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**Datasheet for the decision
of 12 June 2012**

Case Number: T 1817/08 - 3.5.04

Application Number: 96660085.0

Publication Number: 776124

IPC: H04N3/15

Language of the proceedings: EN

Title of invention:

Method and apparatus for imaging an object

Patent Proprietor:

PLANMED OY

Former Opponent:

Sirona Dental Systems GmbH

Headword:

Relevant legal provisions:

EPC Art. 54(1), 54(2)

Keyword:

Admissibility of evidence (yes)
Availability to the public (no)

Decisions cited:

T 0129/88

Catchword:

see point 4



Case Number: T1817/08 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 12 June 2012

Appellant: PLANMED OY
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Respondent: Sirona Dental Systems GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 3 July 2008
revoking European patent No. 776124 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: F. Edlinger
Members: R. Gerdes
C. Vallet

Summary of Facts and Submissions

I. The present appeal arises from the decision of the opposition division revoking European patent No. 0 776 124. The opposition division found that the subject-matter of claim 1 as granted and of claim 1 of the proprietor's first auxiliary request extended beyond the content of the application as filed (Articles 100(c) and 123(2) EPC) and that the subject-matter of claim 1 of the second auxiliary request lacked novelty (Article 54(1) and (2) EPC) with respect to the disclosure of the following document:

E3: Thorez Manuel, PhD thesis dated 27.09.1995, Université Paris XII Val-de-Marne, Etude et réalisation d'un système numérique d'imagerie tomographique appliqué à l'odontologie.

The opposition division also decided to admit the following documents into the proceedings:

E10: Image Sensing Products 1989, EG&G Reticon, July 1989, pages 129 to 131 and

E11: "A Large Area TDI Image Sensor for Low Light Level Imaging", IEEE Journal of Solid State Circuits, vol. SC-15, no. 4, August 1980, pages 753 to 758.

II. An appeal against this decision was lodged by the proprietor (appellant). With the statement of grounds of appeal, the appellant filed claims of a first to fifth auxiliary requests and provided a copy of a fax received from the library of the Université Paris 12 Val-de-Marne, according to which the public had been made aware of the thesis E3 in June 1996 (see statement of grounds, section II.c). The appellant requested that

the decision under appeal be set aside and that the opposition be rejected or, alternatively, that the patent be maintained on the basis of the claims of the first to fifth auxiliary requests. The claims of the first and second auxiliary requests were identical to those underlying the decision under appeal. The appellant also requested that E3 should not be considered due to lack of proof of its public availability and that E10 and E11 not be admitted into the proceedings since these documents were not *prima facie* highly relevant.

- III. In a letter of 5 May 2011 the respondent acknowledged that E3 "actually has not been public prior art at the priority date of the Application" and withdrew its opposition.
- IV. In a communication accompanying the summons to oral proceedings the board set out its preliminary opinion on the case and indicated that it was inclined to follow the opposition division in its assessment of the main and first auxiliary request and with respect to the admittance of E10 and E11. The board also indicated that the opposition division's decision with respect to lack of novelty of the subject-matter of claim 1 of the second auxiliary request in view of E3 could not be upheld, and that it therefore intended to remit the case to the first instance for further prosecution of the proceedings on the basis of the second auxiliary request.
- V. By letter of 21 May 2012 the appellant withdrew the main request and the first auxiliary request. It was requested that the case be remitted to the first instance for further prosecution based on the new main request (previously submitted second auxiliary request)

and first to third auxiliary requests (previously submitted third to fifth auxiliary requests) without holding oral proceedings.

VI. Independent claim 1 according to the respondent's new **main request** reads as follows:

"A method of imaging an object with the help of electromagnetic radiation, in which method radiation reflected from and/or transmitted through an object (O;P;M) is detected by an imaging sensor system capable of delivering an electrical output signal conveying the image information obtained from the object (O;P;M) and which imaging sensor system includes a solid-state sensor comprised of a row-and-column fashion arrayed plurality of picture imaging elements,

characterized in that

the method applies TDI-mode imaging technique, wherein between the object to be imaged and the imaging sensor is arranged a mutual, relative movement, so that the image information, which is formed from the object to be imaged on solid-state sensor imaging elements, is transferred at the same speed as said relative movement, that the physical size of the imaging elements is selected smaller than that required to achieve the maximum resolution required from the sensor, and wherein the imaging element information are shifted in synchronized steps corresponding to the physical size of the solid-state sensor imaging elements, the shifted image information being subsequently binned to correspond to the required resolution, and wherein the method is applied on CCD sensors as the solid-state sensor imaging elements, and wherein the image element information, which represent the image information obtained from the individual imaging elements, are binned in their charge form."

- VII. The wording of the claims of the new first to third auxiliary requests has no bearing on the present decision.
- VIII. The opposition division in its decision on admitting E10 and E11 into the proceedings (see decision under appeal, Reasons, section i) reproduced the argument of the former opponent that "the submission of the documents was necessitated by the opposition division's preliminary opinion on novelty with respect to the disclosure of Document E3". The opposition division then decided that the disclosure of E10 and E11 was "prima facie relevant for the understanding of the charge transfer and binning under discussion" and admitted E10 and E11 without, however, further referring to these documents in the reasons.

The public availability of E3 was presumed and not addressed in the decision under appeal.

- IX. The appellant's arguments may be summarised as follows:

With respect to the admissibility of E10 and E11 the appellant argued that E10 and E11 were not submitted within the opposition period. These documents were also not *prima facie* highly relevant, because they did not "touch upon patentability" and the respondent had failed to supply reasons for their relevance (see statement of grounds of appeal, section II.b and letter of 30 September 2009, section II).

Regarding the public availability of E3 the appellant stated that E3 was not a prior-art publication since the respondent had not "provided any proof or evidence of prior publication of document E3 before the relevant

priority date of the present patent, contrary to the general burden of opponent of proving actual prior publication of any cited non-patent literature". The true publication date of the doctoral thesis was only 26 June 1996, as evidenced by the fax of the library of the Université Paris 12 Val-de-Marne.

Reasons for the Decision

1. The appeal is admissible.
2. *Admittance into the proceedings of E10 and E11*
 - 2.1 According to the case law of the boards of appeal, the decision whether or not a late-filed document should be admitted into the proceedings is a matter for the discretion of the deciding body. This discretion is to be exercised having regard to the principle of fair proceedings, taking account of the circumstances of the case, inter alia the stage of the proceedings, the degree of relevance of the document and whether the party attempting to introduce it has acted in good faith.
 - 2.2 If the way in which a department of first instance has exercised its discretion on admitting late-filed documents is challenged in appeal, it is not the function of a board to review all the facts and circumstances of the case as if it were in the place of the department of first instance, and to decide whether or not it would have exercised such discretion in the same way as or differently from the department of first instance. A board of appeal should overrule the way in which a department of first instance has exercised its discretion only if the board concludes it has done so

according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, VII.E.6.6).

2.3 It is established case law of the boards of appeal that the filing of documents after the expiry of the opposition period, as in the present case, may be justifiable if it is an appropriate and immediate reaction to developments in the previous proceedings. It may also be admissible in order to prove claimed common general knowledge, if challenged (see Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, VII.C.1.5.1).

2.4 In the present case the opposition division, in view of the former opponent's argument that E10 and E11 were filed in reaction to the preliminary opinion on novelty, admitted E10 and E11 as being relevant for the understanding of charge transfer and binning. This might have been decisive for the evaluation of the teaching of the closest prior art (E3 in the present case). For a document to be admissible, it need not "touch upon patentability" (as such), as argued by the appellant. Therefore, the board is satisfied that the opposition division did not exercise its discretion according to wrong principles or in an unreasonable way.

3. *Public availability of E3*

3.1 The former opponent had argued in the notice of opposition that E3 was made available to the public on 27 September 1995. The former opponent referred to the fact that the first page of E3 reads: "Soutenu le

- 27 Septembre 1995 devant le jury composé de ..." and that presentations of doctoral theses were accessible to the public (see notice of opposition, section D).
- 3.2 Together with the statement setting out the grounds of appeal the appellant provided a fax from the library of the University of Paris 12 Val-de-Marne as evidence indicating that E3 was signalled to the public in June 1996, i.e. after the priority date of the patent.
- 3.3 It is therefore not apparent from the file whether E3 as a whole was (or which parts were) presented to a public audience on 27 September 1995. It is also not apparent whether the members of the jury were obliged to maintain secrecy or not. Thus it is not established that E3 was made available to the public before the date indicated in the library fax.
- 3.4 The former opponent acknowledged that he could not prove a publication date of E3 before the priority date of the opposed patent and withdrew the opposition (see point III above).
- 3.5 Although a board of appeal (and equally an opposition division) has an obligation under Article 114(1) EPC 1973 to investigate matters of its own motion, that obligation does not extend as far as investigating an allegation of prior public use or a prior oral disclosure, where the party who formerly made that allegation has withdrawn from the proceedings and it is difficult to establish all the relevant facts without his co-operation (cf. decision T 129/88, OJ EPO 1993, 598). Following this approach the board sees no need to pursue this matter of its own motion.

3.6 Accordingly, the board finds that the public availability of E3 before the priority date of the patent in suit is not proven. Hence, E3 is not part of the state of the art.

3.7 It follows from the above that the decision of the opposition division with respect to lack of novelty of claim 1 according to the second auxiliary request in view of E3 cannot be upheld.

4. *Remittal*

4.1 Thus the appeal is allowable. However, the opponent in its notice of opposition had based its objections on documents other than E3. These objections were not the subject of the decision under appeal or of the appeal proceedings.

4.2 In this situation, the board considers it appropriate to exercise its discretion pursuant to Article 111(1) EPC 1973 to remit the case to the first instance for further prosecution on the basis of the appellant's new main request and of its new first to third auxiliary requests. Since the patent had been revoked and although the opposition has been withdrawn in the meantime, the opposition division will have to examine whether the patent and the invention to which it relates according to the amended requests meet the requirements of the European Patent Convention.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated