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**Datasheet for the decision  
of 2 May 2013**

**Case Number:** T 1089/09 - 3.5.04

**Application Number:** 00100716.0

**Publication Number:** 1021031

**IPC:** H04N1/195

**Language of the proceedings:** EN

**Title of invention:**

Device for detecting images

**Applicant:**

Dimex World S.A.

**Relevant legal provisions:**

EPC 1973 Art. 56  
EPC Art. 123(1)  
EPC R. 137(2), 137(3)  
RPBA Art. 12(4)

**Keyword:**

Inventive step - main request and first auxiliary request (no)  
Second auxiliary request submitted with the statement of  
grounds of appeal - admissibility (no)

**Decisions cited:**

G 0010/93



**Beschwerdekammern  
Boards of Appeal  
Chambres de recours**

European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 1089/09 - 3.5.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.04**  
**of 2 May 2013**

**Appellant:** Dimex World S.A.  
(Applicant) c/o Fidirex SA  
Via Giacometti 1  
6901 Lugano (CH)

**Representative:** Marietti, Giuseppe  
Marietti, Gislon e Trupiano S.r.l.  
Via Larga, 16  
20122 Milano (IT)

**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 11 December 2008 refusing European patent application No. 00100716.0 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** A. Dumont  
B. Müller

## Summary of Facts and Submissions

- I. The appeal is directed against the decision to refuse European patent application No. 00100716.0.
- II. The examining division refused the application on the grounds that the subject-matter of claim 1 then on file lacked inventive step *inter alia* in view of prior-art document

D1: US 4,701,809.

- III. With the statement of grounds of appeal, the appellant submitted amended claims of a main request, a first auxiliary request and a second auxiliary request, and requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of either the main request, first auxiliary request or second auxiliary request.

- IV. In a communication accompanying the summons to oral proceedings, the board *inter alia* expressed the preliminary opinion that the subject-matter of claim 1 of both the main request and the first auxiliary request appeared to lack inventive step over D1 and common general knowledge, as exemplified for instance in

D3: JP 57-078539 A, including its abstract; and

D4: EP 0 680 191 A2.

In that communication, the board *inter alia* also questioned the admissibility of the second auxiliary request, because it was directed to an aspect diverging from the invention according to the first auxiliary

request, which was the invention that had been examined and decided upon by the examining division.

V. In a letter dated 23 April 2013 the appellant announced that he would not be attending the oral proceedings before the board. Oral proceedings took place on 2 May 2013 in his absence.

VI. Claim 1 of the main request reads as follows:

"Device for the detection of images present on a support, of the type comprising a case (1) with at least one flat transparent surface (2) for the rest of said image support, at least one light source (3), as well as means for the acquisition of images (4, 5, 6, 7, 8, 9) contained within said case (1), **characterized in that** said means (4, 5, 6, 7, 8, 9) for the acquisition of images and said sources of illumination (3) are fixed with respect to said support during the simultaneous acquisition of all the images present on said support".

VII. Claim 1 of the first auxiliary request reads as follows:

"Device for the detection of images present on a support, of the type comprising a case (1) with at least one flat transparent surface (2) for the rest of said image support, as least one light source (3), as well as means for the acquisition of images (4, 5, 6, 7, 8, 9) contained within said case (1), furthermore said means for the acquisition of images comprising means (4, 5, 6, 7) for the reflection of images from said rest surface (2), means (9) for the capture of the images, as well as at least one focusing element (8) interposed between said means (4, 5, 6, 7)

for reflection and said means for the capture (9) of the images, **characterized in that** said means (4, 5, 6, 7, 8, 9) for the acquisition of images and said sources of illumination (3) are fixed with respect to said support during the simultaneous acquisition of all the images present on said support, and in that said means (4, 5, 6, 7) for the reflection of images define an optical path (a, b, c, d, f) of the image, from said flat transparent surface to said focusing element, that is greater than, or equal to, 1 meter in length."

VIII. Claim 1 of the second auxiliary request reads as follows:

"Device for the detection of images present on a support, of the type comprising a case (1) with at least one flat transparent surface (2) for the rest of said support, as least one light source (3) comprising a directional illuminator that generates one or more light beams arranged to fall obliquely with respect to said flat transparent surface (2) for the rest of said support, as well as means (4, 5, 6, 7, 8, 9) for the acquisition of images, contained within said case (1), said means (4, 5, 6, 7, 8, 9) for the acquisition of images and said light source (3) being fixed with respect to said support during the simultaneous acquisition of all the images present on said support, **characterized in that** said light beams fall along straight lines of action that form an angle ( $\alpha$ ) between  $35^\circ$  and  $55^\circ$  with the perpendicular to said flat transparent surface (2) for the rest of the support."

IX. The relevant reasoning in the decision under appeal may be summarised as follows:

Document D1 represents the closest prior art and discloses a device with a case with at least one flat transparent surface, with at least one light source and with means for the acquisition of images, which features are fixed with respect to a support during the simultaneous acquisition of the image present on the support.

As Figure 2 of D1 is to scale, D1 further discloses an optical path via a mirror from said flat transparent surface to a focusing element in the means for acquisition that is greater than, or equal to, 1 metre in length. Choosing a focal length of 10 mm to 100 mm, for instance by using a commercially available 35 mm lens, is obvious in order to reduce the cost of the device.

X. The appellant's relevant arguments may be summarised as follows:

The device according to the main request has no moving parts. This reduces wear and maintenance costs, and it speeds up image acquisition. The camera of D1 comprises a CCD array which scans lines and thus moves with respect to the support during the acquisition of an image present on said support. Thus it is neither fixed nor does it allow simultaneous acquisition.

Claim 1 according to the first auxiliary request includes the features of dependent claims 2 and 4 as originally filed. The reflection means fold the optical path and thus makes the device less cumbersome.

Figure 1 of D1 is not a construction drawing. It is merely a schematic drawing, which allows no deduction to be made about the length of the optical path (see

also decision T 204/83). The combination of features thus involves an inventive step.

Claim 1 according to the second auxiliary request includes the features of dependent claims 5, 6 and 7 as originally filed. The directional illuminator in the device helps to prevent light beams from being directed at the operator's eyes, thereby avoiding dazzling. It is neither known nor suggested in the prior-art documents.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Main request
  - 2.1 Document D1 discloses a device according to the preamble of claim 1. Furthermore, the "sources of illumination", or "light source" (lamp 21), are fixed. This is not contested by the appellant.
  - 2.2 The board interprets the "acquisition means" according to claim 1, in accordance with the description, as implying a two-dimensional matrix sensor, which simultaneously acquires an image without recourse to movement of any mechanical part (see paragraphs [0034], [0041] and [0042] of the application as published). This constitutes the only departure from the device known from D1, where the acquisition means comprise a moving one-line scanner necessitating two to four minutes to complete a scan (see D1, column 2, lines 51 to 58, and column 3, lines 14 to 19).

- 2.3 The technical problem solved by the invention can thus be formulated as improving the device, in particular its acquisition speed.
- 2.4 A scanner with a two-dimensional sensor is commonly known to be a better solution than a moving one-line sensor when image acquisition needs to be faster (see for instance the abstract of D3; or D4, column 2, lines 1 to 24, as illustrations of this well-known fact). Furthermore, technical progress between 1987 (date of publication of D1) and 1999 (priority date of the present application) increased the attractiveness of two-dimensional sensors over one-line sensors.
- 2.5 As a result, the skilled person would have envisaged, at the priority date of the present application, choosing acquisition means (camera 15 in Figure 2 of D1) with a two-dimensional sensor, rather than a one-line sensor, if faster acquisition was a goal. In that case, the means for the acquisition of images including the sensor would have been fixed with respect to the support. This obvious solution would also have entailed the further advantage of reducing wear and maintenance costs due to the absence of moving parts, as referred to in paragraphs [0008] and [0036] of the application as published.
- 2.6 As a result, the subject-matter of claim 1 was obvious having regard to D1 and common general knowledge and does not involve an inventive step within the meaning of Article 56 EPC 1973.
- 2.7 The main request is thus not allowable.
3. First auxiliary request



- 3.1 The device of D1 further comprises a lens mounted on the camera (15), which is a means for focusing within the meaning of the present invention. It also comprises means (mirror 14) for the reflection of images from the rest surface (13). It is common general knowledge that such mirrors are used to fold an optical path and so make the device less cumbersome (see for instance D1, column 2, lines 35 to 40).
- 3.2 D1 does not disclose a lower limit for the length of the optical path. The choice of an appropriate length, or its lower limit, depends on the size of the images to be acquired and the angle of view of the means for acquisition, which in turn depends on the focal length of the lens and the size of the sensor. The description of the present application mentions that the focusing element could be a usual 35 mm photographic lens, which is inexpensive and easily obtainable (see paragraph [0027] in the application as published). The description provides no explanation as to how the lower limit is selected. Claim 1 in turn is silent about the type or focal length of the focusing element, or the size of the images to be acquired. In the absence of any mention in claim 1 of essential features which are necessary for determining a lower limit of the optical path length, the board regards the particular value of "1 meter in length" as arbitrary.
- 3.3 As a result, the subject-matter of claim 1 according to the first auxiliary request was obvious having regard to D1 and common general knowledge and does not involve an inventive step within the meaning of Article 56 EPC 1973.
- 3.4 The first auxiliary request is thus not allowable.

4. Second auxiliary request
- 4.1 In reaction to objections raised by the examining division against claim 1 as originally filed (corresponding to claim 1 according to the main request filed with the statement of grounds of appeal), the applicant chose to combine claims 1, 2 and 4 as originally filed, in particular comprising features relating to reflection means to make the device less cumbersome (see the first auxiliary request discussed in section 3 above). This was the invention examined and decided upon by the examining division.
- 4.2 Claim 1 according to the second auxiliary request does not further restrict the invention of the first auxiliary request, but combines claims 1, 5, 6 and 7 as originally filed. The combination aims to reduce dazzling for the operator (see for instance paragraph [0039] in the application as published), essentially by the use of a directional illuminator. This thus shifts the focus of the invention, replacing the invention according to the first auxiliary request with a different one that solves a different problem by different means.
- 4.3 In the present case, the factual situation regarding substantive issues when the appellant filed claims relating to the different invention according to the second auxiliary request (i.e. with the statement of grounds of appeal) was the same as that in the oral proceedings before the examining division. Moreover the appellant has not put forward any explanation as to why it did not file claims directed to that different invention in the examination proceedings. Lastly, that different invention did not play a role in the

examination proceedings, so that the examining division has not examined it, let alone decided on it.

- 4.4 It follows from the foregoing that the applicant was clearly given at least one opportunity to amend the application of his own volition in accordance with Article 123(1) in conjunction with Rule 137(2) and (3) EPC. Any further amendments are subject to the consent of the examining division or of the board.
- 4.5 As stated in decision G 10/93 (OJ 1995, 172; see point 4 of the reasons), "proceedings before the boards of appeal in *ex parte* cases are primarily concerned with examining the contested decision". Furthermore, Article 12(4) RPBA provides that the board has the power to hold inadmissible requests which could have been presented in the first-instance proceedings. Hence there was no obligation and indeed no reason for the board to start a full examination of the amended claims according to the second auxiliary request, which could have been presented in the examination proceedings.
- 4.6 Consequently, the board exercised its discretion in not admitting these amended claims into the appeal proceedings, pursuant to Article 12(4) RPBA.
- 4.7 As a result, the second auxiliary request is not admissible.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated