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File Number: T 685/90 - 3.2.2

Application No.: 85 113 211.8

Publication No.: 0 179 405

Title of invention: Color printer having apparatus for shifting ink ribbon

Classification: B41J 35/16

D E C I S I O N  
of 30 January 1992

Applicant: FUJITSU LIMITED

Headword:

EPC Article 123(2)

Keyword: "Main Request - inadmissible extension" -  
"Auxiliary Request - allowable"

Headnote



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Boards of Appeal

Chambres de recours

Case Number : T 685/90 - 3.2.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.2  
of 30 January 1992

**Appellant :**

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**Decision under appeal :**

Decision of Examining Division of the European  
Patent Office dated 19 March 90 refusing European  
patent application No. 85 113 211.8 pursuant to  
Article 97(1) EPC.

**Composition of the Board :**

**Chairman :** G.S.A. Szabo  
**Members :** W.D. Weiss  
J.H. van Moer

**Summary of Facts and Submissions**

- I. European patent application No. 85 113 211.8, filed on 18 October 1985 and published under publication No. 0 179 405, was refused by a decision of the Examining Division, dated 19 March 1990.
- II. The decision was based on claims which had been further amended on 19 January 1990 after the Examining Division had informed the Applicant in a Communication under Rule 51(4) EPC dated 30 March 1990 on the basis of which documents it intended to grant a patent. The only ground for the decision was that, by submission of the new Claim 1, the application had been amended in such a way that it contained subject-matter which extended beyond the content of the application as filed (Article 123(2) EPC).
- III. On 28 May 1990, an appeal was lodged against this decision and the fee for appeal paid simultaneously. The Statement of the Grounds was transmitted by telecopy on 23 July 1990 and confirmed by a letter received on 25 July 1990.
- IV. In a Communication pursuant to Article 110(2) EPC dated 7 March 1991, the Board expressed as its provisional opinion why all the four versions of the independent Claim 1 (Main Request and four Auxiliary Requests) which had been submitted together with the Statement of the Grounds appeared to violate the provisions of Article 123(2) EPC.

One of the objections stated in the above Communication was that the Board could find no original disclosure to justify the replacement of the specific expression "... cylindrical platen rotatably mounted ..." by the more general wording "... platen mounted ...".

V. On 18 July 1991, with a letter dated 7 July 1991, the Appellant replaced all previous claims by a new complete set of one independent claim and 17 dependent claims as Main Request and a further independent Claim 1 to head the same dependent claims on an auxiliary basis. A final redactionally honed version of these alternative independent Claims 1 was received on 17 January 1992.

Claim 1 according to the Main Request reads as follows:

"1. A color printer, comprising:

a base unit (10);

a platen (21) mounted on said base unit for supporting a printing paper;

a printing head (40);

a carrier (30), reciprocally movable along said platen, for supporting said printing head;

a color ink ribbon cassette (60) comprising a cassette case (62) for accommodating therein a color ink ribbon (61) which has a plurality of different color longitudinal stripes (61a, 61b, 61c, 61d),

so that at least a part of the ink ribbon forms a loop exposed from and extending to the cassette case, which ribbon loop is positioned along said platen and between said printing head and platen,

a ribbon guide member (90) mounted transversely movable on said carrier (30) for supporting said ink ribbon (61) at a position adjacent to said printing head; characterized by

a means (52, 52a, 53, 55, 57, 56, 58, 50a, 25, 26, 27,) for transversely shifting said color ink ribbon cassette by swinging it about an axis substantially parallel to the platen; and by

a means (83, 84, 85, 86, 83b, 83c) for moving said ribbon guide member transverse to the ink ribbon so that a desired one of said color stripes of the ink ribbon is positioned on the printing line,

said transversely shifting means and transversely moving means being driven one in accordance with another so that the position of the cassette case (62) substantially follows the shifted position of the ink ribbon (61)."

Claim 1 according to the Auxiliary Request is identical to Claim 1 according to the Main Request except that here the term "... platen (21) mounted ..." is replaced by the expression "... cylindrical platen (21) rotatably mounted ...".

VI. The Appellant submitted the following arguments for the formal admissibility of the feature referring to the "platen (21)":

It was clearly disclosed in the original documents that the application under appeal concerned the maintenance of the proper alignment of a ribbon loop of a multicolour ink ribbon with respect to a stock of the same ribbon contained in a cassette, whenever the ribbon guide guiding the ribbon loop is shifted transversely to its longitudinal direction in order to bring another colour stripe into the printing position vis-a-vis the supporting platen. It was obvious to the skilled man that the platen, in this connection, only functioned as an abutment to stop the movement of the impacting printing means and that the invention worked the very same way, regardless whether the platen was cylindrical or flat, whether it was fixed or whether it was rotatable. Moreover, rejecting Claim 1 according to the Main Request and only allowing the Auxiliary Request would mean that somebody who, without knowing the invention, would not have been able to arrange

and guide a multi-color ink ribbon could build a printer with a non-rotatable flat platen which would only serve as an abutment for the printing means. This would mean that any competitor could not only be inspired but rather feel invited to build such a printer using the gist and the teaching of the invention, simply replacing the rotatable cylindrical platen for instance by a non-rotatable flat one. Only Claim 1 according to the Main Request would grant the inventor full protection for his invention.

VII. Consequently, the Appellant requests that the decision under Appeal be set aside and a patent be granted on the basis of the following documents:

**Claims:** Claim 1 according to the Main Request, or Auxiliary Claim 1, both received on 17 January 1992 with letter of the same date, Claims 2 to 18, received on 18 July 1991 with letter of 7 July 1991;

**Description:** pages 1 to 15 as indicated in the communication under Rule 51(4) EPC dated 30 March 1989;

**Drawings:** Sheets 1/10 to 10/10 as indicated in the communication under Rule 51(4) EPC dated 30 March 1989.

**Reasons for the decision**

1. The appeal is admissible.
2. Admissibility having regard to Article 123(2) EPC

2.1 Article 123(2) EPC states that a European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

According to the practice of the EPO, the content of an application as filed comprises the whole disclosure, express or implied, that is directly and unambiguously derivable from this application including information which is implicit and immediately and unambiguously apparent to a person skilled in the art reading the application. Thus, the content of the application means the total information content of the disclosure cf. T 514/88 ("Medical infusor/ALZA", dated 10 October 1989, Headnote OJ EPO 1991/12).

In addition to defining the border between admissible and inadmissible amendments in the meaning of Article 123(2) EPC, the content of a European patent application as filed, according to Article 54(3)(4) EPC, is a state of the art with respect to later European patent applications which are filed after the date of filing but on or before the publication date of the earlier one, i.e. it defines the border with respect to what can still be protected in a later application once the earlier application has been filed.

This twofold purpose of the "content of the European patent application as filed" indispensably involves the consequence that such content is identically defined in both cases. If, hypothetically, this "content" for the purpose of Article 123(2) EPC would be defined wider in scope than the "content" for the purpose of Article 54(3)(4) EPC, the EPO would have to allow amendments to the claims within the extent of the broad definition in the earlier application and would have to allow claims outside the narrow definition (e.g. by

disclaimer) in the later application. The consequence would be that the EPO would have to allow double patenting of subject-matter lying in the overlap between the broad and the narrow definitions.

Consequently, it has been suggested that a novelty test should be applied to determine the allowability of an amendment (cf. T 201/83, "Lead alloys/SHELL", OJ EPO 1984, 481, point 3, and T 194/84, "Cellulose fibres", OJ EPO 1990, 59, point 2.4).

2.2 Another approach was suggested in the decision T 331/87 ("Removal of a feature/Houdaille", OJ EPO 1991, 22) based on the decision T 260/85 ("Coaxial connector/AMP", OJ EPO 1989, 105), which has enumerated three indicators to recognise the inadmissibility of an amendment which consists in the deletion of an essential feature from a claim. According to this test removal of a feature from a claim is at least not permissible under Article 123(2) EPC if (1) the feature is presented as essential in the original disclosure, or (2) it is indispensable for the function of the invention in the light of the technical problem it serves to solve according to the original disclosure, or (3) the removal requires a modification of other features to compensate for the change. Of course, the first criterion is not only satisfied in the presence of express reference to essentiality, since the applicant's conduct in the presentation of the invention may also indicate that he considers a feature as essential.

2.3 The above decision T 514/88 (cf. point 2.4.) comes to the conclusion that this test for essentiality (or inessentiality) on the one hand, and the novelty test on the other, are not contradictory but represent the same principle. In both cases the relevant question is whether



or not the amendment is consistent with the original disclosure.

## 2.4 Main Request

2.4.1 The originally filed set of 17 claims contains 7 independent claims all of which, although they differ from each other in various other features, state that the colour printer according to the present application comprises a "... cylindrical platen rotatably mounted ...".

In Claim 1 according to the Main Request this specific feature has now been replaced by the more general term "... platen mounted ...".

The question to be answered is, if this generalisation of the feature is directly and unambiguously derivable from the original disclosure.

It has not been disputed that there is no explicit disclosure throughout the whole original documents which mentions a platen other than one which is cylindrical and rotatable.

Moreover, all the originally filed independent claims contain the features that

- a carrier is reciprocally movable along said platen;
- an ink ribbon supporting frame is swingingly mounted about an axis parallel to said platen;
- the ribbon loop is positioned along said platen.

This means that the direction of the cylinder axis of the platen there has been used as the reference for the definition of the coordinate system which is the basis of

the whole construction as claimed. The original description is consistent with the original claims in this respect.

The platen in the version of Claim 1 according to the Main Request has no preferred axis but nevertheless comprises the features enumerated above which indispensably require such reference for their definition. The mere fact that the subject-matter of Claim 1 according to the Main Request now is undefined is a proof that this claim now lacks a feature which according to the applicant's conduct in the original presentation of the invention indicates that he considers it as essential.

There is nothing in the application as filed to suggest that a platen other than a cylindrical and rotatable one could be used. The fact that a hypothetical expert could have seen that the cylindrical and rotatable construction was not essential for the solution of the problem as presented in the "Summary of the Invention" of the original description does not mean that the application as filed discloses or implies that these attributes of the platen could be omitted. It would merely mean that this expert had sufficient imagination to conceive his own modifications of the disclosure.

Consequently, already the first criterion of the "essentiality test" referred to in point 2.2 above is fulfilled, which criterion excludes the deletion of a respective feature.

- 2.4.2 The subject-matter of Claim 1 according to the Main Request now embraces modifications of the platen which, according to their intended function, may be equivalent to the cylindrical and rotatable construction indicated. This means that, in the version according to the Main Request,

the application contains also features which are equivalents to the respective feature according to the application as filed.

It is, however, the permanently followed practice of the EPO (cf. T 167/84, "Kraftstoffeinspritzventil/NISSAN" OJ EPO 1987, 369) that specific equivalents to explicitly disclosed features do not automatically belong to the content of a European patent application as filed, when this content is used as a state of the art according to Article 54(3)(4) EPC against a younger application. The considerations set out under point 2.1 above forcibly lead to the conclusion that such equivalents could not belong to the content of the European patent application either, when this content is assessed for judging the admissibility of an amendment in the meaning of Article 123(2) EPC.

Therefore, also a novelty test leads to the result that the attributes "cylindrical" and "rotatable" to the platen must not be deleted.

2.4.3 Consequently, the Board is of the opinion that the subject-matter of Claim 1 according to the Main Request extends beyond the content of the application as filed, in contravention of Article 123(2) EPC. The Board, therefore, concludes that Claim 1 according to the Main Request cannot be accepted.

## 2.5 Auxiliary Request

Claim 1 according to the Auxiliary Request contains the following terms which prima facie appear to differ substantially from the wording used to formulate the corresponding features in the originally filed claims:

- a) The purpose feature "... to reciprocally move said printing head along a printing line on the printing paper on said platen" has been omitted;
- b) the reference to an "ink ribbon supporting frame" has been omitted;
- c) the feature "means for slidingly shifting said ribbon guide member" has been replaced by "means for moving said ribbon guide member transverse to the ink ribbon".

The feature a) is a clear and necessary consequence of the reciprocal motion of the carrier; the deletion of this redundant feature does, therefore, not involve a gain in technical information which goes beyond the disclosure.

Page 1, lines 27 to 29, when read together with page 2, lines 19 to 23, of the original description is a clear basis for the feature b) insofar as can be clearly deduced therefrom that it is important for the solution of the basic problem of the invention to swingingly move the ribbon cassette in order to follow the shifting motion of ribbon guide member. The frame only plays a decisive role in the specific embodiment which is represented by the Figures 14 to 18 and which deals with a solution of the additional problem to optionally use a monocolour ribbon cassette instead of a monocolour ribbon cassette.

Feature c) above finds its clear basis on page 2, lines 19 to 23, of the original description.

The features of the dependent Claims 2 and 3 were originally comprised in the independent claims. However, the reasons given above for the feature b) also justify to relate these features to a specific embodiment which solves an additional problem.

The dependent features 4 to 18 find their clear basis in the original description of the preferred embodiment.

Consequently, Claim 1 and the Claims 2 to 18 appended thereto are not objectionable under Article 123(2) EPC.

3. Novelty and Inventive Step

The Examining Division had already concluded the substantive examination and, in its communication dated 30 March 1989, indicated its intention to grant a patent on the basis of an independent claim substantially of the scope of Claim 1 according to the Auxiliary Request. The Board sees no reason to question the result of the examination of the Examining Division with respect to novelty and inventive step.

4. The dependent Claims 2 to 18 are not open to objection on formal grounds and their subject-matter includes particular embodiments of the invention defined in Claim 1 according to the Auxiliary Request. The description and the Figures need no further amendment.

**Order**

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to grant a patent on the basis of the following documents:

**Claims:** Claim 1 according to the Auxiliary Request, received on 17 January 1992 with letter of the same date,  
Claims 2 to 18, received on 18 July 1991 with letter of 7 July 1991;

**Description:** pages 1 to 15 as indicated in the communication under Rule 51(4) EPC dated 30 March 1989;

**Drawings:** Sheets 1/10 to 10/10 as indicated in the communication under Rule 51(4) EPC dated 30 March 1989.

The Registrar



S. Fabiani

The Chairman



G. Szabo