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**D E C I S I O N**  
**of 9 January 2003**

**Case Number:** T 1158/98 - 3.4.1

**Application Number:** 92811028.7

**Publication Number:** 0559992

**IPC:** G07D 11/00

**Language of the proceedings:** EN

**Title of invention:**

Perfected machine for the counting and checking of banknotes  
of any size, even when overlapped

**Patentee:**

TEAN AG

**Opponent:**

GIESECKE & DEVRIENT GmbH

**Headword:**

Perfected machine for the counting and checking of  
banknotes/TEAN AG

**Relevant legal provisions:**

EPC Art. 108, 56

**Keyword:**

"Appeal sufficiently reasoned (yes)"  
"Inventive step (no; main and auxiliary requests)"

**Decisions cited:**

T 0220/83; T 0145/88; T 0729/90; T 0563/91

**Catchword:**

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Case Number: T 1158/98 - 3.4.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.1  
of 9 January 2003

**Appellant:** TEAN AG  
(Proprietor of the patent) Via Bossi 6  
CH-6900 Lugano (CH)

**Representative:** -

**Respondent:** GIESECKE & DEVRIENT GmbH  
(Opponent) Prinzregentenstrasse 159  
D-81677 München (DE)

**Representative:** Klunker, Schmitt-Nilson, Hirsch  
Winzererstrasse 106  
D-80797 München (DE)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 26 October 1998  
revoking European patent No. 0 559 992 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** G. Davies  
**Members:** H. K. Wolfrum  
R. Q. Bekkering

## Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division, dispatched on 26 October 1998, revoking European patent No. 0 559 992. The notice of appeal was received on 18 December 1998 and the prescribed fee was paid on the same day. The statement setting out the grounds of appeal was received on 25 February 1999.

II. Pursuant to Article 100(a) EPC, the opposition was based *inter alia* on the ground of lack of inventive step (Articles 52(1) and 56 EPC).

In its decision, the opposition division found the subject-matter of claim 1 of the patent as granted to lack an inventive step in particular with respect to the teaching of document

**E1:** EP-A-0 389 733.

III. In a communication of 29 July 2002 annexed to summons to oral proceedings, the Board expressed serious doubts as to the patentability of the claimed subject-matter then on file.

IV. Oral proceedings were held on 9 January 2003 at the request of both parties.

The appellant was not represented, the former representative of the proprietor having informed the EPO by letter dated 4 December 2002 that he was no longer responsible for the application. He asked the EPO to send all future communications to ISEA

International Services TEAN Srl in Milan, Italy. This company was duly contacted and summoned to the oral proceedings but did not appear. Further efforts of the Board to contact both the proprietor and the inventor failed.

- V. The appellant requested in writing that the decision under appeal be set aside and the patent maintained as granted (**main request**) or on the basis of claims 1 to 6 filed on 25 February 1999 (**auxiliary request**).
- VI. The respondent (opponent) requested that the appeal be dismissed.
- VII. Independent **claim 1** of the **main request** reads as follows:

*"1. Perfected machine for the counting and checking of banknotes of any size, even overlapped, including a station (2) for the insertion of the banknotes, with a maximun [sic] of 200 at a time, downstream from which a traction unit (30) acts on single banknotes, over a direction essentially perpendicular to the longitudinal development of the banknote itself, characterized in that, downstream from the traction unit 30, a unit (40, 41, 45, 46, 50, 51) for the conveying of the banknotes is provided, along a direction essentially parallel to its longitudinal development, for the conveyance from a counting and checking station (55), with a shunter (80) piloting that is suitable for selectively inserting the banknote into a collection area (85) for the counted banknotes and into a collection area (81) for the discarded banknotes."*

**Claim 1** of the **auxiliary request** reads:

"1. *Perfected machine for the counting and checking of banknote of any size, even overlapped, including a station (2) for the insertion of the banknote, with a maximum of 200 at a time, downstream from which a traction unit (30) acts on single banknote, over a direction essentially perpendicular to the longitudinal development of the banknote itself, downstream from the traction unit 30, a unit (40, 41, 45, 46, 50, 51) for the conveying of the banknote is provided, along a direction essentially parallel to its longitudinal development, for the conveyance from a counting and checking station (55), with a shunter (80) piloting that is suitable for selectively inserting the banknote into a collection area (85) for the counted banknote and into a collection area (81) for the discarded banknote, characterised in that the above mentioned conveyance unit exhibits an advancing starter shaft (40), equipped with a small advancing roller (41), placed above the banknote and the above mentioned reference inclined plane, and suitable for inserting the banknote onto belts (45,46) both upper and lower, for the conveyance of the banknote underneath said counting and checking station (55) at the exit thereof an upper tape (60) and a lower tape (61) are provided, thereinbetween the banknote is inserted, said upper (60) and lower (61) tape exhibiting a common superposed section, defined by an ascending stretch (70A), a horizontal stretch (70B) and a descending stretch (70C) ending in the place where the said shunting device (80) is placed, said shunter (80) being suitable for inserting the counted*

*and checked banknote onto a pick-up belt (90), that moves, for a certain distance, over a common course with said the lower tape (61), to place the banknote onto a pick-up wheel (91)."*

VIII. The appellant essentially submitted that the invention differed from the closest prior art defined by document E1 in that it concerned a "perfected" machine which was distinguished by five cooperating features (identified as (a) to (e)) resulting in a reduction of the overall dimensions of the machine whilst guaranteeing the proper transport of banknotes and improving the reliability of operation of the machine.

IX. The respondent disputed the appellant's view, relying on the following arguments:

The main request was not reasoned as no indication was given why specifically the subject-matter of claim 1 of the main request would be patentable with respect to the prior art. Thus, it was questionable whether the main request was admissible.

As regards the substantive merits of the main request, claim 1 of the patent as granted defined none of features (a) to (e) discussed by the appellant. The sole difference between the claimed subject-matter and the machine for counting and checking banknotes known from document E1 was the requirement that not more than 200 banknotes should be inserted at a time. The figure of "200" was completely arbitrary and had no technical effect, apart from a vague indication as to the size of the machine. Since the machine known from E1 was also fed by a plurality of banknotes at a time, the choice of an upper limit for the number of banknotes to be

inserted simultaneously was merely a matter of meeting customers' demands.

Claim 1 of the auxiliary request included the additional features of dependent claims 7 to 10 as granted. These features were either also known from document E1 or constituted simple and straightforward modifications of elements and their mutual arrangement of the known machine. In particular, the use of a roller for the feeding of a banknote into the conveying belts, instead of using a moving belt as known from E1, concerned the replacement of a technical means by a known equivalent. Moreover, the claimed arrangement of the path of the banknotes through the machine was merely a matter of design according to needs and circumstances.

## **Reasons for the Decision**

### **1. Admissibility of the appeal**

According to the established case law of the boards of appeal (cf. **T 220/83**, OJ 1986, 249; **T 145/88**, OJ 1991, 251), the grounds of appeal have to specify the legal and factual reasons why the contested decision should be set aside and the appeal allowed. In particular, the arguments brought forward must be clearly and concisely presented to enable the board and the other party or parties to understand immediately why the decision is alleged to be incorrect, and on what facts the appellant bases its arguments, without first having to make investigations of their own. However, the filing of amended claims (even in the form of an auxiliary request), the subject-matter of which had not been

addressed in the contested decision, has been considered repeatedly to constitute a sufficient reasoning (cf. **T 563/91**; **T 729/90**).

Therefore, in the present case, notwithstanding the fact that the written statement setting out the grounds of appeal does not provide any indication as to why specifically the subject-matter of claim 1 of the main request would be patentable with respect to the prior art, the filing of an auxiliary set of amended claims is considered to constitute a sufficient substantiation of the appeal. Since the appeal also complies with the further requirements according to Articles 106 to 108 and Rule 64 EPC it is considered admissible as a whole, including the main request.

2. *Main request*

- 2.1 Document E1 (see in particular Figures 1, 2, 4 and 8 with the corresponding description) shows a machine for the counting and checking of banknotes including a station for the insertion of the banknotes, a traction unit, a unit for the conveying of the banknotes, a counting and checking station, a shunter, and collection areas for the counted and discarded banknotes, respectively, all elements being arranged and performing the functions as indicated in claim 1 of the patent as granted.

In particular, as regards the requirement of a first movement of the banknotes perpendicular to their longitudinal extension followed by a movement in the longitudinal direction, the Board makes reference to column 2, lines 15 to 41 and column 3, line 45 to column 4, line 1 of E1.



2.2 Hence, the subject-matter of claim 1 under consideration differs from the known machine only by the explicit requirement that a maximum of 200 banknotes should be inserted at a time, whereas the teaching of E1 refers to the handling of a stack of banknotes of unspecified size.

The Board notes in this context that, as a matter of fact, none of the features (a) to (e) discussed by the appellant is the subject of claim 1.

2.3 The Board considers the claimed maximum number of banknotes to be handled at a time to provide an indication as to the size of the machine and its elements so that it defines a technical feature of the machine which is not directly apparent from E1.

However, any limit to the number of banknotes to be handled simultaneously is to be regarded as a straightforward design option for the person skilled in the art designing a counting and checking machine according to the needs and desires of customers. Therefore and in the absence of any reasoning by the appellant in support of the inventiveness of the aforementioned distinguishing feature, the Board does not see any reason why it should judge the matter in this respect differently from the opposition division.

2.4 Consequently, the main request does not meet the requirements of Articles 52(1) and 56 EPC having regard to inventive step.

### 3. *Auxiliary request*

3.1 With respect to claim 1 of the auxiliary request,

document E1 shows also upper and lower belts (see in particular Figure 2; and column 5, lines 36 to 43) for the conveyance of the banknotes to and through the counting and checking station. As regards the technical means for inserting the banknotes between said belts, E1 shows in the specific embodiment of Figures 2, 7 and 8 (see also the corresponding description in column 4, line 36 to column 5, line 16) a mechanism for moving a banknote from a base stop ("8") to the belts ("30" in Figure 2) which comprises a rotating belt ("27") mounted on a pulley ("23") which in turn is mounted on a shaft or arm ("25") that can be rotated (by means of a ratchet "26") so as to bring belt 27 on pulley 23 into contact with the surface of the banknote. Moreover, the known machine includes upper and lower tapes (see Figure 2; and column 6, lines 22 to 25) exhibiting a common superposed section between which the banknotes, upon exiting the counting and checking station, are inserted and by which they are conveyed to the shunter ("48" in Figure 2) as well as to a pick-up belt, that moves from the shunter, for a certain distance, over a common course with the lower tape (cf. Figure 2), to place the banknotes onto a pick-up wheel (see "52" in Figure 2; and column 6, lines 26 to 30 and 40 to 45).

3.2 It follows that the subject-matter of claim 1 differs from the prior art machine known from E1 (besides the aspect concerning a maximum of 200 banknotes to be inserted at a time):

(i) in that the advancing starter shaft forming part of the conveyance unit for inserting the banknotes between the belts is specifically equipped with a small advancing **roller**, whereas the specific

embodiment of E1 shows a rotating **belt** ("27" in Figure 8) for this purpose; and

(ii) in that the superposed section of the tapes conveying the banknotes from the counting and checking station to the shunter is expressly defined by an "ascending stretch", a "horizontal stretch" and a "descending stretch".

3.3 Feature (i) concerns a technical detail of the above mentioned feature (a) discussed by the appellant (see page 2 of the statement of grounds of appeal). However, it is not evident and not argued by the appellant which specific technical effect would be obtained by this detail, and thus which specific technical problem would be solved by a roller replacing a belt for gripping a banknote.

In the Board's opinion, the rotating roller according to feature (i) has to be considered as a technically equivalent means and straightforward design alternative to the rotating belt shown in E1 for gripping and transferring a banknote, the more so as at other locations of the known machine the banknotes are advanced by rollers.

3.4 As regards feature (ii), which corresponds to feature (b) discussed by the appellant, the Board notes that, in the absence of any specific indications as to the mutual arrangement and orientation of the various elements of the machine, the relative terms "ascending", "horizontal" and "descending" are open to interpretation. In fact, feature (ii), in a very general interpretation, simply requires that the tapes turn twice by 90°, so as to reverse the direction of

movement of the banknotes on their path from the counting and checking station to the shunter. However, such a path is in principle also shown in Figure 2 of document E1, in which the presentation of the path of the banknotes would even suggest an initial transport in a vertical direction away from the counting and checking station.

Besides, the Board notes that, as with feature (i), no specific technical effect can be recognized for feature (ii) and none has been indicated by the appellant.

3.5 Hence, the subject-matter of claim 1 of the auxiliary request is rendered obvious to the skilled person by the teaching of E1 so that the auxiliary request does also not comply with the requirements of Articles 52(1) and 56 EPC.

4. For the above reasons, the requests of the appellant are not allowable.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

R. Schumacher

G. Davies