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D E C I S I O N
of 21 August 2003

Case Number: T 0796/99 - 3.4.1

Application Number: 94917780.2

Publication Number: 0706698

IPC: G07D 13/00

Language of the proceedings: EN

Title of invention:
Validating value carriers

Patentee:
Mars Incorporated

Opponent:
Giesecke & Devrient GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 54, 56, 123(2)

Keyword:
"Novelty (yes)"
"Added subject matter (yes) - second auxiliary request"
"Inventive step (no) - main request and first auxiliary request"
"Inventive step (yes) - third auxiliary request"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0796/99 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 21 August 2003

Appellant: (Opponent)
Giesecke & Devrient GmbH
Prinzregentenstraße 159
D-81677 München (DE)

Representative:
Klunker, Hans-Friedrich, Dr.
Patentanwälte
Klunker . Schmitt-Nilson . Hirsch
Winzererstraße 106
D-80797 München (DE)

Respondent: (Proprietor of the patent)
Mars Incorporated
6885 Elm Street
McLean
Virginia 22101-3883 (USA)

Representative:
Burke, Steven David
R.G.C. Jenkins & Co.
26 Caxton Street
London SW1H ORJ (GB)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 6 July 1999 rejecting the opposition filed against European patent No. 0706698 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: G. Davies
Members: M. G. L. Rognoni
H. K. Wolfrum

Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal received on 4 August 1999, against the decision of the opposition division, despatched on 6 July 1999, rejecting the opposition against the European patent No 0 706 698. The appeal fee was paid on 4 August 1999 and the statement setting out the grounds of appeal was received on 8 November 1999.

II. The opposition had been filed against the patent as a whole, based on Article 100(a) EPC and concerned, in particular, objections under Articles 52(1), 54 and 56 EPC.

III. In the statement of grounds of appeal, the appellant referred, *inter alia*, to the following document:

E3: DE-C-33 21 657

IV. In response to a communication from the Board summoning the parties to oral proceedings, the respondent (patent proprietor) filed three auxiliary requests by letter dated 18 July 2003, received on 21 July 2003.

V. In the oral proceedings, which were held on 21 August 2003, the respondent replaced the claims of the third auxiliary request and filed consequential amendments to the description.

VI. The appellant requested that the decision under appeal be set aside and the patent revoked.

VII. The respondent requested that the appeal be dismissed and the patent be maintained as granted (**main request**), or that the patent be maintained on the basis of the following documents:

- **first auxiliary request** -
claims 1 to 20 filed on 21 July 2003;

- **second auxiliary request** -
claims 1 to 18 filed on 21 July 2003;

- **third auxiliary request** -
claims 1 to 18 filed in the oral proceedings on 21 August 2003,

columns 1 to 5 of the description filed in the oral proceedings on 21 August 2003,

Figures 1 and 2 of the patent as granted.

VIII. The wording of claim 1 and 15 according to the **main request** reads as follows:

"1. A method of accepting, validating and dispensing value carriers, wherein a parameter (x) of a value carrier (2) presented by a user is measured and the value carrier (2) is not accepted as valid unless said parameter (x) falls within a corresponding first acceptance range (T_A), characterized in that the value carrier (2) is not subsequently dispensed unless said parameter (x) falls within a corresponding second acceptance range (T_B) narrower than the first."

"15. Apparatus for accepting, validating and dispensing value carriers, the apparatus comprising validating means (1) for validating a value carrier (2) presented by a user by measuring a parameter (x) of the value carrier (2) and not accepting said value carrier (2) as valid unless said parameter (x) falls within a corresponding first acceptance range (T_A), characterized in that the validating means is arranged subsequently not to dispense the value carrier (2) unless the parameter (x) falls within a corresponding second acceptance range (T_B) narrower than the first."

