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**Datasheet for the decision  
of 3 July 2013**

**Case Number:** T 2235/12 - 3.5.04

**Application Number:** 04800627.4

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**IPC:** H04N5/3745, H04N5/217,  
H04N5/378, H04N5/361, H04N5/363

**Language of the proceedings:** EN

**Title of invention:**  
ON-CHIP BLACK CLAMP SYSTEM AND METHOD

**Applicant:**  
Altasens, Inc.

**Headword:**

**Relevant legal provisions:**  
EPC 1973 Art. 54, 113(1)  
EPC 1973 R. 67, 71(2), 71a(1)

**Keyword:**  
Novelty - (yes)  
Right to be heard - substantial procedural violation (yes)

**Decisions cited:**

**Catchword:**  
see points 3.4 to 3.8



**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 2235/12 - 3.5.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.04**  
**of 3 July 2013**

**Appellant:** Altasens, Inc.  
(Applicant) 501 Marin Street 200  
Thousand Oaks CA 91360 (US)

**Representative:** Fiener, Josef  
Patentanw. J. Fiener et col.  
P.O. Box 12 49  
87712 Mindelheim (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 15 May 2012  
refusing European patent application No.  
04800627.4 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** R. Gerdes  
B. Müller

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the examining division to refuse European patent application No. 04 800 627.4.
- II. The examining division informed the applicant in a communication dated 16 February 2009 that the claims then on file were not clear (Article 84 EPC). It also stated that the subject-matter of the claims was not new and/or did not involve an inventive step (Articles 54(1) and (2) and 56 EPC). In support of this finding the examining division referred to the following documents:
- D1: JP 2000 031450 A together with US 6 903 768 B1,  
D2: US 2003/0117676 A1,  
D3: US 6 507 365 B1.
- III. The applicant replied with a letter of 26 June 2009 submitting an amended set of claims, together with arguments regarding the clarity of the claims as well as novelty and inventive step of the claimed subject-matter.
- IV. On 25 October 2011 the examining division issued a summons to oral proceedings and indicated that claims 1 and 15 lacked clarity, that the presence of two independent claims directed to an apparatus contravened Rule 43(2) EPC and that the subject-matter of claims 1 and 15 lacked novelty in view of D3.
- V. The applicant reacted with a letter dated 15 February 2012 submitting an amended set of claims and arguments in support of novelty and inventive step with respect to the disclosure of D3.

VI. A telephone consultation took place on 17 February 2012 between the first examiner and the representative of the applicant. According to the minutes of the consultation the first examiner informed the representative that "the current claim 1 lacked clarity concerning the the (sic) definition of the building blocks of the sensing system. The first examiner asked the representative to submit an improved version of claim 1, in order to overcome said deficiency."

VII. With a letter dated 29 February 2012 the applicant supplied an amended set of claims "clarified as proposed by the Examiner" and expressed the view that it should be possible to cancel the oral proceedings.

VIII. By fax of 13 March 2012 the examining division informed the applicant that the date fixed for oral proceedings was maintained and cited two additional documents:

D4: US 6 750 910 B1 and  
D5: US 2004/0189839 A1.

The examining division objected that the subject-matter of claim 1 was not new in view of D4. It also stated that documents "D4 and D5 will be discussed in the upcoming oral proceedings".

IX. The appellant replied by fax dated 14 March 2012 requesting that a new date for the oral proceedings be set.

X. Oral proceedings were held on 15 March 2012 in the absence of the applicant. The examining division rejected the request for postponement of the oral proceedings and refused the application for the sole

reason that the subject-matter of claim 1 lacked novelty in view of D4. The examining division argued with respect to the request for postponement of oral proceedings that "the applicant had been informed of the introduction of the new documents one working day in advance of the set date of the oral proceedings. In consideration of the content of documents D4 and D5 the examining division was of the opinion that the time at the disposal of the applicant had been sufficient for a thorough consideration of the documents. Hence, the applicant could not be possibly surprised by this decision", see decision under appeal, Reasoning, point 2.

- XI. The applicant appealed against this decision and requested with the statement setting out the grounds of appeal that the decision under appeal be set aside. The appellant maintained the set of claims underlying the decision under appeal as a main request and filed an amended set of claims as an auxiliary request. The appellant also requested refund of the appeal fee "in view of the very late citation of new references".

The appellant argued *inter alia* that in its reasoning with respect to lack of novelty of the subject-matter of claim 1 the examining division had conflated the written explanations of D4 with figure 4 of D4 which illustrated "prior art".

- XII. In a communication according to Rule 100(2) EPC, the board indicated that it tended to share the appellant's opinion that the subject-matter of claim 1 according to the main request was new in view of D4 and that in the present case rejecting the request for postponement of oral proceedings constituted a substantial procedural

violation which justified reimbursement of the appeal fee (Article 113(1) EPC 1973 and Rule 67 EPC 1973).

XIII. In reply the appellant withdrew its request for oral proceedings. The appellant's final requests are that the decision under appeal be set aside and that a patent be granted according to the claims underlying the decision under appeal (claims 1 to 7 filed on 29 February 2012) or, as an auxiliary request, according to claims 1 and 2 submitted with the statement of grounds and dependent claims 3 to 7 filed on 29 February 2012. The appellant also requests a refund of the appeal fee.

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

"An image sensing system (10), comprising:  
a substrate (16);  
an image sensor (12) including a detector array (18) having masked and unmasked pixels (20) on said substrate (16);  
a system controller (40) on said substrate (16); and a black clamp circuit (14) on said substrate (16), wherein the image sensor (12), pixels (20) and the black clamp circuit (14) are all directly connected to said system controller (40) and directly managed by the system controller (40) to continuously stabilize and maintain an accurate black reference signal for said image sensor (12) using reference data supplied by said masked pixels, wherein said black clamp circuit (14) further comprises  
a differential amplifier (26) connected to produce an error signal corresponding to the difference between an analog masked signal produced by said image sensor (12) and said black reference signal,

an analog-to-digital converter (32) connected to convert said error signal to a digital format; and a black clamp correction circuit which adjusts said black reference signal based upon the difference between said digital error signal and an error reference, and wherein said image sensor (12) is configured to produce an image signal and is connected to said differential amplifier (26) to compare said image signal to said black reference signal and produce a normalized image signal, and said analog-to-digital converter (32) is connected to convert said normalized image signal to a digital format; and an output interface (36) is connected to produce an output signal in response to said normalized digital image signal."

The dependent claims 2 to 7 as well as the claims of the auxiliary request have no bearing on the present decision.

### **Reasons for the Decision**

1. The appeal is admissible.

*Novelty, Article 54(1) and (2) EPC 1973*

2. The finding of lack of novelty of the subject-matter of claim 1 in the decision under appeal is based on D4.

- 2.1 The introductory passage of claim 1 reads "An image sensing system (10) comprising: **a substrate** (16); an image sensor (12) including a detector array (18) having masked an unmasked pixels (20) **on said substrate** (16); a system controller (40) **on said substrate** (16); and a black clamp circuit (14) **on said substrate** (16) ..." (emphasis added by the board).

Hence according to claim 1 all these components of the image sensing system are located on a common substrate. This interpretation of claim 1 is in line with the description (see page 2, lines 7 to 11; page 3, lines 10 to 16; page 8, lines 20 to 22) and the title of the application.

2.2 Neither the passages cited by the examining division in the decision under appeal (see section "Reasoning", point 1) nor any other passage in D4 refers to a common substrate for the different components of the image sensing system shown in figure 4. This feature is also not implicit in D4 because the provision of a readout circuit and a system controller as integrated circuits separate from a CCD are not uncommon (see also present application, page 1, lines 25 to 27). Hence, the subject-matter of claim 1 is new at least for this reason with respect to the disclosure of D4 (Article 54(1) and (2) EPC 1973). In view of this finding it is not necessary for the purpose of the review of the decision under appeal to analyse whether a black clamp correction circuit within the meaning of claim 1 is disclosed in D4.

2.3 The decision of the examining division was exclusively based on lack of novelty with respect to D4. It follows that the decision under appeal cannot be upheld by the board.

*Reimbursement of the appeal fee*

3. In reply to the citation by the examining division of two new documents on 13 March 2012, the appellant submitted in the fax of 14 March 2012, i.e. one day prior to the oral proceedings before the examining division, that "in view of the very late citation of



new references" it was "simply impossible to study the newly cited prior art D4 and D5 and get appropriate instructions from the US-client (via a US-law firm) within this extremely short time of one working day". The appellant therefore requested to "set a new date for the hearing", "to give all parties ... sufficient time to review newly cited documents and discuss/prepare proper amendments", see statement of grounds and letter of 14 March 2012.

- 3.1 Given these facts, the board considers it necessary to examine whether the appellant's right to be heard was violated because the subject of the proceedings had changed shortly before the date set for the oral proceedings and whether the examining division should have cancelled these proceedings and fixed a new date for them.
- 3.2 Under Article 113(1) EPC 1973, decisions may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The applicant therefore has the right to react to objections raised by the examining division. This can be done by providing comments or by amending requests in order to take into account the objection raised by the division.
- 3.3 Rule 71a(1) EPC 1973 (corresponding to Rule 116(1) EPC) specifies that, when issuing the summons to oral proceedings, the EPO shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings shall be fixed. New facts and evidence presented after that date need not be considered, unless admitted on the grounds that

the subject of the proceedings has changed (see also German and French versions of Rule 116(1) EPC: "soweit sie nicht wegen einer Änderung des dem Verfahren zugrunde liegenden Sachverhalts zuzulassen sind", "à moins qu'il ne convienne de les admettre en raison d'un changement intervenu dans les faits de la cause.") This provision has to be interpreted in the light of Article 113(1) EPC 1973 so as to give the applicant an opportunity to submit comments or, if necessary, make amendments to its requests in view of the points to which the EPO drew attention. This principle is also reflected in the Guidelines for Examination, E-III 8.6, in the version of April 2010, stating that the parties "should always be given the opportunity to submit amendments intended to overcome objections raised by the Division which depart from a previously notified opinion."

- 3.4 In the present case (see points IV to X above) the examining division summoned to oral proceedings indicating that claims 1 and 15 lacked clarity and that the subject-matter of these claims lacked novelty in view of D3. Following the submission of amended claims a telephone consultation took place, the results of which were communicated to the appellant and read as follows:

"The first examiner informed the representative that the current claim 1 lacked clarity concerning the the (sic) definition of the building blocks of the sensing system. The first examiner asked the representative to submit an improved version of claim 1, in order to overcome that deficiency."

The appellant could therefore conclude that the objection with respect to lack of novelty in view of D3

had been overcome and that only clarity would have to be discussed in the oral proceedings.

As a consequence, the appellant submitted amended claims asserting that they were "clarified as proposed by the Examiner" and expressed the view that it should be possible to cancel the oral proceedings. Two days before the oral proceedings the examining division informed the appellant that the date for oral proceedings was maintained, introduced two additional documents D4 and D5 into the procedure, and objected that the subject-matter of claim 1 was not new in view of D4. The next day, the appellant requested postponement of the oral proceedings in view of this new objection.

The board notes that the new objection was not related to any of the points which had been indicated in the summons. In particular, a discussion of novelty based on D4 could not be expected after amendments had been filed and discussed in the telephone interview. Hence, the subject of the oral proceedings had changed.

- 3.5 Under these circumstances, the appellant should have been given an adequate opportunity to react to the new objection either by submitting comments or by amending its requests.
- 3.6 The examining division's argument that the appellant had sufficient time for a thorough consideration of D4 and D5 and that the appellant could not possibly be surprised by this decision is not convincing. The representative was given one working day to get acquainted with D4 and D5, contact its client and - if necessary - provide amendments overcoming the objections. The board accepts the argument of the

appellant's representative that it was impossible in view of the short timeframe to get appropriate instructions from the client.

3.7 The board notes that the appellant's representative deliberately chose not to attend the oral proceedings on 15 March 2012. He also repeatedly expressed in writing the wish to avoid oral proceedings. Procedural economy and legal certainty for third parties require that an applicant should not be allowed to prevent an examining division from carrying out the examination in an efficient manner, for instance by delaying the decision or postponing the oral proceedings (see also Rule 71(2) EPC 1973 corresponding to Rule 115(2) EPC). However, the circumstances of the present case are exceptional, because two days before the date of the oral proceedings the examining division changed essential facts of the case on which it had relied in the summons to oral proceedings. Attending the oral proceedings would not have changed the fact that, in the present case, the timeframe of one working day was too short for the appellant to get appropriate instructions and to prepare for oral proceedings which now had a new focus.

3.8 Hence, rejecting the appellant's request for a postponement of the oral proceedings infringed the appellant's right to be heard. Had the appellant been given sufficient time to react to the new objection, the examining division, in dealing with the appellant's arguments, could have explained the reasons why it was of the opinion that the different references to D4 did not constitute a conflation of prior-art embodiments with the embodiments of the invention and why the schematic drawing of figure 4 in D4 did disclose the arrangement of the components on a common substrate.

This exchange of arguments could have avoided the necessity to file an appeal, or would have permitted the board to examine the case in full knowledge of the first instance's view on the contentious issues.

- 3.9 As a result the board considers reimbursement of the appeal fee to be equitable by reason of a substantial procedural violation (Rule 67 EPC 1973).

*Remittal*

4. Article 11 of the RPBA (see Supplement to the OJ EPO 1/2013, page 38) provides that a case shall be remitted to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise.

In the present case there are no such special reasons. It is also noted that the examining division exclusively based its decision on lack of novelty with respect to D4. An examination with respect to inventive step of the claimed subject-matter in view of D4 and D5 still has to be carried out.

## 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.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated