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Datasheet for the decision of 24 September 2024

Case Number: T 0080/21 - 3.4.03

Application Number: 18170030.3

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Title of invention:
PROCESS CARTRIDGE AND IMAGE FORMING APPARATUS

Applicant:
CANON KABUSHIKI KAISHA

Headword:

Relevant legal provisions:
EPC Art. 76(1), 111(1)
RPBA 2020 Art. 12(4), 12(6)

Keyword:

Divisional application - extension beyond the content of the earlier application as filed - main request (yes)
Auxiliary request - amendment to case - amendment overcomes objection and circumstances of appeal justify admittance - admitted (yes)
Remittal to the department of first instance

Decisions cited:

Catchword:

Europäisches Patentamt
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Office européen des brevets

Beschwerdekammern

Boards of Appeal

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Case Number: T 0080/21 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 24 September 2024

Appellant: (Applicant)	CANON KABUSHIKI KAISHA 30-2 Shimomaruko 3-chome Ohta-ku Tokyo 146-8501 (JP)
Representative:	TBK Bavariaring 4-6 80336 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 10 July 2020 refusing European patent application No. 18170030.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	T. Häusser
Members:	M. Papastefanou
	E. Mille

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division refusing European patent application 18 170 030 on the ground that claim 1 of the sole request then on file contained subject-matter extending beyond the content of the parent ("earlier") and/or grandparent ("earliest") applications as filed (Article 76(1) EPC).

II. At the end of the oral proceedings before the board, the appellant's (applicant's) final requests were that the decision under appeal be set aside and that a patent be granted upon basis of the claims of the **main request**, which were filed on 18 April 2019 and are underlying the impugned decision.

In the alternative, the appellant requested that a patent be granted upon basis of the claims of the **fifth auxiliary request** filed with the statement of the grounds of appeal. All other auxiliary requests were withdrawn during the oral proceedings before the board.

III. Claim 1 of the **main request** is worded as follows:

A process cartridge (7) detachably mountable to a main assembly (100A) of an electrophotographic image forming apparatus (100), wherein the main assembly (100A) includes a rotatable first main assembly drive transmission member (66) and a rotatable second main assembly drive transmission member (53), said process cartridge (7) comprising:

(i) an electrophotographic photosensitive drum (1);

(ii) a drum unit (26) containing said electrophotographic photosensitive drum (1);

(iii) a developing roller (25) capable of developing an electrostatic latent image formed on said electrophotographic photosensitive drum (1) with a developer;
(iv) a developing unit (4) containing said developing roller (25) and movably connected with said drum unit (26), said developing unit (4) being movable relative to said drum unit (26) between a contact position in which said developing roller (25) contacts said electrophotographic photosensitive drum (1) and a spaced position in which said developing roller (25) is spaced from said electrophotographic photosensitive drum (1);
(v) a drum coupling member (16), provided on one axial end of said electrophotographic photosensitive drum (1), capable of engaging with the first main assembly drive transmission member (66) and transmitting a first rotational driving force to the electrophotographic photosensitive drum (1), when said process cartridge (7) is mounted to the main assembly (100A) of the apparatus (100) along an axial direction of said electrophotographic photosensitive drum (1);
(vi) a shaft coupling member (20) capable of transmitting a second rotational driving force from said second main assembly drive transmission member (53) to the developing roller (25),
characterized in that
said shaft coupling member (20) includes
(vi-i) a driven side engaging portion (21) capable of transmitting the second rotational driving force to said developing roller (25), and
(vi-ii) a driving side engaging portion (23) capable of engaging with the second main assembly drive transmission member

(53) and receiving the second rotational driving force when said process cartridge (7) is mounted to the main assembly (100A) of the apparatus (100), said driving side engaging portion (23) being movable relative to said driven side engaging portion (21) in a direction crossing with the axial direction of said driving side engaging portion (23) such that said driving side engaging portion (23) is capable of transmitting said second rotational driving force to said driven side engaging portion (21) with deviation permitted between an axis (23c5) of said driving side engaging portion (23) and an axis (21c) of said driven side engaging portion (21) with respect to the crossing direction;

said process cartridge further comprises

(vii) a holding portion (11c; 11f; 27) provided on said process cartridge (1) [sic] *at a predetermined position; and*

(viii) an urging member (18) capable of urging said driving side engaging portion (23) in the crossing direction towards said holding portion (11c; 27f) to position said driving side engaging portion (23) such that when said process cartridge (7) enters said main assembly (100A) of the apparatus with said developing unit (4) positioned in the spaced position, the driving side engaging portion (23) is capable of engaging with the second main assembly drive transmission member (53), while the axis (23c5) of said driving side engaging portion (23) is deviated from the axis (21c) of said driven side engaging portion (21) with respect to the crossing

direction.

IV. Claim 1 of the **fifth auxiliary request** has essentially the same wording as claim 1 of the main request, albeit with the features in a different order and an addition in feature (vi) (underlined by the board). The claim has the following wording:

A process cartridge (7) detachably mountable to a main assembly (100A) of an electrophotographic image forming apparatus (100), wherein the main assembly (100A) includes a rotatable first main assembly drive transmission member (66) and a rotatable second main assembly drive transmission member (53), said process cartridge (7) comprising:

(iii) a developing roller (25) capable of developing an electrostatic latent image formed on an electrophotographic photosensitive drum (1) with a developer;

(iv) a developing unit (4) containing said developing roller (25) and movably connected with said drum unit (26), said developing unit (4) being movable relative to a drum unit (26) between a contact position in which said developing roller (25) contacts said electrophotographic photosensitive drum (1) and a spaced position in which said developing roller (25) is spaced from said electrophotographic photosensitive drum (1); and

(vi) a shaft coupling member (20)<u>, provided on one axial end of said developing roller (25),</u> capable of transmitting a second rotational driving force from said second main assembly drive transmission member (53) to the developing roller (25),

characterized in that

said process cartridge (7) is detachably mountable to the main assembly (100A) of the electrophotographic imaging forming apparatus (100) and comprises

(i) said electrophotographic photosensitive drum (1);

(ii) said drum unit (26) containing said electrophotographic photosensitive drum (1); and

(v) a drum coupling member (16), provided on one axial end of said electrophotographic photosensitive drum (1), capable of engaging with the first main assembly drive transmission member (66) and transmitting a first rotational driving force to the electrophotographic photosensitive drum (1), when said process cartridge (7) is mounted to the main assembly (100A) of the apparatus (100) along an axial direction of said electrophotographic photosensitive drum (1); and

wherein said shaft coupling member (20) includes

(vi-i) a driven side engaging portion (21) capable of transmitting the second rotational driving force to said developing roller (25), and

(vi-ii) a driving side engaging portion (23) capable of engaging with the second main assembly drive transmission member (53) and receiving the second rotational driving force when said process cartridge (7) is mounted to the main assembly (100A) of the apparatus (100), said driving side engaging portion (23) being movable relative to said driven side engaging portion (21) in a direction crossing with the axial direction of said driving side engaging portion (23) such that said driving side engaging portion (23) is capable of transmitting said second

rotational driving force to said driven side engaging portion (21) with deviation permitted between an axis (23c5) of said driving side engaging portion (23) and an axis (21c) of said driven side engaging portion (21) with respect to the crossing direction;

said process cartridge further comprises
(vii) a holding portion (11c; 11f; 27f) provided on said process cartridge (1) [sic] *at a predetermined position; and*
(viii) an urging member (18) capable of urging said driving side engaging portion (23) in the crossing direction towards said holding portion (11c; 27f) to position said driving side engaging portion (23) such that when said process cartridge (7) enters said main assembly (100A) of the apparatus with said developing unit (4) positioned in the spaced position, the driving side engaging portion (23) is capable of engaging with the second main assembly drive transmission member (53), while the axis (23c5) of said driving side engaging portion (23) is deviated from the axis (21c) of said driven side engaging portion (21) with respect to the crossing direction.

V. Regarding the main request, the appellant essentially argued that the skilled person would have understood from reading the originally filed earlier/earliest application that providing the coupling on one axial end of the development roller was not necessary for obtaining the desired technical effect of the invention. The disputed feature was thus not an essential feature of the claimed invention and could therefore be omitted from claim 1.

As to the fifth auxiliary request, the appellant argued essentially that it should be admitted by the board because it clearly overcame the objection that led to the refusal of the main request. The fifth auxiliary request raised no new issues nor presented any extra burden for the board.

Reasons for the Decision

1. The application

1.1 The present application is a divisional application of European patent application No. 14 158 347 ("earlier application"), which is in turn a divisional application of European patent application No. 07 831 405 ("earliest application", published as WO 2008/072431 A2).

1.2 The claimed invention relates to a process cartridge for an electrophotographic imaging apparatus (see Figure 1 of the application as published), such as a photocopy machine. The cartridge contains, among others, an electrophotographic photosensitive drum (1), where a latent image is formed and a developing roller (25), where the latent image formed on the drum is developed (see Figure 2). Both the drum and the roller rotate and the rotating force is transmitted ("inputted") from the apparatus ("main assembly") separately to the drum ("first rotational driving force") and to the developing roller ("second rotational driving force").

1.3 It is noted that the description of the **earliest** application as filed (taken to correspond to the

description as published in WO 2008/072431 A2) is identical with the description of the **earlier** application as filed. The passages cited in the following relate to the earliest application and apply thus to both applications. The numbering of the figures is the same in all applications.

2. Main request - extension beyond the earliest/earlier application as filed

2.1 The sole point of contention relates to the omission of the specification that the shaft coupling member (20) is provided on one axial end of the developing roller (25) in feature (vi) of claim 1.

2.1.1 According to claim 1 of the earliest application as filed, the process cartridge (7) comprises, among others, (emphasis by the board)

- *a drum coupling member,* ***provided on one axial end of said electrophotographic photosensitive drum,*** *for engaging with the first main assembly drive transmission member and transmitting a first rotational driving force to the electrophotographic photosensitive drum ... ;*
- *a shaft coupling member,* ***provided on one axial end of said developing roller,*** *for transmitting a second rotational driving force ... ;*

Claim 1 of the earlier application as filed includes the same features in a similar wording.

2.1.2 In claim 1 of the main request, the specification that the shaft coupling member is provided on one axial end of the ("said") developing roller has been omitted in the second feature cited above (see feature (vi) in

point III. above).

2.2 During the examination procedure, both the examining division and the appellant (then applicant) used the so-called "essentiality test" or "three-point test" (see Guidelines for examination, H-V, 3.1; same wording both in current edition of the Guidelines and the edition of November 2019 in force at the time of the decision under appeal) in order to assess whether the removal of the feature from claim 1 constituted added subject-matter.

The board, however, adhering to recent case law of the Boards of Appeal, considers this test unsuitable for drawing conclusions on questions of added subject-matter (see *Case Law of the Boards of Appeal,* 10th Edition, II.E.1.4.4, especially points b) to e)). Assessment of added-subject matter is rather (to be) based on the so-called "gold standard", i.e. whether the skilled person using common general knowledge can derive the amended subject-matter directly and unambiguously from the content of the application as originally filed, or in cases such as the present one, from the content of the earlier and earliest applications as originally filed.

The "essentiality test" can be regarded as a tool in this assessment but it represents only a necessary and not a sufficient condition. In other words, even if an amendment "passes" the test, it does not necessarily mean that it meets the requirements of Article 123(2) or 76(1) EPC. This is also stated in the above-cited passage of the Guidelines: "*However, even if the above criteria are met, the division must still ensure that the amendment by replacing or removing a feature from a claim satisfies the requirements of Art. 123(2) as they*

also have been set out in G 3/89 and G 11/91, referred to in G 2/10 as 'the gold standard'".

2.3 The relevant question is thus whether the skilled person can derive from the originally filed content of the earlier and earliest applications, directly and unambiguously, that the shaft coupling member (20) can be provided in any other way than on one axial end of the developing roller (25).

2.4 The appellant referred to the passage on pages 21 to 25 of the description of the earliest application and argued that there was no restriction to the position of the shaft coupling member with respect to the developing roller. Moreover, providing the shaft coupling member on one axial end of the developing roller was not presented as an essential feature of the claimed process cartridge (see statement of the grounds of appeal, page 5, second paragraph).

2.4.1 The board notes that this passage (more specifically from page 20, last paragraph (line 16) to page 25, line 7) describes the structure of the process cartridge in general (see also Figure 2). It also describes briefly the image forming operation (page 24, line 3 to page 25 line 7). There is no information in this passage on how the rotational driving force is (to be) transmitted to the drum or to the developing roller.

2.4.2 In the board's view, the skilled person, looking for information on how the rotational driving force is (to be) transmitted to the drum and to the developing roller, would rather look to the passage under the title "Structures of developing roller supporting portion and developing drive force input portion in process cartridge" starting on page 36, line 8 of the

description of the earliest application.

This passage makes reference to Figures 12 to 16 and describes in detail how the developing roller is coupled to the drive transmission member and how the rotational driving force is transmitted to the developing roller. This passage also describes an Oldham coupling which is used to transmit the rotational driving force ("second rotational driving force") from the main assembly development coupling (53) to the developing roller (25) (see also page 38, lines 6 to 12). The subsequent section (starting on page 42, line 18) describes in detail the operation of the Oldham coupling in transmitting the rotational driving force to the developing roller.

2.5 The board agrees with the appellant that there is no explicit mention in the description that the shaft coupling member must be provided on one axial end of the developing roller.

In the board's view, however, the skilled person reading the detailed description and looking at the relevant figures would readily understand that this coupling member is located at one axial end of the developing roller. The earlier/earliest application does not provide any suggestion or hint that the coupling member could be located at a different position (on the developing roller or elsewhere). Moreover, the described function of the Oldham coupling in compensating any phase differences would not be possible if the coupling was located at any other position than at one axial end of the developing roller.

The board also notes that in the description of the

other 3 embodiments (Embodiments 2 to 4) of the claimed cartridge (see page 51, line 22 to page 56, line 27) there is no indication that the coupling of the developing roller is implemented in any different way.

In the board's opinion, therefore, the skilled person reading the originally filed earliest/earlier application receives the information that there is only one implementation of the coupling and this is by providing the shaft coupling member on one axial end of the developing roller.

2.6 Page 49, second paragraph of the earliest application states that *[a]s has been described hereinbefore* [sic], *in this embodiment, the structure is such that the rotational driving force is directly inputted* [sic] *to the developing roller 25 through the coupling 22 from the main assembly development coupling 53 rotated independently of drum drive coupling 66 which inputs the rotational driving force to the photosensitive drum 1. Accordingly, the influence by the rotation of the developing roller 25 to the rotational accuracy of the photosensitive drum 1 can be suppressed, and furthermore, the rotational accuracy of the developing roller 25 per se is improved. For this reason, the image quality is improved.*

Hence, the described embodiment of the coupling of the developing roller achieves one of the principal objects of the invention, which is *to provide a process cartridge and a small size electrophotographic image forming apparatus wherein a rotational driving force is directly imputted* [sic] *to the developing roller through the shaft coupling member from the main assembly of the apparatus independently from the driving input to the photosensitive drum* (see page 4,

lines 13 to 20).

In the board's opinion, this shows that providing the shaft coupling member on one axial end of the developing roller is essential for achieving one of the main objects of the invention.

2.7 The appellant argued that the Oldham coupling was not among the features of claim 1 of the main request, where only a "shaft coupling" was mentioned. The application also mentioned that other couplings might be used (see page 51, lines 16 to 21) and the Oldham coupling was thus only one of the possible couplings. Hence, despite the detailed description of the structure and operation of the Oldham coupling, such a coupling was not among the claimed features, let alone among the essential features of the invention.

2.7.1 Moreover, the skilled person would have understood that it was not obligatory that the Oldham coupling - or any other coupling - was provided on one axial end of the developing roller in order to achieve the mentioned technical advantages such as compensation of any phase differences. For example, the coupling could have been provided on an idle roller between the developing roller and the (second main assembly) drive transmission member. In such a case, there would still be independent transmission of the rotational force to the developing roller and compensation of any phase differences, achieving thus the main aim of the claimed invention and the technical advantages of an Oldham coupling.

2.7.2 As to the aims (objects) of the invention, the appellant argued that, besides the independent input of the driving force to the developing roller (page 4,

lines 13 to 20), there were other aims (objects) of the claimed invention mentioned. One such object was to provide a smooth engagement of the second main assembly drive transmission member and the engaging portion of the shaft coupling member (page 4, lines 21 to 27). Another object of the claimed invention was to improve the rotational accuracy of the developing roller and so the quality of the obtained image (page 5, lines 1 to 5).

Providing the shaft coupling member on one axial end of the developing roller played no role in achieving these aims, which indicated that it was not an essential feature of the invention and could thus be omitted from the claim.

2.8 The board does not find these arguments persuasive.

2.8.1 Regarding the coupling, the board agrees that the Oldham coupling is not claimed in claim 1 of the main request. However, the only detailed embodiment of the invention described in the application includes an Oldham coupling. Even when mentioning the possible use of other couplings, the application introduces a limitation to couplings *which can absorb the rotational variation produced when the axes the input side and the output side are deviated* (see page 51, lines 19 to 21). A similar limitation for the shaft coupling is also included in claim 1, see feature (vi-ii) (point III. above). This is the same technical effect which is obtained by the Oldham coupling described in detail in the earliest/earlier application, i.e. compensating any phase differences between the drive transmission member and the developing roller. In the board's view, in order to obtain such a technical effect, the coupling must be located at one axial end of the roller, just as

with the Oldham coupling.

2.8.2 Proving the coupling (Oldham or other) on an idle roller added between the developing roller and the drive transmission member would go against the main purpose of the invention, which is to reduce the volume and simplify the structure of the cartridge and the apparatus. Moreover, it would be against one of the principal objects of the claimed invention which is to provide *a process cartridge ... wherein a rotational driving force is* ***directly*** *inputted* [sic] *to the developing roller through the shaft coupling member from the main assembly of the apparatus independently from the driving input to the photosensitive drum* (page 4, lines 13 to 20; emphasis by the board).

If an idle roller (on which the coupling member would be provided) were added between the developing roller and the drive transmission member, a *direct* input of the driving force to the developing roller would not be obtained. The skilled person would therefore not contemplate such solutions including additional rollers.

2.8.3 Regarding the other objects of the invention, the board agrees with the examining division that they are subordinate to the principal object, i.e. the direct and independent input of the driving force to the developing roller (see point b) on pages 3 and 4 of the impugned decision). The earliest/earlier application already indicates a ranking, qualifying the first as a "principal" object and the other two as "another" and a "further" objects. The skilled person reading this passage would understand that the smooth engagement and the rotational accuracy are objects to be achieved once the direct and independent input of the driving force

to the developing roller has been implemented. In other words, these objects of the invention aim at solving problems that may arise from the implementation of the direct and independent input of the driving force to the developing roller. It is also clear to the skilled person that in order to achieve the latter, the shaft coupling member has to be provided on the axial end of the developing roller.

2.9 In a different line of argument, the appellant drew attention to the term "provided on" in the disputed feature of claim 1 of the earliest/earlier application as filed (... *a shaft coupling member, provided on one axial end of said developing roller ...).*

2.9.1 The appellant noted that the application used both terms "provided at" (see e.g. the sentence bridging pages 35 and 36 of the earliest application: "... *a clearance 31e provided at upstream of the force receiving portion ...") and* "provided on". It was an established meaning that "provided at" indicated a location at which something was provided while "provided on" indicated, besides a location, also direct contact. The skilled person would thus have understood that "provided on one axial end of said developing roller" meant that the shaft coupling member was directly contacting the axial end of the developing roller. This was in accordance with the definition of claims 1 and 17 of the earliest application as originally filed, where the disputed feature was included.

2.9.2 Moreover, claim 15 of the earliest application as originally filed included the following definition:

[A process cartridge comprising]

"*... an Oldham coupling for transmitting the second rotational driving force to said developing roller with a deviation permitted between an axis of the second main assembly drive transmission member* ***provided on*** *one axial end of said developing roller and an axis of said developing roller ... "* (emphasis added).

The appellant argued that, according to the previously established understanding, the skilled person should have understood that the second main assembly drive transmission member was located at and in direct contact with one axial end of the developing roller. This was however clearly not the case because according to the description there was an Oldham coupling between the the developing roller and the drive transmission member, which was also included in claim 15. A similar definition was included in claim 20, as well.

Therefore the skilled person would have sought a broader interpretation of the term "provided on" in the present context, which could encompass both the definitions of claim 1 (and claim 17) and claim 15 (and claim 20).

2.9.3 As an example of such a broader interpretation "provided on one axial end of said developing roller" could have been understood as provided on the axis of the developing roller. Such an interpretation would have encompassed both definitions in claims 1 and 15.

However, as Figure 18 indicated, there were situations where the axis of the driving side (member) and the axis of the developing roller did not coincide (see also page 46, lines 3 to 15). In such a case, the definition of claim 15 (and claim 20), according to which the drive transmission member was provided on one

axial end of the developing roller would not fall under the broader interpretation.

2.9.4 The skilled person would thus have realised that there was no interpretation of the term "provided on" that could have been used throughout the application and covered all the described embodiments. They would thus have understood that the feature was not essential and would have ignored it.

2.10 The board is not convinced by these arguments of the appellant.

2.10.1 With the exception of claims 15 and 20, the whole content of the earliest/earlier application as filed is consistent in that the shaft coupling member (Oldham or other) is provided on (i.e. located at and being in direct contact with) one axial end of the developing roller.

2.10.2 The board agrees with the appellant that the skilled person would have understood that it was not possible in the context of claims 15 and 20 that the drive transmission member was in contact with one axial end of the developing roller, since the Oldham coupling was in between the two. However, rather than looking for other interpretations of the term "provided on", the skilled person would have readily understood that this was a mistake and have interpreted claims 15 and 20 in accordance with the rest of the application and claims.

2.11 Summarising, in the board's opinion the skilled person reading the originally filed earlier and earliest applications would not only derive, directly and unambiguously, that the shaft coupling member has to be provided on one axial end of the developing roller but

that in this way one of the principal objects of the claimed invention is achieved. There is thus no support in the earliest and earlier applications as originally filed for providing the shaft coupling member in any other way nor for omitting this feature from claim 1 of the main request.

Hence, the board agrees with the examining division that the omission of the identified feature constitutes an unallowable intermediate generalisation and that claim 1 of the main request does not meet the requirements of Article 76(1) EPC.

3. Fifth auxiliary request - admittance

3.1 This request was filed for the first time with the appellant's statement of grounds of appeal. It is thus considered an amendment to the appellant's case which is to be admitted at the board's discretion under Article 12(4) RPBA.

3.1.1 Compared to claim 1 of the main request, claim 1 of the fifth auxiliary request comprises the disputed feature in feature (vi) (see point IV. above).

This amendment clearly overcomes the objection under Article 76(1) EPC which had led to the refusal of the application, since the disputed omitted feature has now been added verbatim in claim 1. It does not give rise to any new issues, either, since the remaining claimed subject-matter is the same as in claim 1 of the main request.

3.2 The objection under Article 76(1) EPC in relation to the specific omitted feature was raised and discussed during the examination procedure. Moreover, the

examining division had suggested this amendment (i.e. the addition of the omitted feature) to the appellant (then applicant), who chose not to follow the suggestion.

Therefore the question whether the appellant should have filed the fifth auxiliary request in the first instance proceedings has to be considered (Article 12(6) RPBA).

3.3 The appellant argued that it wished an opinion by the Boards of Appeal on the disputed question of added-subject matter. Had it filed the fifth auxiliary request during the examination procedure, it would have received a patent without any possibility to have the question assessed by the Boards of Appeal. It had filed the fifth auxiliary request at the earliest possible stage of the appeal proceedings, i.e. with the statement setting out the grounds of appeal. Since the added feature corresponded verbatim to the omitted feature and the remaining claimed subject-matter was the same as in the main request, there was no additional burden for the board if it admitted the fifth auxiliary request.

In addition, since it intended to pursue the claimed subject-matter in a further divisional application in case the board would not admit the fifth auxiliary request, admitting the fifth auxiliary request would actually contribute positively to the economy of the procedure, since a new granting procedure relating to such a divisional application would be avoided.

3.4 The board notes that according to Article 107 EPC, it is an undisputed right of the applicant to contest the decision of the examining division and seek a judgment

on the same question of added-subject matter by a Board of Appeal.

It is evident that in view of the examining division's conclusions, the appellant (then applicant) had no choice but to maintain its main request and to file an appeal if it wanted an opinion of the Boards of Appeal on the same question of added subject-matter.

Regarding the filing of the fifth auxiliary request, it is true that there was the procedural possibility to file it during the examination procedure. If the appellant had filed it then and at the same time maintained the main request, it would have still had the possibility to refuse any intention to grant based on the fifth auxiliary request issued by the examining division and receive a refusal which it could then have appealed.

This handling would not have made any essential difference to the board's task compared to the current procedural situation, since the board would have still been faced with the judicial review of the decision to refuse the main request on the ground of added subject-matter, as well as with the assessment of whether the fifth auxiliary request overcomes the reasons for the refusal.

The only difference to the current procedural situation the board sees is that in a hypothetical decision under appeal after the appellant's refusal of the intention to grant a patent based on the fifth auxiliary request, an indication by the examining division that the fifth auxiliary request met the requirements of the EPC could have been included.

This does not present an additional burden for the board, however, as it intends to remit the case to the examining division for further examination (see point 4. below).

3.5 In addition, the board agrees with the appellant that admitting the fifth auxiliary request and remitting the case to the examining division will allow the case to come to an end in a more efficient way that by obliging the appellant to pursue a further divisional application with the same subject-matter from the start.

3.6 In view of the above, the board considers that the circumstances of the appeal justify the admittance of the fifth auxiliary request into the proceedings, and decides to admit it under Article 12(4) and (6) RPBA.

4. Remittal to the examining division for further prosecution

4.1 The amended claims of the fifth auxiliary request clearly overcome the sole reason for the refusal since they include the omitted feature.

4.2 The impugned decision does not contain any assessment by the examining division regarding compliance of the claimed subject-matter with the other requirements of the EPC.

The statement by the first examiner during a telephone call that the application "appeared to meet the requirements of the EPC, except those of Article 76 EPC" (see minutes of telephone call dated 17 September 2019) cannot be considered a complete assessment reflecting the opinion of the entire

examining division.

4.3 The board is of the opinion that the circumstances described above (see also point 3. above) constitute special reasons for remitting the case to the examining division (Article 11 RPBA).

The board considers appropriate to remit the case to the examining division in order to allow the division as a whole to decide on the question of compliance of the the fifth auxiliary request with the other requirements of the EPC. The appellant agreed to a remittal, as well.

5. Summarising, the board agrees with the examining division that the main request does not meet the requirements of Article 76(1) EPC. The claims of the fifth auxiliary request, however, comply with these requirements. The further examination is thus to be based on the fifth auxiliary request.

Attention is drawn to the corresponding amended description pages for the fifth auxiliary request filed with the statement setting out the grounds of appeal.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the examining division for further prosecution.

The Registrar: The Chairman:

S. Sánchez Chiquero T. Häusser

Decision electronically authenticated