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**Datasheet for the decision
of 25 January 2016**

Case Number: T 0203/15 - 3.4.03

Application Number: 08161123.8

Publication Number: 2037327

IPC: G03G15/08

Language of the proceedings: EN

Title of invention:
Image forming apparatus and the use of a developing device

Patent Proprietor:
Samsung Electronics Co., Ltd.

Opponent:
ABACUS Patentanwälte

Headword:

Relevant legal provisions:
EPC Art. 113(1), 114(2)
EPC R. 103(1)(a)

Keyword:
Substantial procedural violations (yes)

Decisions cited:
G 0003/14, T 0640/91

Catchword:



**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 0203/15 - 3.4.03

**D E C I S I O N
of Technical Board of Appeal 3.4.03
of 25 January 2016**

Appellant: ABACUS Patentanwälte
(Opponent) Lise-Meitner-Strasse 21
72202 Nagold (DE)

Representative: Isarpatent
Patentanwälte Behnisch Barth Charles
Hassa Peckmann & Partner mbB
Friedrichstrasse 31
80801 München (DE)

Respondent: Samsung Electronics Co., Ltd.
(Patent Proprietor) 129, Samsung-ro
Yeongtong-gu
Suwon-si, Gyeonggi-do, 443-742 (KR)

Representative: Appleyard Lees
15 Clare Road
Halifax HX1 2HY (GB)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
26 November 2014 concerning maintenance of the
European Patent No. 2037327 in amended form.**

Composition of the Board:

Chairman G. Eliasson
Members: R. Bekkering
T. Bokor

Summary of Facts and Submissions

- I. The appeal of the opponent is directed against the interlocutory decision of the opposition division to maintain European patent EP 2 037 327 in amended form.
- II. The opposition was filed against the patent as a whole. The grounds for opposition invoked were lack of novelty and lack of inventive step, Articles 100(a), 52(1), 54 and 56 EPC, and that the invention was not disclosed in a sufficiently clear and complete manner, Article 100(b) EPC.
- III. The appellant opponent requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

Moreover, reimbursement of the appeal fee was requested by reason of a plurality of substantial procedural violations of the opposition division (Rule 103(1)(a) EPC).

- IV. The respondent patent proprietor requested that

Main request:

the appeal be dismissed and the patent be maintained in amended form in accordance with the interlocutory decision of the opposition division,

First to fourth auxiliary request:

the patent be maintained in amended form in accordance with the first to fourth auxiliary requests filed with the reply dated 27 August 2015.

- V. A communication pursuant to Rule 100(2) EPC was issued by the board, in which a provisional opinion of the board was provided on the alleged substantial procedural violations by the opposition division and the appellant's request for reimbursement of the appeal fee.

The board noted that it appeared that the appellant's right to be heard had been infringed, which was considered a substantial procedural violation, and that accordingly it was minded to remit the case to the opposition division for further prosecution and to order the refund of the appeal fee.

As both parties requested oral proceedings, the parties were invited to state whether oral proceedings before the board, which would only concern the issue of procedural violation and remittal for this reason, should take place.

- VI. Both parties confirmed that they did not wish to be heard in oral proceedings before the board on these issues.

- VII. Claim 1 as maintained in amended form reads:

"Use of a developing device with an image forming apparatus (1), the developing device (100) comprising: a driving force reception unit (160) disposed at one side of the developing device (100) to receive a driving force from the image forming apparatus (1); and a power reception unit (170) disposed at an other side to receive an electric power from the image forming apparatus (1);

further comprising a memory unit (180) disposed at a rear end (101) of the developing device (100) with respect to a direction of mounting of the developing device (100) during mounting thereof to a main body (10) of the image forming apparatus (1); wherein the memory unit (180) is disposed closer to the power reception unit (170) than to the driving force reception unit (160); characterised by comprising a developing roller (140) disposed at a front end of the developing device (100) with respect to the direction of mounting of the developing device (100)."

VIII. Reference is made to the following labelling of the features defined by claim 1 as maintained in amended form used in the decision under appeal (cf point 8):

OA developing device for an image forming apparatus (use thereof)

OB a driving force reception unit disposed at one side of the developing device to receive a driving force from the image forming apparatus

OC a power reception unit disposed at an other side to receive an electric power from the image forming apparatus

"rear side feature":

OD a memory unit disposed at a rear end of the developing device with respect to a direction of mounting of the developing device during mounting thereof to a main body of the image forming apparatus

"closer feature":

OE the memory unit is disposed closer to the power reception unit than to the driving force reception unit

"developing roller feature":

OF a developing roller disposed at a front end of the developing device with respect to the direction of mounting of the developing device

IX. Reference is made in this decision to the following documents:

E1: EP 1 621 942 A

E5: US 2007/0189781 A

E8: US 2005/0078978 A

E10: US 7 082 276 B

O1: Collection of web pages

pages 1, 2, 11, 12, 13, 14:

www.tecchannel.de/pc_mobile/news/1728125/samsung_drucker_in_klavierlack_optik.html;
www.tecchannel.de/bild-zoom/1728125/1/360717/il-77915687756771303/;

pages 3, 4, 5:

www.chip.de/news/Multifunktionsgeraet-in-schwarzem-Klavierlack_28621254.html

pages 6, 7, 8:

www.chip.de/produkte/Samsung-ML-1630_28630891.html

pages 9, 10, 15:

www.tecchannel.de/produkte/pc-mobil/drucker/samsung-ml-1630.html; www.tecchannel.de/_misc/galleries/detail.cfm?pk=32181&fk=2141103

pages 16, 17:

www.samsung.com/in/news/presskit/samsung-transforms-the-printer-into-a-refined-work-of-art

- O2: Collection of pictures of a printer SAMSUNG ML-1631
 - O3: Collection of pictures of a printer SAMSUNG SCX-4501K
 - O4: Purchase receipts for printer models SAMSUNG ML-1631K and SCX-4501K
 - O5: Collection of different documents
 - O5a: User manual for HP LaserJet HP1000 and HP1500 Series from Hewlett Packard;
 - O5b: Two page document relating to a "toner cartridge" CB435A, anonymous;
 - O5c: Document relating to a "toner cartridge" CB435A from SUMMIT Technologies, published by www.summitechnologies.com (2007)
 - O6: Sworn affidavit from Hui Jin, dated 25.07.2013.
- X. The appellant opponent submitted, as far as relevant to this decision, in substance the following arguments:

The request for reimbursement of the appeal fee was reasoned by various major substantial procedural violations committed by the first instance, which formed the "fundamental basis" of the decision under appeal.

A first major procedural violation was that the opposition division had completely disregarded the clarity and interpretation objections of the opponent regarding the use claim category and feature category of claims 1 and 9, as amended during opposition proceedings. Moreover, amendments during opposition introduced additional feature OF in granted claims 1 and 9 allegedly taken from the description. Thus, a clarity check of at least this additional feature OF was completely justified.

A second major procedural violation was that the opposition division incompletely dealt with the opponent's Article 123(2) EPC objection, which referred to features OD and OF. Paragraph 11.1 of the decision under appeal only dealt with feature OF and recited the wording of Article 84 EPC - not of Article 123 (2) EPC: *"The amendments made by the Patentee in the main request do not contravene the requirements of Article 123(2) EPC, since [the amended features] are sufficiently clear and supported by the patent specification"*. The decision under appeal was thus not based on the correct legal basis and the correct tests had not been performed.

A third major procedural violation was that the opposition division did not correctly execute their discretion regarding late filing of the evidence regarding the printer SCX 4501K, corresponding to documents O1 to O3. The printer, which was available

during the oral proceedings, was not admitted as evidence, because the opposition division was of the opinion that *prima facie* no additional information was considered to be expected therefrom, without presenting any reasoning in this respect.

A fourth major procedural violation was that the opposition division did not sufficiently analyse document E5 regarding features OE and OF where the table on page 10 of the decision under appeal merely stated "*unclear*". Thus, it remained open, if these features OE and OF were present in document E5.

A fifth major procedural violation was that the opposition division did not correctly analyse the question of an inventive step. Under paragraph 14 of the decision under appeal only an analysis of missing features was provided. No analysis of the technical contribution and effects of the missing features to the alleged technical object had been made. No problem-solution approach was provided. Merely, a technical object was vaguely defined.

XI. The respondent patent proprietor argued, as far as relevant to this decision, in substance as follows:

There were no substantial procedural violations, contrary to the submission of the appellant.

Regarding the alleged first major procedural violation, the opponent's objection that the clarity and interpretation of the claim was not properly undertaken by the opposition division was unfounded. Clarity was not a valid ground of opposition and so the claims of the main request were not open to the opponent's objections along the lines of clarity, as well as

"*interpretation*". However, the opposition division properly and correctly addressed the issue of clarity of amendments made to the granted claims in the main request in paragraphs 11 and 12 of the decision under appeal.

The opponent's reference to a second major procedural violation was also unfounded. Again, these matters were properly dealt with in sections 11 and 12 of the appealed decision.

The third major procedural violation referred to by the opponent related to the admission of evidence labelled O1 to O3. The opponent was incorrect in submitting that these documents were not admitted. The documents were admitted, despite being late filed documents, and the documents were considered in section 13.1 of the appealed decision. The opposition division correctly decided that there was insufficient disclosure in documents O1 to O3 to deny novelty from the claims of the main request.

The opponent's fourth major procedural violation objection was based on the analysis of document E5, in particular the opposition division's reference to features OE and OF in claim 1 being marked as unclear. The opposition division decided that there was no clear disclosure of the features OE and OF in D5, leading to the reference to those parts being unclear. If there was no clear and unambiguous disclosure of a feature then it could not be said to be present and so could not be taken into account in relation to E5. Consequently, the opposition division had decided correctly in this respect, because those features were not clearly evident from E5.

The opponent's fifth major procedural violation objection was based on the application of the problem and solution approach to inventive step by the opposition division. Section 14 of the decision gave a proper assessment of inventive step.

Reasons for the Decision

1. The appeal is admissible.
2. *Request for reimbursement of appeal fee*
 - 2.1 The appellant has requested the reimbursement of the appeal fee by reason of a plurality of substantial procedural violations of the opposition division (Rule 103(1) (a) EPC).

The appellant essentially argued that the opposition division in its decision:

1. incompletely dealt with clarity and interpretation objections,
2. incompletely dealt with Article 123(2) EPC objections,
3. incorrectly applied their discretion when not admitting the printer SCX-4501K (as late-filed) evidence at the oral proceedings,
4. insufficiently analysed document E5 regarding features OE and OF, and

5. incorrectly analysed the question of inventive step and did not apply the problem-solution approach.

2.2 *Alleged first substantial procedural violation*

According to the appellant, the opposition division in its decision incompletely dealt with the appellant's clarity objections raised against the amended claims and incompletely dealt with the appellant's argument that since claim 1 was directed at the use of a developing device, all device features should be disregarded.

As to the first point, in its letter of 19 September 2014 (cf point C) the appellant raised a clarity objection under Article 84 EPC against the added feature (feature OF) in claim 1 of the main request.

In the decision under appeal in paragraph 12.2, the opposition division found with respect to feature OF (and features OD and OE) that the mounting direction, the position of the developing roller at the "*front end*" and the position of the memory at the "*rear end*" were seen as being clear per se.

Accordingly, the decision deals with the clarity of feature OF, albeit under insufficient disclosure, Article 100(b) and Article 83 EPC rather than Article 84 EPC. Although incorrect, this has no implications on the procedure and is, therefore, not seen to constitute a substantial procedural violation in the present case.

As to the second point, the appellant indeed extensively argued in the opposition proceedings that as claim 1 was directed at the use of a developing

device, all device features should be disregarded when assessing novelty and inventive step.

The decision, however, nowhere mentions this argument and fails to provide any reasoning refuting it.

The respondent argued that the appellant's objection that the clarity and interpretation of the claim was not properly undertaken by the opposition division was unfounded. Clarity was not a valid ground of opposition and so the claims of the main request were not open to the opponent's objections along the lines of clarity, as well as "interpretation".

It is, however, noted that, as feature OF has been added to claim 1 as granted, it is open to a clarity objection under Article 84 EPC 1973 in opposition proceedings, as confirmed in the decision of the Enlarged Board of Appeal G 3/14. Moreover, the interpretation issues raised by the opponent, in particular those concerning the effect of apparatus features in a use claim, insofar as already present in the claims as granted and thus not being objectionable under Article 84 EPC 1973, should have been considered for novelty and inventive step as argued by the appellant.

As noted above, however, the decision fails to address this argument, which forms an important element of the appellant's case. The Board holds that this deficiency constitutes a violation of the opponent's right to be heard under Article 113(1) EPC (see also "Case Law of the Boards of Appeal of the EPO" (CLBA) 7th Edition 2013, Chapters III.B.1.1.1 and III.B.1.3.9).

Since the provision of Article 113(1) EPC represents a fundamental procedural principle in proceedings before the EPO ensuring the right of a party to the proceedings to be heard before an adverse decision is issued, its breach amounts to a substantial procedural violation.

2.3 *Alleged second substantial procedural violation*

The appellant, moreover, argued that the opposition division in its decision incompletely dealt with the Article 123(2) EPC objections raised concerning features OD and OF in the letter of 26 September 2014, page 3, last paragraph.

Indeed, the appellant here argued that notably regarding the "*direction of mounting*" in feature OF, only a more specific mounting in a direction A was disclosed while referring to the patent, paragraphs [0023], [0035] and [0053]). Accordingly, an undue broadening was seen in this respect.

Yet, as argued by the appellant, in the decision under appeal, under the header "*Amendments, Article 123(2) EPC*" it is held that "*The amendments made by the Patentee in the main request do not contravene [sic] the requirements of Article 123(2) EPC, since the amended "developing roller feature" OF and the definition of an insert or mounting direction as well as the definition of a rear end and front end portion are sufficiently clear and supported by the patent specification, e.g. in par. 23,28,30,35,53 and the figures*" (cf point 11.1).

Although inaccurate, the expression "*supported by the patent specification*" arguably may be understood in the

present case to mean having a disclosure basis in the application as filed. However, the objection raised of undue broadening, which in fact concerns an inadmissible intermediate generalisation, is not mentioned at any point and is not refuted in the decision.

Accordingly, also in this respect the decision fails to address an important element of the appellant's case, which constitutes a violation of Article 113(1) EPC, as explained above.

Again, the breach of the opponent's right to be heard amounts to a substantial procedural violation.

2.4 Alleged third substantial procedural violation

The appellant furthermore argued that the opposition division incorrectly applied their discretion when not admitting the printer SCX-4501K as late-filed evidence at the oral proceedings.

A Samsung printer SCX-4501K, presumably corresponding to the one brought by the appellant to the oral proceedings before the opposition division, was offered as evidence by the appellant for the first time with its letter of 19 September 2014, well after expiry of the opposition period, well after receiving the summons to oral proceedings and only a month before the scheduled oral proceedings.

The appellant argued that the evidence corresponded to documents O1 to O3 already on file.

Documents presenting a device, such as pictures, brochures, technical drawings or specifications etc.,

however, are not equivalent to the physical device itself. For example, each of such pieces of evidence may have a different extent of discernible technical information and/or date on which it was made available to the public.

The considerations on late filed evidence are conceived to prevent the parties and the office to be confronted with facts or information adduced by the evidence without having sufficient time to deal with them, as well as to bring the procedure to an end within a reasonable time. Clearly, to fulfil this role these considerations must be applied anew to each piece of evidence submitted, even if the different evidence relates to one and the same device as in the present case. In fact it is plain that the pictures provided of the printer in document O3, on which, as rightly pointed out by the opposition division, no cartridge is visible, cannot be equated with submitting the printer itself as evidence, which presumably can be opened and provide eg details of the cartridge inside. If the appellant had wished to rely on the printer with cartridge itself as evidence, it should have done so by eg submitting the printer or offering an inspection thereof at an early procedural stage.

Accordingly, the opposition division was correct in considering the printer itself offered for inspection at the oral proceedings late-filed evidence to be admitted into the proceedings at its discretion, in accordance with Article 114(2) EPC.

According to established jurisprudence of the boards of appeal, if the way in which a department of first instance has exercised its discretion on a procedural matter is challenged in an appeal, it is not the

function of a board of appeal 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 the department of first instance. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion 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 (cf CLBA, 7th edition 2013, IV.E.3.6).

In exercising its discretion, the opposition division argued that the printer model the opponent wished to present during the oral proceedings appeared to correspond to documents O1, O2 and O3 already on file. Prima facie no additional information was considered to be expected therefrom.

Having regard to document O1, in the decision under appeal the opposition division held that "*Document O1 collects a number of web pages with different views of a printer, namely of a SAMSUNG ML-1630, ML-1630W and a SCX-4500. Page 1 shows the ML-1630 with a printer cartridge provided with an unidentified structure on the cartridge side surface. This could be either driving force transmission means or electrical power reception means or both. Page 15 shows the ML-1630 with an inserted printer cartridge. Document O1 does not show a cartridge memory unit and does not show the "developing roller feature" OF*" (cf Reasons, point 13).

Having regard to document O2, it held that "*Document O2 shows a number of different pictures of a printer ML-1631K and a printer cartridge. A label seems to refer to a printer manufacturing date of 26.02.2008. A*

driving force transmission means on a side surface of the cartridge is shown in picture 5. Another structure, probably electrical power reception means, is shown in picture 4 on the the [sic] opposite side surface of the cartridge. A further structure on the top surface has been marked by the Opponent as a memory unit. The mounting direction of the cartridge is apparently downward. The main body cover is on the top of the printer. Document O2 does not unambiguously show a cartridge memory unit or a electrical power reception means and does not show the "developing roller feature" OF".

Finally, regarding document O3 it held that "Document O3 shows a closed printer SCX-4501K which seems to be manufactured on 11.09.2007. No cartridge is visible".

In fact, it would appear that only document O3 directly relates to the printer offered for inspection at the oral proceedings.

The opposition division, thus, was unable to clearly discern from documents O1, O2 and O3, and insofar as these documents actually concerned the printer model SCX-4501K offered for inspection at the oral proceedings, the alleged features, notably the driving force transmission means, the electrical power reception means, the cartridge memory unit, the mounting direction of the cartridge and the arrangement of the developing roller.

Clearly, at least for a number of these alleged features, an inspection of the printer and in particular of the cartridge therein, if any, could have provided certainty about whether these features were present in the cartridge and printer or not.

Accordingly, the opposition division erred when arguing that from the printer model SCX-4501K offered for inspection at the oral proceedings "*prima facie no additional information is considered to be expected therefrom*" and exercised its discretion in an unreasonable way.

This may, depending on the circumstances, constitute a substantial procedural violation. In T 640/91, for example, the exercise of discretion in an unreasonable way, taking into account the wrong principles was found to constitute a substantial procedural violation (OJ EPO 1994, 918, point 9 of the Reasons). However, in the present case the exercise of discretion of the opposition division arguably is merely based on an error of judgement, in that the conclusions drawn from the evaluation of facts are manifestly illogical. This is normally not considered a substantive procedural violation (see CLBA, IV.E.8.3.5).

However, in view of the other two established substantial procedural violations, the board considers that it need not be decided for the purposes of the present decision whether this third objection of the appellant also qualifies as a substantial procedural violation.

It is noted in this context, that if the opposition division was of the opinion that the late filed evidence by means of the offered inspection of the printer at the oral proceedings was irrelevant to the case, in particular to the issue of novelty and inventive step, and the statement concerning the assessment of inventive step that "*The documents 01-06 are prima facie less relevant for that purpose and are*

also considered not for an inventive step, since it appears that they only disclose process cartridges which are similar to those disclosed by E1, E8 or E10", would appear to suggest so, it could and should have based its discretionary decision to disregard this evidence on this ground (cf decision, Reasons, point 14.1.2).

2.5 Alleged fourth and fifth substantial procedural violations

Having regard to the alleged fourth and fifth substantial procedural violation, although the board agrees that in an assessment of inventive step, the finding that it is "unclear" whether a particular claimed feature is to be found in a document may be seen as unduly unspecific, it would appear clear from the subsequent reasoning in the decision that these feature were accordingly not considered to be known from document E5.

Moreover, the board agrees that the failure to adopt the problem-solution approach when assessing inventive step is problematic, in particular since in the absence of a clearly defined problem to be solved it becomes difficult to objectively judge whether the distinguishing features provide a non-obvious solution.

Indeed since the appellant has contested that the alleged vibration problem would be solved by the claimed positioning of the memory unit, it would have been appropriate to determine whether the claimed positioning of the memory unit solved this problem, or any other problem, or did not solve any problem and was thus merely arbitrary. This shortcoming, however, in

the board's view cannot be considered a substantial procedure violation in the present case.

2.6 In summary, at least in the first and second alleged substantial procedural violations brought forward by the appellant and discussed above, the board sees the appellant's right to be heard under Article 113(1) EPC being infringed, and to an extent that potentially could have affected the outcome of the proceedings in substance.

Since the provision of Article 113(1) EPC represents a fundamental procedural principle in proceedings before the EPO, each breach amounts to a substantial procedural violation.

For the above reasons, the board remits, in accordance with Article 11 RPBA, the case to the department of the first instance under Article 111(1) EPC for further prosecution.

The appeal fee is to be reimbursed in accordance with Rule 103(1)(a) EPC, since the appeal is considered allowable to the extent that the decision under appeal is set aside as requested and the reimbursement is equitable by reason of the substantial procedural violations.

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 reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated