of the casing. However, in view of the disclosure of paragraph [0069] the features of the supporting pieces or supporting portion were missing from the claim. Paragraph [0042] of the published application specifically related to the variant shown in Figure 3 and did thus not provide a general basis

for the claim amendment. The references to the side frame parts in the claim did not exclude that the other parts of the casing could project with respect to the numbering device. For these reasons, the subject-matter of claim 1 of the auxiliary request went beyond the content of the application as filed.

VIII. The submissions of appellant II (patent proprietor) may be summarised as follows:

Paragraph [0028] of the divisional application as filed only stated that the aspect of the invention that the electro-mechanical actuation means are entirely located within the numbering device and are mechanically autonomous was not claimed. This statement could not be construed as an abandonment of the aspect in question. Generally, any abandonment of subject-matter had to be unequivocal. This requirement was clearly not met in the present case as paragraph [0032] of the published application explicitly referred this aspect of the invention. Moreover, the claims in the application and in the patent were both directed to a numbering device with the only difference that the claimed numbering device in the patent was further limited with additional features. Thus, there was no disadvantage for third parties.

The subject-matter of claim 1 of the main request was in line with the requirements of Article 123(2) EPC. The application clearly disclosed that the electro-mechanical actuation means were completely located within an inner space of the numbering device. This obviated the need for an additional cabinet and thus allowed for a compact design of the numbering device as stated in paragraph [0032] of the application, independently of its actual size. Against this

background, it made no difference from a functional point of view whether the inner space was defined by reference to the numbering device or its casing. Therefore, the subject-matter of claim 1 according to the main request met the requirements of Article 123(2) EPC.

The amendment of claim 1 according to the auxiliary request reflected the disclosure in paragraph [0042] of the published divisional application. Therefore, the subject-matter of claim 1 according to the auxiliary request equally met the requirements of Article 123(2) EPC.

Reasons for the Decision

1. Main request

1.1 The parties' dispute regarding the main request hinges on the question of whether the wording of claim 1

"wherein said electro-mechanical actuation means are entirely located within an inner space of the casing of said numbering device (1)"

goes beyond the content of the divisional application as filed.

1.2 Appellant I first points to the fact that paragraph [0028] of the published application (corresponding to page 7, line 29 to page 8, line 3 of the divisional application as filed) contains the following statement:

"According to an aspect of the invention not claimed herein, the electro-mechanical actuation means are entirely located within the numbering device and are

mechanically autonomous (i.e. do not require any external mechanical coupling for actuating the numbering wheels), the electro-mechanical actuation means comprising a plurality of independent driving means for actuating a corresponding plurality of the numbering wheels."

It is contested whether the wording "*aspect of the invention not claimed herein*" is to be read as a definitive abandonment of the aspect of the location of the electro-mechanical actuation means being entirely within the numbering device, as suggested by appellant I with reference to decision J 15/85.

- 1.3 The board notes that the wording "*an aspect of the invention not claimed herein*", according to its ordinary meaning, merely states that the aspect in question belongs to the claimed invention, however without forming part of the claims of the divisional application. Its literal sense does hence not lead to the conclusion that this aspect is abandoned. According to established case law, a declaration of withdrawal or abandonment can only be accepted if it is unqualified and unequivocal (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, IV.B. 3.7.1 and G 1/06, OJ EPO 2008, 307, Reasons 11.2, first paragraph). Already on these grounds, the contested statement in paragraph [0028] of the published application cannot be construed in the sense that the aspect of the location of the electro-mechanical actuation means being entirely within the numbering device is definitively abandoned. By the same token, the limitations defined in decision G 1/06 (*supra*) regarding claims directed to previously unequivocally omitted content have no bearing on the present case.

1.4 Moreover, it is observed that decision J 15/85, which appellant I relies upon, substantially differs from the case at hand. J 15/85 relates to a situation where the interests of the public do not allow that claims directed to a certain subject-matter (here: the composition *per se*), which had been unequivocally abandoned in an earlier application, be pursued in a divisional application. In the present case, the claims in the divisional patent application and in the granted patent are both directed to a numbering device with the only difference that the claimed numbering device in the patent is further limited with additional features. Under these circumstances, there is no shift of protection and no disadvantage for third parties.

1.5 For these reasons, the introductory statement in paragraph [0028] of the published divisional application does not *per se* constitute an obstacle to the pre-grant introduction of the aspect of the location of the electro-mechanical actuation means into the claim. Rather, the yardstick to be applied in the present case when examining the allowability of the claim amendment in view of the provisions of Article 123(2) EPC is whether it can be directly and unambiguously derived by the skilled person, using common general knowledge, from the (divisional) patent application as filed, i.e. the "gold standard" (see G 2/10, OJ EPO, 376).

1.6 In this regard, the board agrees with appellant I in that the divisional application as filed (see paragraph [0032] of the published application corresponding page 8, line 28 to page 9, line 2 of the divisional application as filed) discloses the electro-mechanical actuation means as being completely located within an inner space of the numbering device, thus forming a

very compact arrangement. The size of the inner space thus substantially corresponds to the size of the numbering device. Additionally, paragraph [0042] of the published application (which corresponds to page 12, line 31 to page 13, line 15 of the divisional application as filed) mentions that the common shaft for the numbering wheels is supported at both ends by bearings provided in the side frame parts, thereby defining the length of the inner space by reference to the length of the common shaft. None of these limitations as regards the size of the inner space is present in claim 1 of the main request, which specifies the inner space in view of an undefined casing, which encloses the numbering device but can be substantially bigger. Consequently, the definition of the inner space in claim 1 of the main request constitutes a generalisation of the disclosure in the divisional application as filed.

1.7 Since no basis for this generalisation was identified in the application as filed, the requirements of Article 123(2) EPC are not met for claim 1 of the main request.

2. *Auxiliary request*

2.1 In claim 1 of the auxiliary request, the definition of the inner space of the casing of the numbering device is limited further by the following additional features:

"... and wherein the numbering wheels (7) are mounted for rotation about a common shaft (17; 17) which is supported at both ends onto bearings provided in side frame parts (3, 3'; 303) of the casing, ..."*

2.2 The additional limitation is based on paragraph [0042] of the published application (which corresponds to page 12, line 31 to page 13, line 15 of the divisional application as filed):

"As already mentioned, one shall appreciate that the electro-mechanical actuation means of the numbering device are entirely located within the numbering device, i.e. are disposed in an inner space of the casing of the numbering device. As illustrated in Figure 3, the numbering wheels 7 are mounted for rotation about a common shaft 17 which is supported at both ends onto bearings provided in the side frame parts 3 and 3'."

2.3 Appellant I essentially argues that the above passage relates to the detailed embodiment of Figure 3 and that it does not provide a general basis for the claim amendment. However, the board notes that in all embodiments of the casing (see Figures 1, 4 and 11) the electro-mechanical actuation means of the numbering device are entirely located in an inner space of the casing of the numbering device and the numbering wheels are mounted for rotation about a common shaft which is supported at both ends onto bearings provided in the side frame parts. Hence, the disclosure of paragraph [0042] of the published application provides a direct and unambiguous basis for claim 1 of the auxiliary request. This finding is not altered by the argument that hypothetical embodiments with projecting casing parts, which were not originally disclosed, possibly fall under the amended claim (and therefore also under the broader claim as filed). In fact, the "gold standard" of Article 123(2) EPC relates to the disclosure of the amended subject-matter in the

original application and not to its extent of protection.

2.4 For these reasons, the subject-matter of the claims of the auxiliary request does not extend beyond the content of the divisional application as filed. It meets the provisions of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeals are dismissed.

The Registrar:

The Chairman:



N. Schneider

M. Poock

Decision electronically authenticated