Claims 1 and 14 according to the **first auxiliary request** differ from claim 1 and 15 of the main request in that:

– *"a parameter (x) of a value carrier (2)" is replaced by "a parameter (x) indicative of the authenticity of a value carrier (2)", and*

– *"not accepted as valid" is replaced by "not accepted as genuine".*

The wording of claim 1 and 13 according to the **second auxiliary request** reads as follows:

"1. A method of accepting, validating and dispensing value carriers, wherein a plurality of parameters (x) indicative of the authenticity of a value carrier (2) are measured and the value carrier (2) is accepted as genuine if each parameter falls within a corresponding first acceptance range (T_A), characterised in that the value carrier is not subsequently dispensed unless one

of said parameters (x) falls within a corresponding second acceptance range (T_B) narrower than the first."

"13. Apparatus for accepting, validating and dispensing value carriers, the apparatus comprising validating means (1) for validating a value carrier (2) presented by a user by measuring a plurality of parameters (x) indicative of the authenticity of the value carrier (2) and not accepting said value carrier (2) as genuine unless each parameter (x) falls within a corresponding first acceptance range (T_A), characterized in that the validating means is arranged subsequently not to dispense the value carrier (2) unless one of the parameters (x) falls within a corresponding second acceptance range (T_B) narrower than the first."

The wording of claim 1 and 13 according to the **third auxiliary request** reads as follows:

"1. A method of accepting, validating and dispensing value carriers, wherein a plurality of parameters (x) of a value carrier (2) presented by a user are measured and the value carrier (2) is accepted as valid if each parameter (x) falls within a corresponding first acceptance range (T_A), characterized in that the value carrier (2) is subsequently dispensed only if each said parameter (x) falls within a corresponding second acceptance range (T_B) narrower than the first."

"13. Apparatus for accepting, validating and dispensing value carriers, the apparatus comprising validating means (1) for validating a value carrier (2) presented by a user by measuring a plurality of parameters (x) of the value carrier (2) and accepting said value carrier

(2) as valid if each said parameter (x) falls within a corresponding first acceptance range (T_A), characterized in that the validating means is arranged subsequently to dispense the value carrier (2) if each parameter (x) falls within a corresponding second acceptance range (T_B) narrower than the first."

Claims 2 to 12 and 14 to 18 are dependent on claims 1 and 13, respectively.

IX. The arguments of the appellant may be summarised as follows:

The closest prior art document E3 anticipated the essential philosophy underlying the contested patent, *ie* the principle that a banknote should be tested not only when it was deposited but also on dispensation in order to avoid recirculation of damaged or soiled banknotes. The only difference between the method according to claim 1 of the main request and E3 was that the latter did not explicitly teach to use the same parameter for both tests. However, a machine could decide whether a banknote was acceptable (*ie* genuine and in a good condition) or not acceptable (*ie* not genuine or not in a good condition) only by measuring certain parameters and determining whether the measured values fell within given tolerance ranges. Since it was implicit in the teaching of E3 that some parameters, such as length or reflected light, could be used for an authenticity test and for a test for fitness of circulation, the subject-matter of claim 1 was not new within the meaning of Article 54 EPC.

If it were assumed that E3 implied the use of different parameters on deposition and dispensation, the problem addressed by the contested patent could be seen in the simplification of the method known from E3. A person skilled in the art, however, would have realised that at least some of the parameters mentioned in document E3 were suitable for determining both the authenticity of a banknote and its fitness for circulation. Since it would have been obvious to such skilled person, wishing to implement the teaching of E3, to use the same parameter for testing a banknote's acceptability both on deposition and on dispensation, the claimed method lacked an inventive step within the meaning of Article 56 EPC

Claim 1 according to the first auxiliary request specified that the parameter to be used was indicative of the authenticity of a value carrier. This amendment, however, could not be understood as a limitation of claim 1 as granted because the patent specification did not provide any support for parameters which were only indicative of a banknote's authenticity. Thus, the claimed method had effectively the same scope as claim 1 of the main request, and, for the same reasons, it was also not inventive within the meaning of Article 56 EPC.

Claim 1 according to the second auxiliary request was not admissible under Article 123(2) EPC because it defined subject-matter extending beyond the content of the application as filed.

Claim 1 according to the third auxiliary request related to a method which used a plurality of

parameters to determine the authenticity and the fitness for circulation of a value carrier. Thus, the only difference between the subject-matter of this claim and claim 1 as granted was that the former used a plurality of parameters to test the same banknote on deposition and dispensation. As it was a standard solution to increase the reliability of a system by performing redundant measurements, the subject-matter of claim 1 according to the third auxiliary request could not involve an inventive step within the meaning of Article 56 EPC.

X. The arguments of the respondent could be summarised as follows:

None of the cited documents disclosed the characterising portion of claim 1 according to the main request, and, therefore, there was no evidence which filled the gap between E3 and the contested patent. Furthermore, E3 implied that the tests for authenticity and for fitness of circulation should be as independent as possible and, consequently, that the parameters used for such tests should also be different. Even if one of the parameters (*ie* a dimension) referred to in E3 could, in principle, be used in a test performed on deposition and in a test for fitness of circulation on dispensation, there was no suggestion that different acceptability ranges should be used or that the same portion of the banknote should be tested twice. Since E3 essentially taught away from the contested patent, it would not have been obvious to the person skilled in the art to arrive at the claimed method starting from this document. Thus, the subject-matter of claim 1

according to the main request met the requirements of Article 54 and 56 EPC.

Claim 1 according to the first auxiliary request was based on a combination of claims 1 and 12 of the patent as granted. The specification that the parameters were indicative of the authenticity of the banknote contributed to distinguishing the claimed method from E3 because the latter clearly taught that the test performed on the banknote before dispensing should not involve the assessment of its authenticity and that, therefore, a parameter indicative of the banknote's authenticity would not be suitable for performing such test.

Claim 1 according to the second auxiliary request was based on a combination of claims 1, 2 and 14 as granted and thus was supported by the patent specification. Considerations relating to the admissibility under Article 123(2) EPC with regard to the application as originally filed should not be admitted in the proceedings because this question had never been raised in opposition.

As to the third auxiliary request, there was no suggestion in the cited prior art to use a plurality of parameters for testing a banknote presented by the user and to regard the banknote as fit for circulation only if each of these parameters fell within a narrower acceptance range. Thus, the claimed method met the requirements of Article 56 EPC.

Reasons for the Decision

1. The appeal is admissible.

Main request

2.1 Claim 1 of the patent in suit relates to a "*method of accepting, validating and dispensing value carriers*" comprising essentially the following steps:

- measuring an unspecified parameter (x) of a value carrier;
- establishing on the basis of the measured parameter (x) and of a first acceptance criterion whether the value carrier presented by a user can be accepted as "*valid*";
- establishing on the basis of the measured parameter (x) and of a second acceptance criterion whether a *"valid"* value carrier is to be subsequently dispensed.

According to the first acceptance criterion, the value carrier is not accepted unless the measured parameter falls within a corresponding first acceptance range T_A. Similarly, the value carrier is not dispensed unless the same parameter falls within a corresponding second acceptance range T_B narrower than the first range T_A.

2.2 In other words, claim 1 defines a first necessary condition which a value carrier has to meet if it is to be regarded as "*valid*", and a second necessary

condition which a "*valid*" value carrier has to satisfy in order to be considered suitable for reuse.

The negative clauses used in claim 1 ("*not accepted as ....., unless"* and *"not subsequently dispensed ....unless*") imply that other tests may be performed to establish whether a value carrier is valid and/or fit for circulation (cf. dependent claims 2 and 3).

3.1 E3, which uncontestedly represents the closest prior art, relates, *inter alia*, to a method for determining whether a value carrier, such as a banknote, is genuine and fit for circulation. This document (see column 9, lines 32 to 44) shows a judgment section 30 where certain parameters of the banknote (*ie* length, width, magnetic pattern matching, colour analysis of transmitted light, and fine section matching by reflected light) are measured and four detecting functions (*ie* denomination detection, authenticity detection, fit/unfit detection, and obverse/reverse detection) are effected. Deposited banknotes are subjected only to denomination and authenticity detections (cf E3, column 9, lines 43 to 44). Some "true" banknotes, however, may be judged counterfeit or not genuine by the authenticity detection because they are superposed, greatly skewed or broken (E3, column 9, lines 45 to 53). In other words, the judgment unit may not be able to distinguish between counterfeit and genuine but damaged banknotes.

E3 (column 13, lines 1 to 13) further specifies that as many soiled banknotes as possible ("*Die meisten verschmutzten Banknoten*") should be accepted so long as they are recognised as authentic at depositing.

However, soiled genuine notes are referred to as "unfit notes" which should not be delivered to customers. Thus, the notes must be examined thoroughly upon dispensation, and those notes which are soiled, damaged, mended with adhesive tape, and/or dog-eared, and are therefore judged unfit, must be rejected.

3.2 In summary, E3 teaches that banknotes to be dispensed to customers must meet more severe criteria than deposited banknotes, in the sense that they should be subjected to additional tests directed to establishing whether they are damaged or soiled. E3, however, does not identify any parameter suitable for such additional tests and, in particular, it does not exclude the possibility that at least one of the parameters used to determine the denomination and/or authenticity of a banknote could also be used for testing its fitness for circulation.

4.1 According to the appellant, E3 anticipated the "philosophy" which underlay the contested patent and consisted in testing banknotes accepted as genuine for damage and soiling before they were reused. This and the fact that "soiling" was not *per* se a parameter of a banknote but represented a condition derivable from some of the parameters normally used for authentication and referred to in E3 (*eg* the attenuation of light reflected by a certain pattern) implied that the claimed method was not new with respect to E3.

4.2 As pointed out above, however, E3 does not establish any link between the measured parameters and any of the functions required to determine whether a banknote is genuine and/or fit for circulation. As it is left to

the person skilled in the art to decide which parameters should be used when testing a banknote on deposition and on dispensation and, in particular, whether the same parameters might be used, E3 does not disclose a method comprising all the steps recited in claim 1 of the contested patent.

4.3 Hence, the subject-matter of claim 1 of the contested patent is new within the meaning of Article 54 EPC and differs from the teaching of E3 essentially in that:

– the same parameter is measured to test a value carrier's validity and fitness for circulation, whereby the acceptance range for the latter is narrower than the acceptance range for the former.

5.1 According to the respondent, it would be contrary to the teaching of E3 to use the same parameter to test a banknote on deposition and dispensation because a banknote's authenticity was tested only on deposition and an authenticity test was essentially different from a test directed to establishing whether a genuine banknote was fit for circulation.

For the appellant, however, there was no substantial difference between a test for authenticity and a test for damage or soiling since both were based on the comparison of a measured parameter with certain tolerance ranges.

5.2 Hence, a first question to be considered is whether the test for authenticity referred to in E3 is essentially different from the test for fitness so as to require the selection of different parameters, of some

"special" parameter or even of some special combination of parameters.

6.1 In the patent in suit (column 1, lines 26 to 36), it is acknowledged that automatic machines check "the "acceptability", that is, for example, the authenticity, and frequently, in addition, the general condition of the banknotes" by comparing "one or more measurements that can be made of the banknote with corresponding given reference values or tolerance ranges which are normally stored in the automatic machine. The choice of parameters which are measured depends primarily upon the recognition characteristics existing on the banknote".
If the measurement or measurements of a banknote do not fall within predetermined tolerance ranges, the machine concludes that the banknote is not acceptable (*ie* not genuine or not in a good condition), and rejects it.

Thus, the assessment of the prior art given in the patent in suit appears to confirm the appellant's view that an automatic machine for checking banknotes does not actually "distinguish" between a banknote's authenticity and its condition, but only between banknotes which are acceptable or not acceptable because their parameters meet or fall short of certain standards.

6.2 If the banknote is tested only once, a compromise must be made as to the choice of the tolerance value or values, so that both the probability of an acceptable banknote being rejected and the probability of the non-acceptable banknote being used are kept within limits (cf patent specification, column 2, lines 14 to 18).

The claimed method implies that it is possible to assess whether a banknote is genuine and in a good condition, or genuine but not in a sufficiently good condition, by using only one parameter. According to the description (column 3, line 52 to column 4, line 3), *"one possible measuring parameter xi is the dimension, that is to say the length, width or thickness of the banknote. Another advantageous measuring parameter xi is the spectrum of the light reflected or transmitted by the banknote..... A further measuring parameter xi that can be used is the change produced in a magnetic field by a banknote provided with magnetic printing ink... "*

6.3 It should be noted that, apart from *"thickness",* all parameters referred to in the patent in suit are the same parameters which are measured by the judging unit 30 of E3. Since the patent in suit does not disclose any special parameter or tolerance ranges which would be particularly suitable for determining the genuineness of a banknote and its general state, it must necessarily be assumed that the general knowledge common in the field at the time of the priority date of the contested patent would have enabled the skilled person to select a suitable parameter and corresponding tolerance ranges.

6.4 In summary, the contribution the contested patent makes over the teaching of E3 consists essentially in suggesting that the same unspecified parameter can be used in a test for authenticity and in a test for fitness of circulation. As to the choice of a narrower tolerance range for the second test, it represents, in

the opinion of the Board, a necessary consequence of the use of a single parameter for both tests, because it would not make much sense to compare a banknote's parameter a second time with the same tolerance range, let alone with a wider tolerance range.

6.5 Thus, the notional skilled person capable of implementing the teaching of the contested patent would have realised that some of the parameters measured by the judgment unit 30 of E3 contained information indicative both of a banknote's genuineness and of its condition. In particular, such a skilled person would have known that length was suitable for determining the denomination of a banknote on depositing and for checking whether a banknote's dimension fell within a certain tolerance range, whereby a failure to meet such test would have implied a damaged or dog-eared banknote. Similarly, the skilled person would have realised that the colour spectrum of transmitted light measured in E3 provided information about the authenticity of a banknote on the basis of the presence of certain frequency peaks of certain amplitudes, and that, by limiting the range of acceptable amplitudes, it would have been possible to identify soiled banknotes.

6.6 In summary the Board considers that it would have been obvious to a person skilled in the art, starting from the teaching of E3 and facing the problem of determining how to test banknotes on the basis of the parameters disclosed in this document, to realise that at least some of these parameters were suitable for testing a banknote both on depositing and on dispensation. In doing so, the skilled person would have arrived at method falling within the terms of

claim 1 of the contested patent. Hence, the claimed subject-matter does not involve an inventive step within the meaning of Article 56 EPC.

First auxiliary request

7.1 Claim 1 according to the first auxiliary request differs from claim 1 of the patent as granted in that:

(a) it is specified that the parameter (x) to be measured is "*indicative of the authenticity of a value carrier*" ; and

(b) the term "*genuine*" has replaced *"valid"* in the expression "*not accepted as valid*" .

7.2 According to the respondent, the first amendment (a), based on claim 14 of the patent as granted, and its consequential amendment (b) constituted a limitation which further distinguished the subject-matter of claim 1 from the teaching of E3.

7.3 As submitted by the appellant, however, the patent as granted does not provide any basis for interpreting this amendment as limiting the choice of parameters to be measured to such parameters which are exclusively indicative of the authenticity of the value carrier.

The values of some of the parameters referred to by way of example in the contested patent (cf item 6.2 above) necessarily depend both on the authenticity and on the condition of a genuine banknote, whereby the conclusions to be drawn as to the banknote's acceptability upon depositing or dispensing are

essentially a function of the corresponding tolerance ranges. Furthermore, a parameter sensitive to authenticity but insensitive to soiling or damage would not provide any information on the state of the banknote and thus would appear to be unsuitable for implementing the teaching of the contested patent.

Thus, in the opinion of the Board, claim 1 of the first auxiliary request merely clarifies that the measured parameter should be suitable for establishing both a banknote's authenticity and its condition, and not, for instance, only its denomination and condition.

7.4 As pointed out by the appellant, E3 provides at least one example of a parameter, *ie* light reflected by a pattern (cf E3, column 9, lines 38, 39), which is not only indicative of the authenticity of a value carrier but also sensitive to soiling. In the opinion of the Board, it would have been obvious to a skilled person wishing to implement the teaching of E3 to select such a parameter and to assess both the authenticity and the condition of a value carrier by comparing the measured parameter values with suitable tolerance ranges.

7.5 Hence, the subject-matter of claim 1 of the first auxiliary request does not involve an inventive step within the meaning of Article 56 EPC.

Second auxiliary request

8.1 Claim 1 according to the second auxiliary request relates to a method comprising essentially the following steps:

– a plurality of parameters indicative of the authenticity of a value carrier are measured;

– the value carrier is accepted as genuine if each parameter falls within a corresponding first acceptance range;

– the value carrier is not subsequently dispensed unless one of said parameters falls within a corresponding second acceptance range narrower than the first.

The last condition implies that at least one parameter has to fall within the narrower range for the value carrier to be subsequently dispensed.

8.2 Though the wording of this claim is essentially based on claim 1, 2 and 14 of the patent specification, there is no support in the application as originally filed for the claimed combination of steps. In fact, claim 1 and the description as originally filed teach that when a plurality of parameters are measured, each of the measured parameters has to fall within a narrow corresponding range for the value carrier to be considered fit for circulation. The discrepancy between the content of the application as originally filed and the granted claims can be explained by the fact that the latter were filed between the International Preliminary Examination Report and the communication under Rule 51(4) EPC.

8.3 As to the appellant's arguments that lack of support of a combination of features recited in the claims of the

granted patent was a new ground of opposition and that, as such, it could not be examined without the patent proprietor's consent, it is observed that in G 9/91 (OJ EPO 1993, 408) the Enlarged Board of Appeal stated the following (see point 19.):

"In order to avoid any misunderstanding, it should finally be confirmed that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC)."

Thus, the Board has not only the right but also the duty to examine*, inter alia*, whether the subject-matter of a newly filed independent claim introduces undisclosed subject-matter.

8.4 Since claim 1 of the second auxiliary request covers subject-matter which extends beyond the content of the application as originally filed, it is not admissible under Article 123(2) EPC.

Third auxiliary request

9.1 The claims according to the third auxiliary request filed on 21 July 2003 were amended in the oral proceedings of 21 August 2003 and submitted as a new third auxiliary request. In the opinion of the Board, this late-filed request should be admitted into the proceedings because it was occasioned by an objection raised by the appellant in the oral proceedings, and it aims at limiting the claimed subject-matter to one of

the two alternatives covered by the independent claims of the previous third auxiliary request.

9.2 Claims 1 to 18 correspond essentially to the claims of the application as originally filed amended so as exclude the alternative embodiment of the invention based on the measurement of a single parameter. Hence, these claims do not contain any subject-matter extending beyond the content of the application as originally filed. Furthermore, the independent claims 1 and 13 do not extend the protection conferred by the contested patent. The description comprises consequential amendments.

Hence, all amendments are admissible under Articles 123(2) and (3) EPC.

9.3 Claim 1 relates to "a method of accepting, validating and dispensing value carriers" based on the following steps:

- a plurality of parameters of a value carrier presented by a user is measured;

- the value carrier is accepted as valid if each parameter (x) falls within a corresponding first acceptance range T_A;

- the value carrier is subsequently dispensed only if each said parameter (x) falls within a corresponding second acceptance range T_B narrower than the first;

9.4 Claim 1 differs from the method shown in E3 essentially in that:

– each of the plurality of parameters for testing whether a banknote presented by a user is acceptable for payment is also used to determine whether the banknote is acceptable for dispensation,

– whereby the second acceptance range is narrower than the first one.

9.5 Starting from the teaching of E3, a problem solved by the claimed method can be seen in decreasing the probability that "bad" banknotes, *ie* not only counterfeit banknotes but also genuine banknotes unfit for reuse, are put into circulation (patent specification, column 2, lines 14 to 24 and 47 to 54).

The Board is satisfied that checking a banknote, which has been judged acceptable on deposition, against a narrower acceptance criterion before dispensation will identify not only damaged or soiled banknotes but also banknotes which "just" pass the acceptance criterion with a certain apparatus but may be rejected by a different apparatus because one or more of their parameters are too close to the outer boundaries of the corresponding acceptance ranges. This could happen, for instance, if different apparatuses have slightly different acceptance ranges and/or sensitivities (cf patent specification column 4, lines 6 to 12).

In other words, by comparing all parameters used to authenticate a banknote with narrower acceptance ranges

before reuse, it is ensured that only "fit" banknotes with parameters well within the acceptance ranges for deposited banknotes are recirculated.

9.6 As pointed out above, E3 teaches that banknotes which are soiled, damaged or dog-eared should be judged unfit for circulation and thus rejected . As to the authenticity detection, only banknotes which are set manually in a cash box should be tested upon dispensation, because of possible setting errors (cf E3 column 12, lines 57 to 68).

Thus, E3 teaches to carry out tests suitable for determining whether a banknote is genuine or not, whereby it is suggested that soiled banknotes should be accepted, and to check a banknote thoroughly for damage before it is dispensed. Though, as concluded above (cf ***"Main request"***), an obvious implementation of a method for testing banknotes according to E3 would consist in using one or more parameters (*eg* length and spectrum of transmitted light) indicative of certain features of a genuine banknote and of damage or soiling, and in comparing such measurements with predetermined tolerance ranges, E3 does not suggest testing a banknote's fitness for circulation on the basis of all the parameters involved in assessing its authenticity. On the contrary, the disclosure in E3 does not appear to give any incentive to measuring upon dispensation authenticity parameters which may not reliably reflect damage and/or soiling.

9.7 In other words, the claimed method goes beyond the mere recognition that a test for authenticity and fitness for circulation could be improved by performing

redundant measurements based on different parameters, as submitted by the appellant. It ensures that of all the banknotes recognized as genuine only those which have all the parameters lying well within the corresponding acceptance ranges for deposited banknotes are recirculated, whereas banknotes with parameters barely falling within the acceptance ranges for authenticity are withdrawn, no matter whether such parameters are primarily indicative of a banknote's authenticity, its fitness for circulation or both.

9.8 Since there is no suggestion in the cited prior art to test a banknote on dispensation on the basis of all the parameters used to determine the banknote's acceptability on deposition, the Board concludes that it would not have been obvious to a person skilled in the art, starting from the teaching of E3 to arrive at a method falling within the terms of claim 1 of the third auxiliary request. Hence, the subject-matter of this claim involves an inventive step within the meaning of Article 56 EPC.

9.9 Claim 13 relates to an "*apparatus for accepting, validating and dispensing value carriers*" comprising means for effecting the method steps recited in claim 1. For the same reasons given above, also the subject-matter of this claim involves an inventive step within the meaning Article 56 EPC.

Claims 2 to 12 and 14 to 18 are dependent and, therefore, their subject-matters also comply with Article 56 EPC.

10. In the result, the Board finds that the respondent's third auxiliary request satisfies the requirements of the EPC, and that the patent can be maintained on the basis thereof.

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 maintain the patent on the basis of the following documents according to the respondent's third auxiliary request:

Claims: 1 to 18 filed in the oral proceedings on 21 August 2003;

Description: columns 1 to 5 filed in the oral proceedings on 21 August 2003;

Figures: 1 and 2 of the patent specification.

The Registrar: The Chairman:

R. Schumacher G. Davies