

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 22 July 2009**

Case Number: T 0548/08 - 3.5.03

Application Number: 04016901.3

Publication Number: 1467272

IPC: G05B 19/418

Language of the proceedings: EN

Title of invention:
Parts classification unit

Applicant:
YAMAZAKI MAZAK KABUSHIKI KAISHA

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC R. 111(2), 103(1)(a)

Relevant legal provisions (EPC 1973):

Keyword:
"Decision reasoned (no)"
"Substantial procedural violation (yes)"
"Remittal (yes)"
"Reimbursement of appeal fee (yes)"

Decisions cited:
T 0292/90

Catchword:
-



Case Number: T 0548/08 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 22 July 2009

Appellant: YAMAZAKI MAZAK KABUSHIKI KAISHA
Azanorifune 1, Ooazaoguchi
Ooguchi-cho
Niwa-gun
Aichi-ken (JP)

Representative: Reinstädler, Diane
Anwaltskanzlei
Gulde Hengelhaupt Ziebig & Schneider
Wallstrasse 58/59
D-10179 Berlin (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 8 October 2007
refusing European application No. 04016901.3
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: A. S. Clelland
Members: B. Noll
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division refusing European application no. 04016901.3.

II. The examining procedure leading to the decision to refuse the application can be summarized as follows:

(a) The examining division issued a first communication objecting that claim 1 lacked clarity (Article 84 EPC) because of the reference to a "detecting portion" in the penultimate feature. The applicant was invited to file clarified claims meeting the requirements of Rule 29 EPC 1973, to acknowledge prior art documents US-A-4 998 206 (D1) and JP-A-07 124773 (D2) in the description and to delete the last paragraph on page 120 of the description.

(b) In response the applicant filed a new set of claims and amended pages 1-5, 14, 16-24, 31, 35, 42, 43, 48, 62, 72, 76 and 120 of the description.

(c) A further communication was issued by the examining division objecting that the amendments made to pages 35, 42, 43, 48, 62, 72 and 76 of the description contained subject-matter extending beyond the content of the application as filed (Article 123(2) EPC) and that the features of unspecified claims were not supported by the description. Objection was also raised that the embodiments described at pages 31 to 120 did not fall within the scope of the claims (Article 84 EPC).

(d) In response to the further communication the applicant did not propose any further amendments and

argued that the amendments previously made to the description did not add matter but only made clear the correspondence between the broader terms in the claims and the more specific terms employed in the description. For two out of eight "couples" of broad and detailed terms the equivalence was explained in detail.

(e) A consultation by telephone between a member of the examining division and the applicant was held on 23 January 2007. According to the minutes sent to the applicant a time limit of two months was given for the applicant to "indicate the basis for the amendments listed in the letter of reply of 02.10.2006".

(f) In a further letter by the applicant dated 23 March 2007 the basis for the equivalence of the "further couples 3 to 8" was explained in detail.

(g) The decision to refuse the application, dated 8 October 2007, was based on the grounds that the amended application documents included added subject-matter (Article 123(2) EPC) and that features contained in the claims were not supported by the description whilst certain embodiments did not fall within the scope of the claims (Article 84 EPC).

III. In the notice of appeal the appellant requested that the decision under appeal be cancelled. In the statement of grounds all amendments made during the examination procedure were withdrawn and it was requested that a patent be granted on the basis of claims 1-10 of a main request or, in the alternative, claims 1-10 of an auxiliary request, both filed together with the statement of grounds.

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

"A parts classification unit (15) for absorbing parts (70) made by cutting and machining a sheet workpiece (70A) and carrying from a first position (5) to a second position (10) through absorbing carriage means (20) and classifying, said parts classification unit comprising:

- an absorbing position information storing portion (122) for storing absorbing position information (BRJ) concerning the absorbing position of said absorption carriage means (20) with respect to a plurality of parts groups (sort 3, sort 2, ..), said parts group being comprised of one or more parts (70) in the same shape to be classified;
- a parts location information storing portion (111a) for storing location information (SNJ) at said first position (5) concerning individual parts (70) belonging to said plurality of parts groups (sort 1, sort 2, ...);
- a shape information storing portion (110) for storing parts shape information (BZ) of said parts (70) to be classified and area shape information (Z10) of parts classification area in said second position (10);
- a parts classification position computing portion (130) for computing and composing parts classification position information (PNJ) by computing classification position of said each parts group (sort 3, sort 2, ...) with respect to said parts classification area (10) on the basis of said parts shape information (BZ) and said area

shape information (Z10) stored in said shape information storing portion (110);

- a parts classification position information storing portion (137) for storing the parts classification position information (PNJ) computed by said parts classification position computing portion (130);
- a parts corresponding information detecting portion (146) for detecting absorbing position information (BRJ) and parts classification position information (PNJ) corresponding to said parts (70) concerning individual parts (70) in said each parts group (sort 3, sort 2, ...) from the absorbing position information (BRJ) stored in said absorbing position information storing portion (122), the location information (SNJ) stored in said parts location information storing portion (111a) and the parts classification position information (PNJ) stored in said parts classification Position information storing portion (137); and
- a program composing portion (146) for composing and outputting a classification program (SPR) with respect to said individual parts (70) composing moving positioning command (FRn) of said absorption carriage means (20) from said first position (5) to said second position (10) an [sic] the basis of the detecting result by said parts corresponding information detecting portion (146) for said individual parts (70).

Claim 1 according to the auxiliary request differs from claim 1 of the main request substantially in that the expression "absorbing carriage means" is replaced by

"palletizing robot", "absorbing position information storing portion" by "parts robot information memory", "parts shape information" by "parts graphic", "area shape information" by "pallet graphic", "parts classification position computing portion" by "pallet nesting information setting portion", "parts classification position information storing portion" by "pallet nesting information memory" and "parts classification position information" by "pallet nesting information".

Reasons for the Decision

1. *Procedural violation*

1.1 According to Rule 111(2) EPC decisions of the European Patent Office which are open to appeal shall be reasoned. In accordance with the established case-law this requires that the decision shall contain, in logical sequence, the arguments which justify its tenor. In particular the facts and arguments which led to the decision must be discussed in sufficient detail in order to enable a party and, in case of a subsequent appeal the board of appeal, to examine whether the decision was justified or not (see e.g. T 292/90, discussed in Case Law of the Boards of Appeal of the European Patent Office, 5th edition, 2006, VI.M.5.3.3). In accordance with the established case law the absence of sufficient reasoning is a substantial procedural violation.

1.2 The first ground for refusal is set out at point 1a of the reasons of the decision under appeal and is that

the amendments on pages 35, 42, 43, 48, 62, 72 and 76 do not comply with the requirements of Article 123(2) EPC. No reason is given for this ground other than the assertion that these pages "do not readily show the direct relation neither [sic] to the original description, nor [sic] to the translation of the priority documents". However, given that all amendments to the description made during the examining procedure were withdrawn with the statement of grounds of appeal the board does not consider it necessary to pursue the question of whether this ground for refusal was adequately reasoned.

1.3 The second ground for refusal is set out in point 1b which reads as follows:

"The Examining Division objects that the features contained in the claims are not supported in the description, Article 84 with Rule 27(1)(c) EPC, and, moreover, the embodiments of the invention as described on description pages 31 to 120 do not fall within the scope of the present claims. Thus, this inconsistency between the claims and description leads to doubt as to the extent of the protection to be afforded by the claims, Article 84 EPC."

In the board's view this general statement, which merely refers to a large number of pages without further explanation, cannot be considered as a reasoned objection; it is indeed no more than an assertion which requires to be substantiated by a detailed analysis.

1.4 However, no such analysis is made in the decision. Instead, there follows at points 2a and 2b a presentation of the applicant's arguments as to added

subject-matter whilst at point 3a terms used in the claims and the description are compared. Point 3a goes on to state that the various terms "do not show a direct entire equivalence" since they "are not suggested from the corresponding other wording, especially since the terms vary considerably and are not obviously derivable from each other" and ends with the conclusion: "Thus, the skilled man, when confronted with such entirely different terminology is misled [sic] linguistically to consider technically different elements and is effectively confronted with additional information which is effectively an extension of original subject-matter. The amendments, therefore, do not comply with the requirements of Article 123(2) EPC."

The level of substantiation in this paragraph again does not go beyond an assertion. However, in the board's view it cannot be concluded from the mere fact that different terminology was introduced into the claims that this terminology necessarily relates to different technical elements. Such a conclusion would have required that the examining division analyse the technical subject-matter in order to arrive at an interpretation of the terminology, but no such analysis can be found in the decision; indeed, the only place in the file the board can find an interpretation of the terminology is in the applicant's letters in response to the second communication and the telephone conversation.

Thus, it is left to the board and the appellant to speculate as to which features of the claims were considered by the examining division as not supported

by the description, why the division recognized several distinctive embodiments in the application and why such embodiments were considered to fall outside the scope of the claims.

The board notes that the appellant points out at page 7 of the statement of grounds that a specific reason for the objected lack of support was not given. Although the statement of grounds goes on to discuss the question of support of the claims the board is not in a position to decide on this issue due to the absence of reasoning in the impugned decision.

2. *Remittal*

In conclusion, instead of a logical chain of reasoning as to why the claims were not supported by the description or why embodiments fell outside the scope of the claims the entire burden of analysis and argument was put on the applicant, who was expected to work out for himself the true nature of the examining division's objections. The impugned decision indeed devotes considerably more space to the applicant's arguments than to reasoning as to why the application fails to comply with the EPC. The board therefore considers that the decision to refuse the application does not comply with Rule 111(2) EPC so that there has been a substantial procedural violation.

This substantial procedural violation requires that the decision be set aside and the case remitted to the department of first instance for further prosecution.

3. *Reimbursement of the appeal fee*

Under these circumstances, the board furthermore considers that it would be equitable to reimburse the appeal fee pursuant to Rule 103 (1) (a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted for the department of first instance for further prosecution on the basis of the claims according to the main and the auxiliary request.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland