

Publication in the Official Journal ~~Yes~~ / No

File Number: T 225/90 - 3.2.3

Application No.: 83 102 855.0

Publication No.: 0 089 684

Title of invention: Device for the insertion of small blocking strips or
ribbons for multiple sheet material

Classification: B42C3/00

D E C I S I O N
of 19 September 1991

Applicant: BAMA Spa

Opponent: GRAPHOTECHNIK Jung KG

Headword: Insertion device / BAMA

EPC Articles 123, 114(1), 56, 111(1), 104

Keyword: "Deletion of essential features (not allowed)" - "Late-filed
relevant prior art" - "New situation for assessment of inventive
step" - "Remittal to Opposition Division upon request" -
"Apportionment of costs - no improper behaviour recognisable"

Headnote



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Boards of Appeal

Chambres de recours

Case Number : T 225/90 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 19 September 1991

Appellant : GRAPHOTECHNIK Jung KG
(Opponent) Akazienweg 9
W - Rheinstetten 4 (DE)

Representative : Rüger, Rudolf, Dr.-Ing.
Patentanwälte
Dr.-Ing. R. Rüger
Dipl.-Ing. H.P. Barthelt
Webergasse 3
Postfach 348
W - 7300 Esslingen/Neckar (DE)

Respondent : BAMA Spa
(Proprietor of the patent) Via IV Novembre 2
I - 20080 Zibido S. Giacomo (Milano) (IT)

Representative : Prüfer, Lutz H., Dipl.-Phys.
Harthäuser Strasse 25d
W - 8000 München 90 (DE)

Decision under appeal : Decision of Opposition Division of the European
Patent Office dated 6 December 1989, dispatched
in writing on 23 January 1990, rejecting the
opposition filed against European patent
No. 0 089 684 pursuant to Article 102(2) EPC.

Composition of the Board :

Chairman : C.T. Wilson
Members : H. Andrae
W. Moser

Summary of Facts and Submissions

- I. European patent No. 0 089 684 was granted on 27 August 1986 on the basis of European patent application No. 83 102 855.0 filed on 22 March 1983.
- II. A notice of opposition to this patent was filed on 26 May 1987 by the Appellant requesting that the patent be revoked because the subject-matter thereof was not patentable in accordance with Articles 52 to 57 EPC. In support of his request, the Appellant referred to the document GB-A-1 175 373 and as well to the documents discussed in the description of the contested patent, in particular to DE-A-1 436 814.
- III. By decision dated 6 December 1989, dispatched in writing on 23 January 1990, the Opposition Division rejected the opposition pursuant to Article 102(2) EPC.
- IV. The Appellant lodged an appeal against this decision on 20 March 1990 and paid the appeal fee on the same date. In the statement of grounds received on 22 May 1990 by telecopy, confirmed by letter received on 23 May 1990, he substantiated his opinion according to which the subject-matter of Claims 1 to 5 did not involve an inventive step having regard to the documents GB-A-1 175 373, DE-A-1 436 814 and DE-B-2 205 714.
- V. In a communication according to Article 11(2) RPBA dated 16 May 1991 the Board gave its provisional opinion with regard to the granted Claim 1 holding that by elimination of certain features from the originally filed Claim 1 the patent seemed to have been amended in such a way that it contained subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC). Furthermore, the Board expressed the opinion that an

amended Claim 1 into which the eliminated features were reincorporated would appear not to be obvious in the light of the disclosed prior art.

- VI. In response to the Board's communication the Respondent filed on 20 August 1991 two new versions of Claim 1 according to a main request and an auxiliary request, respectively, and requested to maintain the patent on the basis of these independent claims and otherwise of the documents as granted.
- VII. By a letter received on 7 September 1991 the Appellant referred for the first time to the document US-A-3 431 827 which, according to the Appellant, discloses a solution to the problem that the apparatus on applying the strips to the continuous carrier material onto which the strips are applied avoids a relative movement between the cutting means and the forms and is furthermore distinguished by a simple and reliable construction. He requested to take this document into account according to Article 114(1) EPC, to set aside the decision of the Opposition Division and if necessary to remit the case to the Opposition Division.
- VIII. In the oral proceedings subsidiarily requested by both parties and held on 19 September 1991, the parties defended their cases, whereby the issue of Article 123(2) EPC was discussed extensively.
- IX. The Appellant's arguments set forth in his written and oral statements can be summarised as follows:
- The elimination of the features in the originally filed Claim 1 from the granted Claim 1 as cited in the communication of the Board amend the European patent in such a way that it contains subject-matter which extends

beyond the content of the application as filed. This is obviously not disputed by the Respondent as can be seen from the newly filed versions of Claim 1. That these features have to be regarded as essential features in the sense of Decision T 331/87 - 3.2.2 dated 6 July 1989 arises clearly from the fact that they form part of the originally filed Claim 1.

- It appears questionable whether the proposed amendments to the claims are allowable at present in the opposition proceedings under Article 123(3) EPC. According to the proposed versions of Claim 1 it is now proposed to drive the supporting means rather than the cutting means, so that the scope of protection now extends also to such cases in which the cutting means is movable relative to the supporting means or has even further additional driving means arranged on the supporting means.
- The embodiment of the invention as disclosed in Figures 1 and 2 and in the corresponding description is inconsistent with the subject-matter of the claims. The cutting blade, designated with the reference sign 36, cannot cut the ribbon in the configuration shown in Figure 2. Furthermore, due to the offset position of the cutting blade 36 against the roller 42, the cutting blade cannot transfer any cut strips to the roller 42.

X. The Respondent argued in his written and oral statements as follows:

According to the decision T 331/87 of the Board of Appeal 3.3.2 dated 6 July 1989 a replacement or removal of a feature from a claim may not violate Article 123(2) EPC provided the skilled person would directly and unambiguously recognise that

- (1) the feature was not explained as essential in the disclosure,
- (2) it is not as such indispensable for the function of the invention in the light of the technical problem it serves to solve, and
- (3) the replacement or removal requires no real modification of other features to compensate for the change.

The feature that the stacked sheet material forms a continuous strip of sheets coming from a sheet coupling device and the feature that displacement means for controlled displacement of the continuous strip of sheets being engaged by the cutting means is provided, the cutting means carrying therewith a just cut small strip concomitantly with the second alternating motion of the supporting means, are not at all explained in the originally filed documents as essential. It is not necessary for the apparatus to function that the stacked sheet material forms a continuous strip of sheets coming from a sheet coupling device. Any stacked material such as groups of sheets being separated from each other would do and no change of the apparatus would be necessary. Nor is the displacement means strictly necessary. The cutting means could also deposit the blocking strip onto stacked sheet material without the support of the displacement means. If no displacement means is provided, no other modification of the apparatus is necessary.

As concerns the relevance of the document US-A-3 431 827 the invention concerns the technical field of printing whereas the citation deals with the technical field of wrapping, these fields being classified in different sections of the International Patent Classification. A

person skilled in the art would not combine the teaching of the US specification with the prior art relevant to the invention since these groups of documents refer to basically different fields.

The Respondent requested to maintain the patent

- on the basis of Claim 1 filed on 20 August 1991 according to the main request and otherwise the documents as granted
- on the basis of Claim 1 filed on 20 August 1991 according to the auxiliary request and otherwise the documents as granted.

He requested the Board to issue a decision on his submissions only in the case that the Board disregards the late-filed document US-A-3 431 827 for lack of relevance, and alternatively to remit the case to the first instance for further prosecution.

Furthermore, he requested a different apportionment of costs in his favour.

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

"Apparatus for applying small blocking strips over mating holes of stacked sheet material fed along a sheet material feed direction, comprising feeding means (20, 21, 22, 23) for intermittently advancing a continuous ribbon (15) to be cut into the said small strips (16) over said sheet material along a predetermined path transversely to the sheet material feed direction, cutting means (36) supported on supporting means (37) for cutting said ribbon (15) transversely with respect to the

direction of intermittent advancement, and first drive means (41, 48, 49) for actuating said supporting means (37) in a first alternating motion transversely to said direction of intermittent advancement, for cutting said ribbon (15) and applying said cut strip (16) onto said sheet material, characterized by second drive means (40, 50) actuating said supporting means (37) in a second alternating motion in sheet material feed direction transversely to said first alternating motion such that there is no substantial relative motion in sheet material feed direction between the advancing sheet material and said strip (16) to be applied."

Claim 1 according to the auxiliary request reads as follows:

"Apparatus for applying small blocking strips over mating holes of stacked sheet material forming a continuous strip of sheets coming from a sheet coupling device and fed along a sheet material feed direction, comprising feeding means (20, 21, 22, 23) for intermittently advancing a continuous ribbon (15) to be cut into the said small strips (16) over said sheet material along a predetermined path transversely to the sheet material feed direction, cutting means (36) supported on supporting means (37) for cutting said ribbon (15) transversely with respect to the direction of intermittent advancement, and first drive means (41, 48, 49) for actuating said supporting means (37) in a first alternating motion transversely to said direction of intermittent advancement, for cutting said ribbon (15) and applying said cut strip (16) onto said sheet material, characterized by

second drive means (40, 50) actuating said supporting means (37) in a second alternating motion in sheet material feed direction transversely to said first alternating motion such that there is no substantial relative motion in sheet material feed direction between the advancing sheet material and said strip (16) to be applied, and displacement means (42, 43, 45, 47) for the controlled displacement of said continuous strip of sheets and being engaged by said cutting means (36) carrying therewith a just cut small strip concomitantly with said second alternating motion of said supporting means (37)."

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.

2. Main request

2.1 Amendments

2.1.1 Claim 1 as filed originally on 22 March 1983 contains the following feature which does not form part of Claim 1 both in the form as granted and according to the main request:

"Means for the controlled displacement of a continuous strip of sheets coming from a sheet coupling device is provided, said displacement means being engaged by said cutting means carrying therewith a just cut small strip concomitantly with said second alternating motion of said supporting means."

2.1.2 The question to be answered is whether by deleting the above-cited feature from the originally filed Claim 1 the

contested patent has been amended in such a way that it contains subject-matter which extends beyond the content of the application as filed and contravenes thus Article 123(2) EPC.

As stated in decision T 392/89 (section 5) of 3 July 1990 (unpublished), such a question is not a legal question of fundamental relevance but an issue in fact which can only be answered on the basis of the circumstances of the particular case. It has to be investigated in any case whether the content of the originally filed application provides the skilled person either explicitly or implicitly with a hint as to the deletion of a feature contained in an independent claim.

2.1.3 In the present case, it has been indicated in the passage bridging page 1, last paragraph, and page 2, paragraph 4, of the originally filed description that in the known devices for the insertion of small blocking strips or ribbons for multiple sheet material the small strip insertion rate and consequently the operating speed of the machine for the production of coupled forms is affected. It has been stated:

"For an approximate evaluation of the negative incidence of the hole enlarging operating and small strip insertion on the whole rate of the entire form coupling cycle it will be enough to take into consideration that the coupling mechanisms may attain linear speeds of the continuous paper band as formed by the forms joined along their opposite edges (emphasis added), up to 350 m/min, whereas the automatic machines for the application of small strips of the aforesaid type seldom may operate at linear speeds of said paper band higher than 180 m/min. The main purpose of the present invention is that of providing an automatic device for the insertion of small

ribbons or strips onto forms by which the aforesaid drawbacks are done away with A further purpose of the present invention is that of providing a device of the aforesaid type which is of simple operation, of rugged structure and of easy maintenance besides permitting the use thereof with whatever type of mechanism for the continuous coupling of forms (emphasis added)."

Furthermore, it has been stated in the passage bridging pages 5 and 6 of the original description that all the modifications, changes and equivalents possible and foreseeable to the invention are based on the use of means for cutting and inserting the small strips or ribbons having a motion such that the relative motion between the small strip and the hole to which the same small strip is to be applied is null at the moment at which the said insertion takes place without appreciable change of the displacement speed of the band of coupled form being processed.

Hence, the inherent problem as understandable from the original description has essentially two aspects, namely:

- (a) to provide an apparatus for the insertion of small blocking strips for multiple sheet material in the form of a continuous paper band in which the production rate is increased, and
- (b) to provide a device of the aforesaid type which is of simple operation, rugged structure and of easy maintenance.

The solution to aspect (a) of the problem requires that means for the controlled displacement of a continuous strip of sheets coming from a sheet coupling device is provided since a continuous paper band to be fed to the

apparatus in dependence on the speed of the blocking strip band is presumed in aspect (a).

Having regard to the second part of the deleted feature the skilled person recognises that this part provides an important contribution to aspect (b) of the problem. The measure that the means for the controlled displacement of a continuous strip of sheets is engaged by the cutting means carrying therewith a just cut small strip concomitantly with the second alternating motion of the supporting means has the effect that separate means for transferring the cut strip to the band of sheets as required in the apparatus according to the relevant prior art DE-A-1 436 814 (cf. ref. sign 21 in Figure 8) can be dispensed with. Hence the skilled person recognises that this measure obviously serves the purpose of providing a device which is of simple operation, rugged structure and of easy maintenance.

Since the deleted feature is required to solve the inherent problem it must be regarded as part of the essential features of the invention as disclosed in the originally filed documents. There is no passage in the documents as originally filed including the drawings which might give a clue to the skilled person that this feature if need be can be suppressed in the independent claims. No basis is therefore recognisable which might justify the deletion of the cited feature from the originally filed Claim 1.

- 2.1.4 The Respondent brought forward that the conditions referred to in Decision T 331/87 dated 6 July 1989 for justifying a replacement or removal of a feature from a claim have been met in the present case.

In the Board's view, the present case, cannot however be compared with the situation underlying the cited Decision. As outlined above, in the case to be decided the deleted feature is indispensable for the solution to the problem as illustrated in the original description.

- 2.1.5 Taking account of the arguments presented by the Respondent, the Board comes to the conclusion that in the present case it was not admissible to eliminate the cited feature from the independent Claim 1 since this feature has been originally disclosed to be essential with regard to the claimed solution. Such an amendment would lead to subject-matter which extends beyond the content of the application as filed and would therefore contravene Article 123(2) EPC.

Claim 1 according to the main request is not, therefore, allowable.

3. Auxiliary request

3.1 Amendments

- 3.1.1 Claim 1 according to the auxiliary request contains additionally to the subject-matter of Claim 1 as granted the following features forming part of the originally filed Claim 1:

- (a) Supporting means for the cutting means is provided, the supporting means being actuated by a first alternating motion ... and by a second alternating motion ...",
- (b) Means for the controlled displacement of a continuous strip of sheets coming from a sheet coupling device is provided, said displacement means being engaged by

said cutting means carrying therewith a just cut small strip concomitantly with said second alternating motion of said supporting means,

(c) The blocking strips are "small blocking strips".

The wording of original Claim 1, lines 1 to 5, "Automatic device for the insertion of small blocking strips or ribbons adapted for the insertion in the groups of mating holes of materials consisting of laterally punched and coupled sheet groups whereby each strip takes a U-shaped configuration and is fixed to the first and to the last sheet of the sheet group by means of adhesive areas provided in the strips itself" has been amended to "apparatus for applying blocking strips over mating holes of stacked feed material fed along a sheet material feed direction". The above-cited amended feature is based on the original description page 4, last line, to page 5, line 1, and page 5, lines 17 to 20 and lines 24 to 28. As the step of inserting the small strips in the mating holes of the stacked feed material is not carried out by the apparatus for feeding and bringing into position of the small strips as shown e.g. in original Figure 1 but by a suitable punch arranged downstream of said apparatus (cf. page 5, lines 24 to 28, of the original description), the elimination of the features concerning the insertion of the blocking strips in the mating holes of the stacked feed material and the forming of these strips to a U-shaped configuration from original Claim 1 constitutes an allowable clarification supported by the cited passage of the original description.

Claim 1 according to the auxiliary request complies, therefore, with the requirement of Article 123(2) EPC.

3.1.2 Due to reintroducing the above-cited features (a), (b) and (c) (cf. section 3.1.1) into Claim 1 in the form as granted, the claim has been restricted to the particular configurations constituted by these features. The cutting means has been restricted to an embodiment in which its supporting means is actuated by a first and a second alternating motion. Similarly, the means for feeding stacked sheet material has been restricted to means for the controlled displacement of a continuous strip of sheets, the displacement means being in a particular relation with the cutting means, and the blocking strips have been restricted to "small" blocking strips.

The argument of the Appellant that the reincorporation of "supporting means for the cutting means" would contravene Article 123(3) EPC because the scope of protection now would also comprise such cases in which the cutting means is movable relative to the supporting means or has even further additional driving means arranged on the supporting means, is not convincing. There is no disclosure in the original documents underlying the patent from which it could be derived that the scope of protection comprises also such cases. It must be concluded therefore that the argument put forward by the Appellant is of mere speculative character.

Moreover, it is self-evident and also acknowledged by the Appellant with regard to the prior art disclosed in US-A-3 431 827 (cf. Appellant's letter dated 6 September 1991, page 5, section 5), that the cutting means of a mechanical cutting device as represented by the cutting edge is normally disposed on supporting means.

