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Datasheet for the decision of 11 August 2021

Case Number: T 2556/18 - 3.5.05

Application Number: 06010204.3

Publication Number: 1724672

IPC: G06F3/048

Language of the proceedings: EN

Title of invention:
Data processing setting apparatus, data processing setting method, data processing setting program, and computer-readable recording medium recording the program

Applicant:
K. Mizra LLC

Headword:
Print processing setting apparatus / Mizra

Relevant legal provisions:
EPC Art. 123(2)
EPC R. 103(4)(c)
RPBA 2020 Art. 12(2), 11

Keyword:

Amendments - added subject-matter (Main request: yes) - added subject-matter (Auxiliary request: no)
Remittal - special reasons for remittal
Reimbursement of appeal fee - (yes at 25%)

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Beschwerdekammern

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Case Number: T 2556/18 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 11 August 2021

Appellant: (Applicant)	K. Mizra LLC 2160 Century Park East, No. 707 Los Angeles, CA 90067 (US)
Representative:	Bosch Jehle Patentanwaltsgesellschaft mbH Flüggenstraße 13 80639 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 29 May 2018 refusing European patent application No. 06010204.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair	A. Ritzka
Members:	N. H. Uhlmann
	D. Prietzel-Funk

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division refusing European patent application No. 06010204.3, which was filed on 17 May 2006.

II. The examining division decided that the main request and auxiliary request 1 did not satisfy the requirements of Article 123(2) EPC. Auxiliary request 2 was not admitted into the proceedings.

III. In its statement setting out the grounds of appeal, the appellant submitted an amended main request and also amended auxiliary requests 1 to 3. Furthermore, the appellant requested reimbursement of the full appeal fee, on the basis that the examining division had committed a procedural violation, and remittal to a different examining division.

IV. The board summoned the appellant to oral proceedings.

V. In a communication pursuant to Article 15(1) RPBA 2020, the board set out its provisional view of the case. The board also noted that it did not see a procedural violation, so the appeal fee was not likely to be reimbursed.

VI. With a letter dated 19 October 2020, the appellant submitted an amended main request, an amended auxiliary request and comments on the provisional view of the board.

VII. The board issued a communication dated 28 October 2020 in which it addressed the appellant's submission dated 19 October 2020.

VIII. As indicated in the communication of the legal division dated 13 January 2021, transfer of the application in suit to the present appellant K. Mizra LLC had taken effect on 10 November 2020.

IX. With its letter dated 10 November 2020, the appellant referred to the board's communication dated 28 October 2020 and withdrew the request for oral proceedings. Furthermore, it requested a written decision and, rather than full reimbursement, partial reimbursement of the appeal fee.

X. The board cancelled the oral proceedings.

XI. The European patent attorney Dr Thomas Hell indicated by letter of 20 January 2021 that the BoschJehle Patentanwaltsgesellschaft mbH was taking over representation in the present case. He referred to the previous letter, dated 10 November 2020.

XII. In its communication dated 23 February 2021, the board noted that a new appellant / applicant K. Mizra LLC and a new representative BoschJehle Patentanwalts-gesellschaft mbH had been entered in the Register of European Patents, and invited the appellant to confirm the requests submitted with the letter referred to in section IX. above.

XIII. The appellant confirmed these requests with a letter dated 11 March 2021.

XIV. The appellant's final request was that the decision under appeal be set aside and a patent be granted on the basis of the main request or, alternatively, of the auxiliary request submitted with the letter dated 19 October 2020. The appellant also requested partial reimbursement of the appeal fee.

XV. Claim 1 of the main request reads:

"A print processing setting apparatus (2) comprising:

display control means (15) for displaying plural kinds of advanced function icons on a setting screen image for generating a print job, each of the plural kinds of advanced function icons indicating a print condition of the print job and being able to be identified by the print condition, wherein a print instruction key for triggering printing according to the generated print job is further displayed on the setting screen image;

input means (12) for receiving input instructions to the print processing setting apparatus (2) by a user;

advanced function setting means (27) for selecting in response to a selection of an advanced function icon by an input instruction received by the input means (12) from plural pieces of advanced function icons among the plural kinds of advanced function icons, which plural pieces of advanced function icons are displayed on the setting screen image, the print condition indicated by the selected advanced function icon, and for setting the selected print condition,

advanced function condition storing means (29) for storing for each print condition set by the advanced function setting means (27) a control number in association with the print condition;

table managing means (23) for storing in a table for each print condition indicated by one of the control numbers stored in the advanced function condition storing means (29) at least a set function icon and an image that shows a result of the respective set print condition,

set function icon display processing means (43) for reading out one of the control numbers and the associated print condition from the advanced function condition storing means (29), for reading out from the table managing means (23), based on the read out control number and print condition, the corresponding set function icon, and for displaying the read out set function icon in a region (C) of the setting screen image, which is different from a region (B) in which the plural kinds of advanced function icons are displayed by said display control means, and that indicates that the read out print condition has been set by said advanced function setting means (27),

resulting image display processing means (28) for displaying a resulting image in a region (D) of the setting screen image, which is different from the region (B) in which the plural kinds of advanced function icons are displayed by said display control means and the region (C) in which the set function icon is displayed by said set function icon display processing means (43), and

wherein said resulting image is obtained by the resulting image display processing means (28) by reading out the control numbers and the associated print conditions from the advanced function condition storing means (29), and the corresponding images that show the result of the respective print conditions from the table managing means (23), and by overlapping the read out images."

XVI. Claim 1 of the auxiliary request reads:

"A print processing setting apparatus (2) comprising:

display control means (15) for displaying plural kinds of advanced function icons on a setting screen image for generating a print job, each of the plural kinds of

advanced function icons indicating an advanced function and its print condition of the print job and being able to be identified by the advanced function and its print condition, wherein a print instruction key for triggering printing according to the generated print job is further displayed on the setting screen image;

input means (12) for receiving input instructions to the print processing setting apparatus (2) by a user;

advanced function setting means (27) for selecting in response to a selection of an advanced function icon by an input instruction received by the input means (12) from plural pieces of advanced function icons among the plural kinds of advanced function icons, which plural pieces of advanced function icons are displayed on the setting screen image, the advanced function and its print condition indicated by the selected advanced function icon, and for setting the selected advanced function and its print condition,

advanced function condition storing means (29) for storing for each advanced function and its print condition set by the advanced function setting means (27) a control number in association with the print condition;

table managing means (23) for storing in a table all advanced functions and their print conditions in association with at least the corresponding control number, a set function icon and an image that shows a result of the respective advanced function and its print condition,

set function icon display processing means (43) for reading out one of the control numbers and the associated print condition from the advanced function condition storing means (29), for reading out from the table managing means (23), based on the read out

control number and print condition, the corresponding set function icon, and for displaying the read out set function icon in a region (C) of the setting screen image, which is different from a region (B) in which the plural kinds of advanced function icons are displayed by said display control means, and that indicates that the read out print condition and the corresponding advanced function have been set by said advanced function setting means (27),

resulting image display processing means (28) for displaying a resulting image in a region (D) of the setting screen image, which is different from the region (B) in which the plural kinds of advanced function icons are displayed by said display control means and the region (C) in which the set function icon is displayed by said set function icon display processing means (43), and

wherein, when said advanced function setting means (27) has set a plurality of advanced functions and their corresponding print conditions, said resulting image is obtained by the resulting image display processing means (28) by reading out the control numbers and the associated print conditions from the advanced function condition storing means (29), and the corresponding images that show the result of the respective advanced functions and their print conditions from the table managing means (23), and by overlapping the read out images."

Reasons for the Decision

1. The present application relates to a print processing setting apparatus and method for selecting print functions (such as stapling or poster printing) and specifying options for the selected functions (such as

one-point or two-point stapling). The selected functions and options are displayed as icons in a dedicated region of the screen. Furthermore, images representing the result of these functions and options (e.g. an image of a sheet of paper with one or two staples) are displayed in another region of the screen.

Admission

2. The board considers that the present requests form a suitable response to the numerous new added-matter objections raised by the board in the communication pursuant to Article 15(1) RPBA 2020. Thus, they are admitted into the proceedings.

Main request

3. Claim 1 of the main request does not meet the requirements of Article 123(2) EPC.

3.1 The board holds that the print conditions belong to, and provide further detail on, the advanced functions, and are not independent of the latter. Thus, there is no basis for claiming a print condition independently of the advanced function to which it belongs.

3.2 The appellant pointed to the first sentence of the second full paragraph on page 89 of the description. This sentence reads:

"Moreover, the table managing section 23 may associate detailed print condition items (detail setting items) of the advanced function with respective control numbers, and manages the detail setting items."

3.3 It argued that this sentence modified the main example of the contents stored by the table managing section illustrated in Figure 4 and thus referred directly to the print conditions, rather than to the advanced functions.

3.4 The board disagrees. The sentence reproduced above clearly states that the detailed print condition items **of the** advanced function may be associated with control numbers. Even if modified control numbers 3a and 3b were indicated in Figure 4 of the application (see appellant's letter dated 19 October 2020, figure on page 3) the control numbers would still refer to the advanced function "STAPLE" **and** the print condition.

3.5 The appellant argued further that in the main example the advanced function storing means 29 did not store a reference to an advanced function, but only a reference to the control number and the print condition for this control number, pointing to page 25, first full paragraph, page 26, first full paragraph and page 27, lines 6 and 7. It submitted that the table managing section 23 operated solely on the control number and the print condition stored by the advanced function storing means 29, referring to page 47, first full paragraph, page 48, second full paragraph and page 49, section headed "Initial Display Processing of Resulting Image". Thus, it argued, only the print conditions were used for the claimed idea of generating an overlapped resulting image indicating the selected print conditions.

3.6 The board is not convinced. In the main example, a control number corresponds to an advanced function (page 25, lines 4 to 10). Furthermore, the advanced function specifies the processing to be performed by the printer ("Staple Function: a function of stapling together a plurality of sheets with a stapler" on page 15, lines 2 and 3) and the print condition provides further detail on this function (one-point or two-point). It is apparent that both pieces of information are needed for generating a resulting image. This is

confirmed by the explanations regarding the resulting image in the second full paragraph on page 26.

3.7 For these reasons, claim 1 as amended does not satisfy the requirements of Article 123(2) EPC.

Auxiliary request

4. Amendments

4.1 The amendments to claims 1 and 2 solve all the added-matter objections that were raised in the decision under appeal and by the board in the communication pursuant to Article 15(1) RPBA 2020.

4.2 In particular, the claims consistently refer to an advanced function and its print condition, as taught throughout the description.

Furthermore, all advanced functions and their print conditions are stored in a table, according to the teaching of Figure 4.

Finally, in claim 9 as filed,the last "wherein" clause refers to a plurality of (advanced) functions.

4.3 Consequently, the requirements of Article 123(2) EPC are met.

5. Patentability

5.1 The inventive merit of the subject-matter of the independent claims was not discussed in the course of the first-instance oral proceedings and was not addressed in the Reasons of the decision under appeal.

5.2 In a section headed "OBITER DICTUM", the examining division set out its opinion on inventive step regarding the then auxiliary request 1.

5.3 The board notes that the opinion did not take into consideration the effects pointed out by the appellant

in its letter dated 9 March 2018, section 4.4. Furthermore, it is not apparent what is meant by the second approach said to be available to the skilled person. Thus, a complete inventive-step analysis has not been carried out.

5.4 Given that the primary object of the appeal proceedings is to review the impugned decision in a judicial manner (Article 12(2) RPBA 2020), the board holds that special reasons present themselves for remitting the case to the examining division, according to Article 11 RPBA 2020.

Procedural issues

6. Reimbursement of the appeal fee

6.1 In its letters dated 10 November 2020 and 11 March 2021, the appellant requested partial reimbursement of the appeal fee. Since it no longer requests full reimbursement of the appeal fee, as it did previously in the statement setting out the grounds of appeal, the board assumes that the appellant no longer alleges that there was a procedural violation, but that the request for partial reimbursement was instead based on the fact that the request for oral proceedings had been withdrawn.

6.2 The board holds that the appeal fee is to be reimbursed at 25% based on Rule 103(4)(c) EPC.

6.3 The requirements of Rule 103(4)(c) EPC are met, for the following reasons.

6.4 The appellant requested oral proceedings in the statement setting out the grounds of appeal.

6.5 This request was withdrawn by letter dated 10 November 2020. Upon an invitation by the board, and within the specified time limit, this withdrawal was confirmed by

letter dated 11 March 2021. At that point, BoschJehle Patentanwaltsgesellschaft mbH had already been entered as representative in the Register of European Patents. Hence, the request for oral proceedings was effectively withdrawn on 10 November 2020.

6.6 The board issued a communication dated 28 October 2020 in which it addressed the appellant's submission dated 19 October 2020, set out observations regarding substantive aspects and stated that "it [could] decide in written procedure and [might] partially reimburse the appeal fee pursuant to new Rule 103(4)(c) EPC if the request for oral proceedings [was] withdrawn and no oral proceedings [took] place".

6.7 The board considers that, in the present case, this communication was issued in preparation for the oral proceedings.

6.8 No oral proceedings took place in the case at hand.

7. Remittal to a different examining division

7.1 In the statement setting out the grounds of appeal, the appellant requested that the case be remitted to a different examining division because of a procedural violation committed by the examining division.

7.2 The appellant did not mention this request in its letter dated 19 October 2020, despite the fact that this letter listed the appellant's requests individually in section A. on page 1. Moreover, no such request was mentioned in the subsequent letters from the appellant.

7.3 Given this situation, the board finds that the request that the case be remitted to a different examining division was no longer pursued by the appellant. This

finding is confirmed by the fact that the appellant is not requesting full reimbursement of the appeal fee.

7.4 The board notes that the question of whether the EPC provides such a possibility at all can be left open. In the case at hand, the board does not see any justification in the submissions of the appellant.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the department of first instance for further prosecution on the basis of the auxiliary request submitted on 19 October 2020.

The appeal fee is reimbursed at 25%.

The Registrar: The Chair:

L. Stridde A. Ritzka

Decision electronically authenticated