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**Datasheet for the decision  
of 30 June 2022**

**Case Number:** T 2027/18 - 3.2.05

**Application Number:** 12160752.7

**Publication Number:** 2468522

**IPC:** B41K3/12, B41K3/10, B41F33/00,  
B41F13/00

**Language of the proceedings:** EN

**Title of invention:**

Numbering unit of a numbering device having a releasable indexing mechanism

**Patent Proprietor:**

KBA-NotaSys SA

**Opponent:**

Paul Leibinger GmbH & Co. KG Nummerier-  
und Markierungssysteme

**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

Amendments - intermediate generalisation (allowable: yes)

**Decisions cited:**

G 0002/98, G 0002/10, T 0169/83, T 0398/00, T 0910/03,  
T 2311/10, T 2537/10, T 0886/15



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

**Case Number: T 2027/18 - 3.2.05**

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.05**  
**of 30 June 2022**

**Appellant:** Paul Leibinger GmbH & Co. KG Nummerier-  
(Opponent) und Markierungssysteme  
Daimlerstrasse 14  
78532 Tuttlingen (DE)

**Representative:** Westphal, Mussnug & Partner  
Patentanwälte mbB  
Am Riettor 5  
78048 Villingen-Schwenningen (DE)

**Respondent:** KBA-NotaSys SA  
(Patent Proprietor) PO Box 347  
55, Avenue du Grey  
1000 Lausanne 22 (CH)

**Representative:** Koenig & Bauer AG  
- Lizenzen - Patente -  
Friedrich-Koenig-Straße 4  
97080 Würzburg (DE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
7 June 2018 concerning maintenance of the  
European Patent No. 2468522 in amended form.**

**Composition of the Board:**

**Chairman** P. Lanz  
**Members:** T. Vermeulen  
K. Kerber-Zubrzycka

## Summary of Facts and Submissions

I. The opponent lodged an appeal against the interlocutory decision of the opposition division finding that European patent No. 2 468 522 as amended according to auxiliary request II met the requirements of the European Patent Convention. They had filed opposition against the patent as a whole on the basis of the grounds for opposition under Article 100(a) EPC together with Article 54(1) EPC (lack of novelty) and with Article 56 EPC (lack of inventive step), under Article 100(b) EPC and under Article 100(c) EPC.

II. The oral proceedings before the board of appeal took place on 30 June 2022.

III. The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed.

IV. Claim 1 of auxiliary request II underlying the impugned decision has the following wording (the feature numbering used by the board is introduced in square brackets):

"[F1] A numbering unit (6) of a numbering device, [F2] said numbering unit (6) comprising rotatable numbering wheels (7) carrying alpha-numerical symbols thereon, [F3] which numbering wheels (7) are disposed next to each other for rotation about a common rotation axis and a common shaft (17; 17\*), [F4] wherein said

numbering unit (6) comprises a releasable indexing mechanism (50'; 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, [F5] wherein the common shaft (17; 17\*) does not rotate, [F6] and wherein the releasable indexing mechanism (50'; 7a', 510, 520) comprises a movable indexing member (50'; 510) extending parallel to said rotation axis [F6.1] and which movable indexing member (510) is actuated by means of an electromagnetic energizing coil (520), [F7] wherein the movable indexing member (510) and the electromagnetic energizing coil (520) are disposed in a radial opening (17c\*) provided in the common shaft (17\*), [F7.1] the radial opening (17c\*) being a groove (17c\*) extending axially along the periphery of the common shaft (17\*), [F8] and which movable indexing member (510) is adapted to be pushed vertically into indexing grooves (7a') provided on an inner periphery of said numbering wheels (7)."

V. The appellant essentially argued as follows.

Claim 1 under consideration included two amendments that violated Article 123(2) EPC.

Feature F5 had literal basis in paragraph [0031] of the published application. However, it was disclosed in the context of a specific embodiment in which the numbering unit was described as part of a numbering device. The requirement that the common shaft did not rotate was not originally disclosed as a technical feature of the numbering unit. Moreover, it followed from paragraph [0058] of the published application that the numbering units were meant to be replaced. In fact, the non-

rotation of the common shaft was a consequence of its support on the side frame parts 3, 3' of the numbering device. Without such a support arrangement, the common shaft would be able to rotate around the numbering wheels in the same way as the numbering wheels were rotating around the common shaft. A clear structural and functional relationship therefore existed between feature F5 and the shaft support arrangement. It was therefore not allowed to extract the feature from the detailed description without further specifying the shaft support arrangement. Regarding the movable indexing member of claim 1 as originally filed, its purpose was to fix the position of the numbering wheels relative to the position of the shaft. It was not possible to directly and unambiguously infer from the wording of claim 1 as originally filed that the indexing mechanism fixed the position of the numbering wheels in an absolute manner.

The word "vertically" in feature F8 presented the skilled person with new technical information, namely the direction of engagement of the indexing member relative to the ground and, hence, the orientation in which the claimed numbering unit should be installed in a numbering device. The application as filed did not provide any basis for this new information. The amendment amounted to an intermediate generalisation. The only reference to the vertical displacement of the indexing member was found in paragraph [0064] of the published application. The word "vertically" was, however, not defined in paragraph [0064] in terms of an orientation of the indexing member relative to the ground, but only in the context of an indexing member with "a substantially inverted-T-shaped cross-section". This was illustrated by Figure 9c of the application as filed. The unspecified view could either be a side

view, in which case the indexing member moved vertically in accordance with feature F8, or it was considered as a top view of the numbering unit with a horizontally moving indexing member. Therefore, the vertical displacement of the indexing member was structurally and functionally disclosed in close connection to the vertical part of an indexing member with a substantially inverted-T-shaped cross-section being located in an opening of the coil. Isolating the vertical movement of the indexing member from this context was not allowed. Apart from paragraph [0064], a possible basis for feature F8 was only to be found in the figures of the application as filed. Reference was made to point II.E.1.13 of "Case Law of the Boards of Appeal of the EPO", 9th edition 2019 (hereinafter: "Case Law") and to decisions T 398/00 (reasons 3.4) and T 886/15 (reasons 21). Amending a claim based on a feature taken from the drawings were allowable provided not only the structure of the feature was clearly, unmistakably and fully derivable from the drawings by the skilled person, but also its function and relevance for solving the technical problem. Regarding the example of Figure 9c, it was questionable whether the direction of displacement of the indexing member could be derived from Figures 9a, 9b. This should then also apply to the Figure 8c, which was very similar to Figure 9c. However, the indexing member of Figures 8a and 8b clearly did not operate in the vertical direction. Furthermore, the different orientations of the numbering unit illustrated in Figures 14a, 14b and 14d compared to Figure 14e proved that the orientation of the indexing unit was not so important. But even if the vertical movement of the indexing member were assumed to be structurally disclosed in the drawings, the skilled person would still miss an indication of its function. This followed in particular from

paragraphs [0060] and [0062] of the published application, according to which the embodiments of Figures 8a-8c and Figures 9a-9c of the application as filed operated in the same way, the only difference being the internal or external engagement of the indexing member. Also the example of Figures 14a-14e of the application as filed did not provide any technical effect associated with the vertical direction of movement of the indexing member. Hence, the relevance of feature F8 for solving the technical problem was not apparent to the skilled person.

VI. The respondent's submissions were essentially as follows.

Both feature F5 and feature F8 of claim 1 under consideration clearly had a basis in the application as filed. The requirements of Article 123(2) EPC were therefore met. As set out by the opposition division on page 6 of the impugned decision, features F5 and F8 were to be considered as interacting functional features of the claimed numbering unit. There was no contradiction with the original disclosure. Nor was it necessary to add any further features from a specific embodiment. Actually, features F5 and F8 applied to all embodiments disclosed.

Feature F5 introduced an operational limitation of the numbering unit. The numbering wheels had to rotate on the shaft, not the other way around. The basis for the amendment was found in paragraph [0031] of the published application. It served to clarify the function of the numbering unit or the numbering device in the context of Figure 3 where the non-rotating common shaft was represented for the first time. But the same applied to the embodiments described



thereafter. There was nothing to suggest the contrary. Assuming that the examples of Figure 9a-9c or Figure 14a-14e would work with a rotating shaft and fixed numbering wheels was absurd.

Regarding feature F8, Figures 9a-9b and Figure 14b in combination with the description in paragraph [0064] of the published application provided a basis for the arrangement of a numbering unit in which the indexing member was vertically pushed in the indexing grooves on the inner periphery of the numbering wheels. It was therefore allowed to add the word "vertically" to claim 1 without any further amendments, such as the shape of the indexing member. In fact, paragraph [0064] of the published application disclosed an indexing member moving in the vertical direction without an inverted-T-shaped cross-section in immediate reference to Figures 9a-9c. It was therefore clear that features related to the shape of the indexing member were not relevant. The appellant's comparison between the examples of Figures 8a-8c and 9a-9c was problematic because Figure 8a-8c had nothing to do with the claimed invention. Unlike the present case, the decisions cited by the appellant referred to features taken from drawings that did not have any basis in the text of the application as filed.

### **Reasons for the Decision**

1. The sole issue to be decided is whether the amendments to claim 1 of the auxiliary request II underlying the impugned decision are allowable under Article 123(2) EPC. The appellant's grievance lies with the opposition division's finding that the amendments of features F5 and F8 do not extend the claimed subject-matter beyond the content of the application as filed.

*Feature F5 - the common shaft does not rotate*

2. It is not disputed between the parties that a literal basis for feature F5 can be found on page 11, lines 20 to 21 of the application as filed (corresponding to the last sentence in paragraph [0031] of the published application). That sentence is, however, part of the detailed description of a preferred example. The present case is thus one where the subject-matter of a claim is restricted so that it lies somewhere between an originally broad disclosure and a more limited specific disclosure of the detailed description. Amendments of this kind are often referred to as "intermediate generalisations".
  
3. In accordance with well-established case law, the yardstick for determining whether the subject-matter of an amended claim goes beyond the disclosure of the application as filed is to establish what the skilled person can derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (see G 2/10, Reasons 4.3). This principle applies equally to intermediate generalisations.
  
4. At first sight, the description and the drawings as filed do not disclose much more as regards the (lack of) rotation of the common shaft. In accordance with page 11, lines 12 to 14, the common shaft 17 of Figure 3 is "supported at both ends onto bearings provided in the side frame parts 3 and 3' ". More details of the bearings are given in the description of Figures 5, 6, 10 and 11 on page 17, lines 17 to 19 and page 19, lines 5 to 7. Accordingly, the extremities of the shaft are

mounted in recesses of respective side frame parts of the numbering device. Whether this means that the common shaft rotates or remains stationary cannot be derived with certainty from these passages.

The second part of the detailed description as filed discusses in detail the indexing mechanism used for "maintaining the position of the numbering wheels during a numbering operation" and "to guarantee, if necessary, an exact positioning of the numbering wheels 7 on their target positions", see page 20, lines 18 to 25. To that end, an indexing member is disposed together with an electromagnetic energising coil inside an axially extending groove of the common shaft. Under the action of the coil, the indexing member moves to cooperate with indexing grooves in the numbering wheels. In the board's view, these passages can only mean that the common shaft does not rotate. Only when the common shaft is stationary, the indexing mechanism can maintain the position of the numbering wheels and guarantee their exact positioning.

Corroboration for this view is found on page 23, lines 6 to 10 of the description as filed. If the indexing member 510 can be "raised for releasing the numbering wheels 7 to enable rotation thereof", the indexing member must, conversely, be able to maintain the numbering wheels in a position in which they are not able to rotate, neither around the common shaft nor otherwise.

Moreover, the arrangement of the discrete electrical contacts 531, 532 on the common shaft 17\* in Figure 14e and the PCB contact 126a\* on the side frame part 303\* in Figures 16a and 16b can only mean that the common shaft of the numbering unit is installed in the

numbering device in a well-defined position and orientation. Any relative rotation would interrupt the flow of electric current to the indexing coil and impair the proper function of the device.

5. The appellant argues that feature F5 cannot be extracted from the detailed description on page 11, lines 20 to 21 of the application as filed without further specifying the shaft support arrangement. Their argument is based on the premise that feature F5 is only disclosed in the context of the numbering *device*, not of the numbering *unit*.

The board cannot agree with this reasoning, for the following reasons.

The claims as originally filed are all directed to a numbering unit. With the requirement that the numbering unit comprises a releasable indexing mechanism "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", claim 1 as originally filed already limits the numbering unit to one where the engagement of the releasable indexing mechanism prevents a rotation of the wheels of the numbering unit. This entails that the indexing member of the releasable indexing mechanism which, in the wording of claim 1 as originally filed, "is adapted to be pushed into indexing grooves (7a') provided on an inner periphery of said numbering wheels" has to be stationary both in the engaged and in the retracted position. Otherwise it would not keep the numbering wheels from rotating. Considering that claim 6 as originally filed further foresees that the indexing member is "integrated within an opening (17c\*) provided

in a common shaft (17\*) of the numbering wheels", it follows that also the common shaft has to be stationary. Neither the numbering device nor the shaft support arrangement are mentioned in this context. Hence, the claims as originally filed already imply that the common shaft of the numbering unit is not rotating.

In the board's view, the relationship between the common shaft of the numbering wheels and the numbering device is therefore not so close that one cannot be detached from the other.

6. In view of the above, the addition of feature F5 does not introduce subject-matter which extends beyond the content of the application as filed.

*Feature F8 - adapted to be pushed vertically*

7. Except for the word "vertically", feature F8 was already part of claim 1 of the application as filed. The only passage of the description that serves as a basis for the addition of the adverb is the detailed description of Figures 14a-14e, which spans from page 21, line 31 to page 23, line 20 of the application as filed (corresponding to paragraphs [0064] to [0068] of the published application). In this passage, the vertical displacement of the indexing member is undisputedly disclosed, albeit together with the further requirements that "the indexing member 510 has a substantially inverted-T-shaped cross-section with a head part 510a and a longitudinal extension 510b [...] a vertical part (not referenced) of the indexing member 510 being located in an opening 520a of the coil 520" (page 22, lines 5 to 10). This is reflected in the cross-sectional view of Figure 14b, which shows an

indexing member 510 in the shape of an inverted "T". In contrast, claim 1 of auxiliary request II underlying the impugned decision does not impose any restriction on the shape of the indexing member. As with feature F5, the amendment to feature F8 thus constitutes an intermediate generalisation.

8. Claim 8 as originally filed is directed to a numbering unit with an indexing member of unspecified shape pushed into the indexing grooves of the numbering wheels and energized by the electromagnetic energising coil to *move up* and thereby release the numbering wheels. The inverted-T-shaped cross-section only appears in claim 4 as originally filed, on which claim 8 is not necessarily dependent. In the board's view, the claims as originally filed thus lend weight to the consideration that the movement of the indexing member in the vertical direction and the shape of the indexing member are not so closely related that one cannot be detached from the other.
  
9. This view of the matter is confirmed by the drawings. Figures 9a-9c show a numbering unit 6 with a set of numbering wheels 7 disposed next to each other about a common shaft 17. At the interface between the common shaft and the inner periphery of the numbering wheels a releasable indexing mechanism is arranged. An indexing member 50' is disposed in an axial groove in the common shaft. The arrows in each of the Figures 9a, 9b and 9c imply that the indexing member cooperates with corresponding grooves 7a' of the numbering wheels in a vertical direction. Unlike the embodiment of Figures 14a-14e, the indexing member of Figures 9a-9c has an unspecified cross-sectional shape, which implies that its movement in the vertical direction is not inextricably linked to the inverted-T-shaped cross-

section of the indexing member mentioned in the description of Figures 14a-14e.

10. The appellant argues that there is some ambiguity to the direction of movement in Figure 9c. They submit that it could be regarded as a top view of the numbering unit, in which case the indexing member 50' would move horizontally rather than vertically in and out of the indexing grooves 7a'. The board is not persuaded that this is the case. First, such an interpretation would go against the teaching of the cross-sectional views of Figures 9a and 9b, which can safely be assumed to be representations of the same example as Figure 9c (see also page 8, lines 16 to 19: "Figures 9a, 9b and 9c are views illustrating a second example [...]"). The skilled person would immediately and unmistakably derive from page 9/22 of the drawings of the application as filed that the indexing member 50' of Figure 9c is the same as the indexing member 50' of Figures 9a and 9b. It must therefore move in the same, vertical direction. This is consistent with the fact that the embodiment of Figures 14a-14e, where the vertical movement has a clear, literal basis, "follows the principle [...] in reference to Figures 9a to 9c" (see the sentence bridging pages 21 and 22 of the application as filed).

In coming to this conclusion the board does not attach any weight to the indexing mechanism of Figures 8a-8c, which, because of its operation at the outer surface of the numbering wheels, does not fall within the terms of claim 1 under consideration and was already at variance with the requirement set out in claim 1 as originally filed that the indexing member is adapted to be pushed into indexing grooves provided on an *inner* periphery of the numbering wheels. Furthermore, the circumferential

position of the indexing member shown in Figures 8a and 8b is an immediate consequence of the requirement that it is "provided at the location of one of the supporting members 14, 14' holding the calibration detectors 13" (page 21, lines 5 to 13). The example of Figures 9a-9c does not have this constraint since the indexing mechanism is entirely disposed inside the common shaft. So, even if the Figures 8c and 9c may, at first sight, appear to be similar views of different indexing mechanisms, the skilled person will unmistakably derive from the whole of the documents as filed that Figure 8c is a top view of a first, unclaimed example and Figure 9c a side view of a second example which is in accordance with claim 1.

11. The appellant seeks to strengthen their case that the amended feature F8 cannot be extracted from the drawings by referring to decisions T 398/00 and T 886/15. The board fails to see the relevance of these decisions on the present case. Both decisions relate to cases where features added to the claims were not mentioned at all in the written part of the application documents. In T 398/00 the amendment concerned the position of the engine of a lifting truck in function of its wheels. In T 886/15 the feature under consideration was that at least a portion of a coil element did not overlap with a radiation plate. In contrast, the present case concerns the addition of a word to the claims that has a basis in the detailed description of the application as filed (see point 7. above). Already for that reason, the present case is not comparable to the cases underlying decisions T 398/00 and T 886/15.

It is further noted that, by requiring that an amendment taken from the drawings is "*the deliberate*



*result of technical considerations directed to the solution of the technical problem involved"* (T 398/00, reasons 3.4; T 886/15, reasons 21), the decisions cited by the appellant seem to impose stricter conditions on features extracted from drawings than on features taken from the written application documents. The board, however, subscribes to the findings of decision T 2537/10 (mentioned at the very beginning of point II.E.1.13 of the "Case Law", which was also cited by the appellant) that, for determining whether an amendment has a basis in the drawings of the application as filed the exact same standards must be applied as for the description: the crucial point is what the skilled person would derive directly and unambiguously from the drawing using common general knowledge (T 2537/10, reasons 2.9; see also T 169/83, reasons 3.2.5). Furthermore, the approach of T 398/00 and T 886/15 *de facto* makes a distinction between features in the drawings which are related to the solution of the technical problem and features which are not. In the board's view, such a distinction is problematic in the context of Article 123(2) EPC as it introduces a degree of legal uncertainty considering that technical problems often completely change in the course of the proceedings, for example if new prior art is considered (see G 2/98, reasons 8.3; T 2311/10, reasons 2.6; T 910/03, reasons 3.4).

12. Having regard to the above consideration, the board holds that the addition of "vertically" in feature F8 does not introduce subject-matter which extends beyond the content of the application as filed.

*Conclusion*

13. The amendments of features F5 and F8 comply with Article 123(2) EPC. The appeal of the opponent must therefore be dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated