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**Datasheet for the decision
of 9 May 2012**

Case Number: T 1178/08 - 3.5.04

Application Number: 03003609.9

Publication Number: 1339217

IPC: H04N1/32, H04N1/00

Language of the proceedings: EN

Title of invention:
Photofinishing system

Applicant:
FUJIFILM Corporation

Headword:

Relevant legal provisions:
EPC Art. 123(1)
EPC 1973 R. 66(1)
EPC R. 137(2) (2010), 137(3) (2010)
RPBA Art. 12(4)

Keyword:
Amended claims filed with the statement of grounds of appeal -
not admitted

Decisions cited:
G 0010/93, R 0010/09, R 0011/11, T 1007/05, T 0144/09

Catchword:
See section 2.6



Case Number: T1178/08 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 9 May 2012

Appellant: FUJIFILM Corporation
(Applicant) 26-30, Nishiazabu 2-chome
Minato-ku
Tokyo (JP)

Representative: Klunker . Schmitt-Nilson . Hirsch
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted 28 January 2008
refusing European patent application No.
03003609.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: F. Edlinger
Members: C. Kunzelmann
C. Vallet

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 03 003 609.9.
- II. In the first-instance proceedings the examining division had issued two communications pursuant to Article 96(2) EPC 1973 and a summons to attend oral proceedings pursuant to Rule 71(1) EPC 1973, all raising objections under *inter alia* Article 56 EPC 1973. The applicant filed amended claims and description pages but, with respect to claim 1, consistently maintained in substance claim 1 as originally filed. Furthermore the applicant did not file any auxiliary requests with its replies. In a letter of 2 November 2007 in reply to the summons, the applicant informed the examining division that it would not be attending the oral proceedings and requested a decision based on the papers as on file.
- III. The decision under appeal was based on the ground that claim 1 then on file, namely claim 1 as originally filed, did not meet the requirements of Article 84 EPC 1973. Furthermore, insofar as claim 1 could be understood, its subject-matter lacked novelty or at least inventive step (Articles 54 and 56 EPC 1973).
- IV. The applicant appealed and requested in the notice of appeal that the decision under appeal be set aside. Oral proceedings were requested as an auxiliary measure. With the statement of grounds of appeal the appellant filed amended claims 1 to 21. The appellant requested that a patent be granted on the basis of the claims filed with the statement of grounds of appeal. The appellant also identified amendments made to

claim 1 in order to overcome the objection under Article 84 EPC 1973 and gave arguments as to why the invention as defined in the amended claims had certain advantages and was not taught or suggested by the available prior art.

V. Claim 1 reads as follows:

"A method for selecting and ordering photographic prints (122) from a remote location (102) that is apart from a lab (104), the method comprising the steps of:

- a) processing a *roll of exposed film* (118, 400) to produce a plurality of film images (402, 404);
- b) scanning the plurality of film images (402, 404) to create a *plurality of digital images corresponding to the plurality of film images* (402, 404);
- c) manipulating the digital images to create a positive low-resolution digital image (406, 410) for each of the plurality of film images (402, 404);
- d) creating a *lab digital image file comprising at least one of said digital images and lab meta data* (220) including lab-generated image identifiers for identifying the plurality of film images (402, 404) and the corresponding digital images, the lab-generated image identifiers being independent of any manufacturer generated frame numbers disposed on the roll of exposed film (118, 400);
- e) making the *lab digital image file* associated with the plurality of film images (402, 404) accessible at the remote location;
- f) *allowing creation of a studio digital image file comprising order data including one or more of studio-generated image identifiers for identifying the digital images at the remote location (102), the studio-generated image identifiers being separate and distinct from the lab-generated image identifiers and any*

manufacturer generated frame numbers disposed on the roll of exposed film (118, 400);
g) receiving the *studio* digital image file from the remote location;
h) accessing *at least one of* the lab-generated image identifier *and the studio-generated image identifier* of each of the digital images *identified with the studio digital image file* received from the remote location to identify the corresponding film image; and
i) creating a photographic print (122) of each of the digital images *identified with the studio digital image file* received from the remote location using the identified film image."

Amendments with respect to claim 1 on which the decision under appeal was based are shown in *italics* above.

VI. The board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536), annexed to a summons to oral proceedings. The board raised *inter alia* the issue that the claims filed with the statement of grounds of appeal appeared to create a fresh case requiring substantial further examination. The board also expressed the opinion that these claims should have been submitted to the first instance and that by presenting the relevant request only in appeal proceedings the appellant was making it impossible for the board to examine the decision under appeal. In this context reference was made to Rule 137(3) EPC and Article 12(4) RPBA. The board added that new objections under Article 84 EPC 1973 and Article 123(2) EPC would probably have to be discussed in the oral proceedings if the board admitted the amended claims into the appeal proceedings.

- VII. In a letter of 3 April 2012 the appellant informed the board that it would not be attending the oral proceedings. No observations on the issues raised in the board's communication were filed.
- VIII. Oral proceedings were held by the board on 9 May 2012, in the appellant's absence, in application of Rule 71(2) EPC 1973 and Article 15(3) RPBA. At the end of the oral proceedings the chairman announced the board's decision.

Reasons for the Decision

1. The appeal is admissible.
2. *Admission of the claims filed with the statement of grounds of appeal*
 - 2.1 In accordance with Article 123(1) EPC in conjunction with Rule 137(2) and (3) EPC, an applicant is to be given at least one opportunity to amend the application of his own volition. No further amendments may be made without the consent of the examining division. The Convention and the Implementing Regulations do not contain explicit provisions concerning the admissibility of amendments in appeal proceedings. Rule 66(1) EPC 1973 sets out that the provisions relating to proceedings before the department which has made the decision from which the appeal is brought shall be applicable *mutatis mutandis* in such a case. Therefore, an appellant is not entitled, as a matter of right, to present amendments of his own volition at the appeal stage, but as a matter of discretion to be exercised by the board. Articles 12 and 13 RPBA set out

the provisions governing the basis of appeal proceedings and amendments to a party's case which are binding upon the boards of appeal (Article 23 RPBA).

2.2 In particular, Article 12(4) RPBA reads as follows:

"Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2)."

In the paragraph above, (1) and (2) refer to Articles 12(1) and 12(2) RPBA, respectively.

2.3 In the board's view, the above wording makes clear that the board in an *ex parte* case has discretion over whether or not to admit requests which could have been presented to the first instance, but were not. It must exercise that discretion having regard to the particular circumstances of the individual case.

2.4 The board considers that this view is consistent with the view taken in previous decisions in the different context of *inter partes* cases (see, for instance, R 10/09, point 3.2 of the Reasons; T 144/09, point 1.14 of the Reasons and R 11/11, which rejected the petition for review of T 144/09 as clearly unallowable, in point 9 of the Reasons; and T 1007/05, point 3 of the Reasons).

2.5 The board is aware that amended claims filed together with the statement of grounds of appeal have in many cases been admitted into appeal proceedings if they

constituted a legitimate reaction to the reasoning underlying the appealed decision. Indeed, such amended claims filed with the statement of grounds of appeal may achieve the goal of "a more defined and controlled initial phase of proceedings" (see T 1007/05, point 3 of the Reasons), in particular if they serve to avoid later amendments. But this does not mean that the board is obliged to admit amended claims solely because they were filed with the statement of grounds of appeal.

2.6 In the present case, the applicant had been given several opportunities to file amended claims in the first-instance proceedings. In particular, as far as Article 56 EPC 1973 was concerned, the decisive issue in the communications and replies, as well as in the summons to attend oral proceedings before the examining division, was whether the only difference over the closest state of the art, namely the step of creating lab meta data including lab-generated image identifiers (see feature d) of claim 1) was sufficient to confer inventive step on the claimed subject-matter. With respect to claim 1 the applicant chose to maintain in substance, and in the end also in form, claim 1 as originally filed (see point II above). No auxiliary requests were filed. Instead the applicant tried to convince the examining division with arguments that the subject-matter of claim 1 involved an inventive step. In reply to the summons to oral proceedings which already set out the essential reasons for the later decision, the applicant merely requested a decision according to the file. Since the applicant's arguments did not convince the examining division, the application was ultimately refused.

2.6.1 Thus already after the first communication of the examining division the applicant was aware that the

application might be refused for lack of inventive step if his arguments concerning this decisive issue reflected in feature d) of claim 1 did not convince the examining division. Furthermore, the detailed reasoning concerning Articles 54 and 56 EPC 1973 given in the decision under appeal is almost *verbatim* the same as that given in the summons to attend oral proceedings. Under these circumstances, in the board's view, the amended claims filed with the statement of grounds of appeal are not a reaction to the reasoning underlying the appealed decision. Instead they are the result of the applicant's decision no longer to pursue claim 1 as originally filed and to submit a fresh case to the board of appeal.

2.6.2 This assessment is confirmed by the fact that the statement of grounds of appeal gives no indication that or how the amended claims are a reaction to the reasoning underlying the appealed decision. Nor does it indicate why the amended claims were not submitted to the examining division even though they could have been submitted at the latest in reaction to the summons to attend oral proceedings, in which the applicant had been informed of the ultimately relevant reasoning.

2.6.3 It is also confirmed by the wording of the amended claims. Namely, these claims do not further specify feature d) of claim 1, which reflected the decisive issue (in the context of the objections relating to Articles 54 and 56 EPC 1973) discussed in the first-instance proceedings. In particular, the wording of claim 1, when read in the light of the statement of grounds of appeal and the decision under appeal, does not make clear that the (or which) amendments made to claim 1 are in substance caused by the objections concerning feature d) of claim 1, as given in the

decision under appeal. Instead, amended claim 1 has an additional feature f) specifying separate and distinct studio-generated image identifiers which are not related to the lab meta data including lab-generated image identifiers (see point 2.6 above).

2.6.4 In the board's view, the applicant should have submitted these (or other suitably) amended claims in the first-instance proceedings. By presenting its sole and amended request only in appeal proceedings the applicant is making it impossible for the board to examine the contested decision. In addition, the new claims necessitate further investigations and give rise to further objections (as set out in the communication accompanying the summons issued by the board) to which the appellant did not reply in substance. This is contrary to the main purpose of *ex parte* appeal proceedings. Namely, "[p]roceedings before the boards of appeal in *ex parte* cases are primarily concerned with examining the contested decision" (see point 4 of the reasons for the decision of the Enlarged Board of Appeal G 10/93, OJ EPO 1995, 172). The appellant has not submitted any arguments as to why the present case is an exception justifying that the board carry out a full examination of the application as to patentability requirements. Nor does the board see any reason why the present case might be such an exception.

2.7 In view of the above the board has exercised its discretion under Article 12(4) RPBA by not admitting the claims filed with the statement of grounds of appeal into the appeal proceedings.

3. Hence the decision under appeal cannot be set aside.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated