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**Datasheet for the decision
of 23 May 2023**

Case Number: T 1770/19 - 3.2.05

Application Number: 10169617.7

Publication Number: 2236295

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

Language of the proceedings: EN

Title of invention:

Numbering device for typographic numbering having independent driving means

Patent Proprietor:

KBA-NotaSys SA

Opponent:

Paul Leibinger GmbH & Co. KG Nummerier-
und Markierungssysteme

Relevant legal provisions:

EPC Art. 100(c), 76(1)

Keyword:

Amendments - extension beyond the content of the parent application as filed (yes)

Decisions cited:

G 0001/05, G 0002/10, T 2537/10, T 0614/12, T 1943/15



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Case Number: T 1770/19 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 23 May 2023

Appellant: KBA-NotaSys SA
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 April 2019
revoking European patent No. 2236295 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: T. Vermeulen
A. Bacchin

Summary of Facts and Submissions

- I. The appeal was filed by the patent proprietor against the decision of the opposition division to revoke European patent No. 2 236 295 ("the patent").
- II. The patent originates from European patent application No. 10169617.7, a divisional of the earlier application No. 07789741.1 ("the parent application") which led to the European patent No. 2 032 364 maintained in amended form by an opposition division after appeal proceedings before the board in a different composition (cf. decision T 2/17).
- III. The opposition was filed against the patent as a whole on the basis of the grounds for opposition under Article 100(a) together with Article 54(1) EPC (lack of novelty) and Article 56 EPC (lack of inventive step), under Article 100(b) EPC and under Article 100(c) EPC.
- IV. In the decision under appeal the opposition division came to the conclusion that the subject-matter of claim 1 according to each of the main request (patent as granted) and auxiliary requests 1 to 4 filed with letter of 28 November 2018 extended beyond the content of the parent and divisional applications as filed.
- V. With the statement of grounds of appeal the appellant (patent proprietor) filed auxiliary requests Ia, II, IIa, III, IIIa, IV and IVa.
- VI. New auxiliary requests II, IIa, III, IIIa, IV and IVa replacing previous auxiliary requests II, IIa, III,

IIIa, IV and IVa were filed with appellant's letter dated 10 March 2020.

- VII. Oral proceedings before the board were held by videoconference on 23 May 2023.
- VIII. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or, alternatively, in amended form on the basis of the claims of auxiliary request Ia filed with the statement of grounds of appeal or, further alternatively, on the basis of the claims of auxiliary requests II, IIa, III, IIIa, IV or IVa filed with letter dated 10 March 2020.

The respondent (opponent) requested that the appeal be dismissed.

- IX. Claim 1 of the main request (corresponding to claim 1 of the patent as granted) has the following wording (the feature numbering used in the decision under appeal appearing in square brackets):

"[1.1] A numbering device (1) for carrying out numbering in sheet-fed or web-fed numbering presses, said numbering device (1) comprising [1.2] a casing and [1.3] a numbering unit (6) with rotatable numbering wheels (7) carrying alphanumerical symbols thereon, [1.4] which numbering wheels (7) are disposed next to each other and rotate about a common rotation axis, [1.5] said numbering device further comprising electro-mechanical actuation means for setting the position of said numbering wheels (7), [1.6] 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), characterized in that [1.7] said electro-mechanical actuation means are entirely located within an inner space of the casing of said numbering device and [1.8] are mechanically autonomous, [1.9] said independent driving means (15, 18-23, 23*) being distributed about the rotation axis of said numbering wheels (7) and [1.10] being located at equal distance to the rotation axis of said numbering wheels (7), [1.11] said independent driving means (15, 18-23, 23*) being distributed about the rotation axis of said numbering wheels (7) within an angular sector of approximately 180° around the rotation axis of the numbering wheels (7)".

X. With auxiliary request Ia, the appellant requested to correct paragraph [0028] of the patent specification, as follows:

"[0028] According to the invention, 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."

The claims of auxiliary request Ia are identical to the claims of the patent as granted.

XI. Claim 1 of auxiliary requests II and IIa differs from claim 1 as granted by the following amendments to features **1.3** and **1.6**:

"[1.3'] a numbering unit (6) with more than six rotatable numbering wheels (7) carrying alphanumerical symbols thereon,"

"[1.6'] said electro-mechanical actuation means comprising a plurality of independent driving means (15, 18-23; 23*) for actuating a corresponding plurality of said more than six numbering wheels (7), ~~characterized in that~~ wherein".

XII. Claim 1 of auxiliary requests III and IIIa differs from claim 1 of the patent as granted by the following amendments to feature **1.7**:

"[1.7'] said electro-mechanical actuation means are entirely located within an inner space of the casing of said numbering device wherein the casing comprises two side frame parts (3; 3') having bearings for the common shaft about which the numbering wheels rotate and the electro-mechanical actuation means being located between these side frame parts of the casing and".

XIII. Claim 1 of auxiliary requests IV and IVa corresponds to claim 1 of auxiliary requests III and IIIa, respectively, with the addition of "more than six" in features **1.3** and **1.6**, similarly to the amendments in claim 1 of auxiliary requests II and IIa.

XIV. The appellant's submissions may be summarised as follows.

Main request (patent as granted)

The drawings of the parent application were not merely schematic drawings. They provided such a level of detail that they must have been generated by a Computer-Aided Design (CAD) software and therefore showed the dimensional relationships to scale. This applied in particular to Figures 4, 5 and 7 of the parent application. In decision T 614/12 (see also "Case Law of the Boards of Appeal of the European Patent Office", hereinafter "Case Law", 8th edition 2016, II.E.1.12.1), it was held that a feature was not directly and unambiguously disclosed in a drawing when no indications were provided that it was an exact construction drawing to scale. However, this criterion was met for the figures of the parent application so that it was possible to derive the contested feature **1.10** from these figures. Regarding decision T 1943/15, reference was made to points 4.3 and 4.4 of the Reasons, according to which construction drawings may generally be relied on to show dimensions and proportions of elements to scale. Each case depended on the knowledge of the person skilled in the art and the way in which the feature in question was shown in the drawing. Even if Figure 7 of the parent application was expressly referred to as "schematic", it was immediately clear for the skilled person that the other figures were construction drawings.

Despite its slight perspective angle relative to a view in the axial direction, the representation of Figure 11 was drawn to scale and clearly illustrated that the shafts 19 and 22 of all components of the independent

driving means lay on circular lines concentrically around the center of the rotation shaft 17. The same applied to the shaft passages in the side frame parts shown in Figures 5 and 10b. In addition, in Figure 11 the projection of the center of the rotating shaft 17 was colinear with the projection of shafts 19 and 22 of each of the independent driving means. Given that an ellipse could be drawn through the shafts of the independent driving means illustrated in the drawings and that this ellipse was similar to ellipses depicting other known circular shapes, it followed that the shafts were orientated along a circular arc around the rotation shaft. Further, the representation of identical gears 16 in Figure 2 and the semi-circular arrangement of the pinions 20 and the gears 21, each having the same size, respectively, in Figures 4 and 11 could only mean that the independent driving means were arranged concentrically, i.e. at equal distance to the rotation axis of the numbering wheels. This also made technical sense since otherwise it would be impossible to rotate the numbering mechanism. Similarly, Figure 7 revealed that the shafts 19 and 22 of all independent driving means must lie on circular arcs around the rotation shaft if the gears 16, 23, 21 and 20 were of the same size. It was clear that each independent driving means had to be considered as a unit disposed at a single distance from the rotation axis. Moreover, the components of the independent driving means arranged on either side of the numbering device had identical reference signs in Figures 5 and 6. This indicated that, even if such was not required by claim 1, all the independent driving means of the numbering device were arranged in the same manner.

Concerning the other features of the embodiment shown in the figures of the parent application, it had to be

borne in mind that it was the aim of the invention as set out in paragraph [0024] of the patent to provide a compact construction. Feature **1.10** offered a solution to that problem. Unlike prior art solutions, in which the driving means were symmetrically arranged around an intermediate shaft, the position around the main rotating shaft reduced the size of the numbering device.

Feature **1.10** therefore had basis in the drawings of the parent application as filed. The subject-matter of claim 1 of the main request did not extend beyond the content of the parent application as filed.

Auxiliary requests

Regarding the auxiliary requests, the subject-matter of claim 1 did not extend beyond the content of the parent application as filed.

- XV. The respondent's submissions were essentially as follows.

Main request (patent as granted)

The extraction of distances and size ratios from patent drawings was generally to be handled with caution. In the case on hand, it was to be derived from a set of perspective drawings whether some unmarked distances were identical. In this context, the reverse conclusion the appellant took from decision T 614/12 could not be understood. In exactly the same way as in T 614/12, the issue in the present case was whether Figures 4, 5, 7 and 11 of the parent application contained indications that they actually were construction drawings. However, the drawings did not show any relevant axes or

dimensions, nor any indication of a scale of reproduction. Accordingly, it was to be assumed that they provided schematic representations commonly found in patent documents. A certain level of detail in a patent drawing did not necessarily mean that it was a construction drawing to scale. Whether or not the drawings of the parent application actually were construction drawings or exports from a CAD software was irrelevant; only the appellant as patent proprietor knew the answer to that question. What counted was that they were not recognizable as such by a person skilled in the art.

According to "Case law", 9th edition 2019, II.E.1.13, for the amendment of claims to include features taken from drawings it was necessary that the structure and the function of such features were clearly, unmistakably and fully derivable from the drawings by the person skilled in the art. In the present case, the person skilled in the art would not find any indication in the drawings of the parent application, in particular not in Figures 4, 5, 6 or 11, that an equal distance of the independent driving means to the rotation axis of the numbering wheels played an essential role for the invention. No reference points were marked in the drawings from which such a distance was to be measured. In fact, the rotation axis was not shown in Figures 4, 5, 6 or 11. Figures 5 and 6 did not even depict the numbering wheels. The lack of any explicit marking of reference points was all the more problematic since the components of the independent driving means were positioned at different distances from the rotation axis. And not all of these components were represented in Figures 4 and 11. If the equal distance condition were indeed so relevant, it raised the question of why the drawings of the parent

application did not include any cross-sectional view clearly disclosing it. Feature **1.10** was thus not clearly, unmistakably and fully derivable disclosed by the drawings of the parent application.

The above conclusion notwithstanding, a second hurdle for achieving an allowable amendment to the claim on the basis of a feature taken from the drawings was that the feature must not be disclosed in structural and functional relationship with other, unclaimed features. According to "Case Law", 9th edition, II.E.1.6.1, in particular decision T 1120/05, also the original drawings could not be considered as a reservoir of features on which the applicant or patent proprietor could draw when amending the claims. Even if one were to see basis in Figures 4, 5, 6 and 11 of the parent application for claiming the equal distance condition, the feature was not disclosed in said figures in conjunction with an arbitrary independent driving means. Indeed, all of these figures related to independent driving means devices having the additional features of claims 3, 4, 6, 7, 9 and 13 of the patent in suit. This was particularly clear from Figure 7. Thus, the isolated extraction of feature **1.10** would constitute an unallowable intermediate generalization. Analogously to the factual situation in decision T 191/93, there was no indication in the drawings that the claimed feature was disclosed in such a clear and, compared to the other features, particularly important manner that it could be isolated from the other features shown in the drawings. The appellant's argument concerning the compact construction based on paragraph [0024] of the patent was not convincing since compactness was relative and it strongly depended on the direction in which the size of the numbering device was reduced.

As a result, in agreement with the opposition division, the addition of feature **1.10** in claim 1 of the patent as granted constituted an infringement of Article 76(1) EPC.

Auxiliary requests

For the same reasons as set out in regard of the main request, none of the auxiliary requests complied with Article 76(1) EPC.

Reasons for the Decision

1. Applicable law

The application on which the opposed patent is based was filed on 15 July 2010 as a divisional of the earlier application No. 07789741.1, which was filed on 20 June 2007. Thus, differently from its parent application, the application on which the present patent is based, was not pending when the revised European Patent Convention entered into force on 13 December 2007. Hence the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 (see decision of the Administrative Council of 28 June 2001 in Special edition No. 4 to OJ EPO 2007, 219) do not apply in the present case.

2. Main request (patent as granted) - ground for opposition under Article 100(c) EPC

2.1 In the decision under appeal, the opposition division based its conclusion that the ground for opposition under Article 100(c) EPC prejudiced the maintenance of

the patent as granted *inter alia* on the view that feature **1.10** extended the subject-matter of claim 1 as granted beyond the content of the parent application as filed (point 3.3.(i) on pages 9 and 10 of the reasons for the decision under appeal).

2.2 Claim 1 as granted defines a numbering device with numbering wheels that rotate about a common rotation axis (feature **1.4**). In order to set the position of the wheels, electro-mechanical actuation means are provided (feature **1.5**). They comprise a plurality of independent driving means for actuating a corresponding plurality of said numbering wheels (feature **1.6**). These driving means are to be distributed about the rotation axis of the numbering wheels (feature **1.9**) within an angular sector of approximately 180° around the rotation axis (feature **1.11**). Feature **1.10** under dispute poses a further requirement on how the independent driving means are arranged in the numbering device: they must be "located at equal distance to the rotation axis of said numbering wheels".

2.3 In the description and the claims of the parent application as filed, feature **1.10** is not disclosed. No mention is made anywhere of a (relative) distance between the independent driving means and the rotation axis of the numbering wheels. This was not challenged by the appellant who argued that feature **1.10** was derived from the drawings of the parent application as filed.

2.4 It is well-established case law that an amendment can be solely based on a feature taken from the drawings of the application as filed (see "Case Law", 10th edition 2022, II.E.1.13.1). As drawings are to be treated on an equal footing with the other parts of the application

(T 169/83), the exact same standards must be applied as for the description (T 2537/10, Reasons 2.9). Such an amendment is therefore allowable provided it is made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing from the drawings as filed (G 2/10, Reasons 4.3). This principle also applies when determining whether the subject-matter of a claim extends beyond the content of the parent application as filed (G 1/05, Reasons 5.1).

2.5 Especially in the field of mechanical engineering, patent drawings are often very detailed. They convey to the person skilled in the art relatively complex facts in a concentrated manner and go beyond a mere schematic representation of the essential features (T 2537/10, Reasons 2.9; T 1943/15, Reasons 4.3). If the amendment concerns dimensions of an object, however, a detailed reproduction alone is generally not sufficient. For such amendments to have basis, the drawings must be so accurate that they can be relied on to show the dimensions of the object exactly proportional to the real-life construction, i.e. they must be to scale.

2.6 In the present case, the requirement of a location "at equal distance" involves an assessment of some of the dimensions of the numbering device. The board concurs with the appellant that most of the twenty-seven drawings of the parent application as filed show the numbering device with a high level of detail. Indeed, the omission of some of the cover and frame members in Figures 4 to 6 allows the person skilled in the art to gain a thorough insight into the assembly and the operation of the numbering device. But this is not sufficient to conclude that these drawings qualify as

construction drawings generated by a CAD software. First and foremost, the drawings of Figures 4 to 6 as well as Figures 10a, 10b and 11 of the parent application are all perspective views of (parts of) a numbering device. They do not include any dimensions or a scale of reproduction, from which it could be deduced that they serve as a graphic representation of how the numbering device is actually built. Furthermore, no indications can be found in the drawings that the various components of the numbering device are exactly proportional to those of the actual device (cf. decision T 614/12, Reasons 2.1, cited by the appellant). In fact, Figure 7, one of the few drawings that uses imaginary center lines to depict the rotation centre of the different drive shafts and by doing so bears some resemblance to a construction drawing, is described as "a schematic view" on page 10, lines 4 to 5 of the description of the parent application as filed. In the absence of proof of the contrary, the drawings of the parent application can therefore not be assumed to have the accuracy of construction drawings to scale.

2.7 Under these circumstances, there is no way for the person skilled in the art to ascertain whether feature **1.10** is actually disclosed by the drawings of the parent application as filed. Even if it can be inferred from the perspective view of Figure 4 that the driving motors 15, the reduction gears 18 and the associated gear wheels 20 - at least at the visible side of the numbering device - are arranged about the rotation axis of the numbering wheels 7 in what appears to be an angular sector of approximately 180° (feature **1.11**), it cannot be derived without ambiguity whether these components are located *at equal distance from* the common rotation axis of the numbering wheels, i.e. on a

(semi-)cylindrical surface extending around the rotation axis. The board shares the respondent's view that the absence of reference marks indicating the location of the rotation axis in Figures 4, 5, 6 and 11 make any appreciation of the relative distances to the respective independent driving means highly speculative. This is particularly problematic in connection with Figures 5 and 10b of the parent application as filed, which do not even show the numbering wheels or the shaft on which the wheels rotate. Also the appellant's argument that the rotation shafts 19 and 22 in Figure 11 are distributed along a circular or - taking account of the perspective - elliptical arc about the rotation axis of the common shaft 17 does not stand up to scrutiny. To reach such a conclusion the relative position of the shafts or the corresponding passages through the side frame parts would need to be measured. This, in turn, presumes that the drawings are accurate and to scale, which, as the board has found above, they are not. The same applies to the argument that the equal sizes of the gears 16 in Figure 2 and of the pinions 20 and the gears 21 in Figures 4 and 11, respectively, imply that the independent driving means are arranged concentrically. Without conducting measurements the person skilled in the art would not know for certain whether, for example, the gears 21 disposed in two separate planes have the same diameter. In this context it is noted that the use of a single reference sign for corresponding gears of the independent driving means, while possibly being indicative of a similar function in the drive train of the numbering wheels, does not make a conclusive case that the gears are of equal size.

2.8 The board further takes cognisance of the fact that the driving means is defined on page 14, lines 4 to 7 of the description of the parent application as filed as an assembly of several parts which, following the depiction of the shafts 19 and 22 in Figures 7 and 11, are positioned at two different distances from the common rotation axis. If the appellant's line of argument were followed and each independent driving means were indeed considered as a separate unit disposed at a fixed distance from the rotation axis, this would still raise the question: from which reference point is that fixed distance defined? In the board's view, this question does anything but eliminate the uncertainty the person skilled in the art faces when attempting to determine the basis for feature **1.10** in the drawings of the parent application.

2.9 The conclusion the board has arrived at above is further reinforced by the consideration that the relative arrangement of the independent driving means with respect to the rotation axis of the numbering wheels is only disclosed in the drawings of the parent application as part of a detailed embodiment in combination with several other features. An example of such a feature is the specific connection of motors, reduction gears, pinions and intermeshing gear wheels illustrated in the drawings. The arrangement of the independent driving means would typically be closely related both in function and in structure to its individual components and the way in which these are connected. The respondent presented a convincing case that an arbitrary independent driving means was not disclosed in the drawings. Another example of such a feature is the total of twelve numbering wheels that make up the numbering device, half of which are driven from one side of the numbering device, the other half

from the opposite side. No other wheel configuration is disclosed in the parent application. It cannot be ignored that there is a clearly recognisable functional and structural relationship with the arrangement of the independent driving means. In this respect, the appellant has referred to paragraph [0024] of the patent, according to which it was the aim of the invention to provide a compact arrangement. This argument is, however, not persuasive. The same paragraph was already included in the parent application on page 7, lines 17 to 18, at a time when feature **1.10** did not appear in the claims. Moreover, the board fails to see any causal link between the equal distance between the independent driving means and the rotation axis of the numbering wheels, on the one hand, and the size or compactness of the device, on the other hand. Compactness is relative, as the respondent has pointed out. And neither the size of the independent driving means nor their distance from the rotation axis follow from the claim wording. It is therefore unclear how, if at all, the equal distance condition of feature **1.10** would affect the size of the numbering device.

2.10 In view of the above, it is concluded that the opposition division was correct in its finding that feature **1.10** is without basis in the parent application as filed (Article 76(1) EPC). Therefore, the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted. The main request is thus not allowable.

3. Auxiliary requests - compliance with Article 76(1) EPC

3.1 Claim 1 of auxiliary request Ia has identical wording to that of claim 1 of the patent as granted. Claim 1 of

auxiliary requests II and IIa, in turn, merely differ from claim 1 of the patent as granted by specifying in features **1.3** and **1.6** that the numbering unit has *more than six* numbering wheels. In claim 1 of auxiliary requests III and IIIa, the only differences with respect to claim 1 as granted lie therein that feature **1.7** further restricts the casing to include *two side frame parts* which have *bearings* for the common shaft and between which the electro-mechanical actuation means is arranged. Claim 1 of auxiliary requests IV and IVa, finally, corresponds to claim 1 of auxiliary requests III and IIIa with the further addition of *more than six* numbering wheels in features **1.3** and **1.6**, similarly to the wording of claim 1 of auxiliary requests II and IIa.

3.2 The wording of feature **1.10** thus remains unchanged in claim 1 of each of the auxiliary requests. None of the amendments carried out in the auxiliary requests affect the arrangement of the independent driving means at equal distance to the rotation axis of the numbering wheels. The conclusion reached above in regard of the main request that feature **1.10** is without basis in the parent application is therefore not altered, so that Article 76(1) EPC is not complied with.

3.3 Hence, auxiliary requests Ia, II, IIa, III, IIIa, IV and IVa are not allowable either.

4. Conclusion

As none of the appellant's requests is allowable, the appeal must 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