Claim 1 does not, therefore, extend the scope of protection of the patent and consequently complies with Article 123(3) EPC.

3.2 The late-filed document US-A-3 431 827 deals with an apparatus for producing and applying tear strips to a continuous sheet or web or to a succession of precut blanks of wrapping or packing material (cf. column 1, lines 33 to 39). Notwithstanding the circumstance that the strips and the continuous sheet or web or succession of precut blanks of the citation serve a particular purpose, i.e. as tear strips and wrapping or packing materials, respectively, the inherent problem, namely to provide an improved high-speed apparatus which can form and apply tear strips at frequent intervals and with high accuracy to a succession of blanks or a continuous web of wrapping material whereby a simple, compact and rugged apparatus including the strip cutting mechanism should be employed (cf. column 2, lines 1 to 11 and 30 to 36), corresponds basically with the problem underlying the invention.

As the skilled person is expected to take account of the art in which identical or similar problems have to be solved (cf. Decision T 176/84 dated 22 November 1985, published in OJ EPO 1986, 50), he will consider, in the Board's view, whether the subject-matter of the late-filed document provides a hint to the solution of his problem. He will recognise that the known apparatus provides supporting means of a cutting mechanism which is actuated in a first and a second alternating motion such that there is no substantial relative motion in sheet material feed direction between the advancing sheet material and the strip to be applied, the cutting means on its movement towards the sheet material transferring a freshly formed strip against the upper side of a respective sheet.

From the above it arises that the late-filed document discloses essential features of the characterising portion of Claim 1. Moreover, it fills - at least to a great extent - the missing link in the argumentation of the

Appellant in his grounds for opposition, these missing features being relied upon by the Opposition Division in its Decision rejecting the opposition.

Having regard to what is set out above the Board decided to admit the document US-A-3 431 827 into the proceedings.

3.3 Remittal to Opposition Division

In accordance with Article 111(1) EPC the Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

If a document is sufficiently relevant to be admitted at a later stage of the proceedings, the case should normally be referred back to the first instance so as to allow the case to be examined in the light of the new document before two instances so as not to deprive the patent proprietor of one level of jurisdiction. Such a procedure is desirable at least in the case when the Board considers that the late-filed document is of such relevance that it puts the maintenance of the patent at risk. Moreover, in the present case, both parties have expressly asked for remittal of the case to the first instance.

In the exercise of its power conferred to it under Article 111(1) EPC the Board remits the case to the Opposition Division for further examination on the basis of Claim 1 according to the auxiliary request and Claims 2 to 5 as granted.

During further prosecution of the case the first instance will also have to take account of the point raised by the Appellant that the embodiment of the invention as

disclosed in Figures 1 and 2 of the drawings and in the corresponding part of the description of the patent is inconsistent with certain features of the claims (cf. above point IX).

4. Apportionment of costs

It is clear that in general the late filing of a document by one party increases the overall costs incurred by the other party in comparison with the situation if all the facts, evidence and documents had been presented within the nine-month opposition period. In the present case, however, Claim 1 as granted has been broadened by deletion of features contained in the originally filed Claim 1. Some of those deleted features, as e.g. the feature concerning the transfer of a cut strip to the continuous strip of sheets by the cutting means, which have been reintegrated into Claim 1 according to the auxiliary request, are known from the late-filed document. The filing of this document must therefore be regarded as a reaction upon a request of the Respondent being new in substance. The Respondent could have maintained his request according to the originally filed Claim 1 which complied with the requirement of Article 123(2) EPC giving thereby the Appellant the opportunity to file a document being particularly relevant as to such a request at an earlier stage of the proceedings.

In the established jurisprudence of the European Patent Office only special circumstances such as an abuse of procedure make it equitable to award costs against one of the parties. These circumstances differ from those of the present case in which the Board cannot find any criterion for attributing improper behaviour to the Appellant. Therefore, no reason of equity can be found to make an exception to the principle that each party has to bear the


costs it has incurred for the proceedings (Article 104 EPC). Thus, the request for different apportionment of costs has to be rejected.

Order

For these reasons, it is decided that:

1. The main request is rejected.
2. The case is remitted to the Opposition Division for further prosecution on the basis of the auxiliary request.
3. The request for different apportionment of the costs in favour of the Respondent (Article 104 EPC) is rejected.

The Registrar:



N. Maslin

The Chairman:



C.T. Wilson

for
W. Moser

