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Anmeldenummer / Filing No / N° de la demande : 80 302 390.2

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Bezeichnung der Erfindung: Document handling apparatus and method
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : B65H 29/12, G03G 21/00

ENTSCHEIDUNG / DECISION

vom / of / du 9 July 1990

Anmelder / Applicant / Demandeur : Xerox Corporation

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Finality of decision/XEROX

EPO / EPC / CBE Articles 96(2), 110(2), 111, 112, 113

Rules 51(2), 66(1), 86(3)
Schlagwort / Keyword / Mot cle : "Rejection of certain claimed subject-matter in appeal proceedings" - "Remittal to Examining Division for further prosecution on basis of auxiliary request" - "Disapproval of text in accordance with Rule 51(4) communication and request for further examination in respect of rejected subject-matter" - "Request for referral of questions to Enlarged Board rejected".

Leitsatz / Headnote / Sommaire

Headnote follows



Case Number : T 79/89 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 9 July 1990

Appellant : Xerox Corporation
Xerox Square
Rochester
New York 14644, (US)

Representative : Ian Goode
Rank Xerox Ltd
364 Euston Road
London NW1 3BL (GB)

Decision under appeal : Decision of Examining Division 084
of the European Patent Office dated
28 July 1988 refusing European
patent application No. 80 302 390.2
pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : F. Gumbel
Members : G.D. Paterson
C. Wilson

Summary of Facts and Submissions

- I. This European patent application was refused by a Decision of the Examining Division dated 4 January 1985, on the ground that the proposed amended claims contravened Article 123(2) EPC, following a previous objection by the Examining Division to Claim 1 as originally filed that it was not supported by the description ("does not include all features necessary to produce the desired result"). The Decision stated that the questions of novelty and inventive step had not been considered, (although in an earlier communication it had been stated that the subject-matter of Claim 1 as originally filed appeared to be novel and inventive).

The subsequent appeal procedure against the above Decision is the subject of Decision T 133/85 dated 25 August 1987 (OJ EPO 1988, 441). As can be seen from Decision T 133/85, during oral proceedings before the Board of Appeal, the Appellant made a main request and an auxiliary request. The claim in accordance with the main request was held not to be allowable because it contravened Article 84 EPC, for the same reason as that underlying the objection by the Examining Division to the claims as originally filed, referred to above. The claim in accordance with the auxiliary request was held to be allowable, and the Order therefore states that "The case is remitted to the first instance with the order to complete the examination on the basis of Claim 1 of the conditional submission B (i.e. the auxiliary request)".

- II. The subsequent procedure before the Examining Division is set out in its Decision to refuse the application, dated 28 July 1988. As can be seen from that Decision, the

Examining Division issued a communication under Rule 51(4) EPC dated 10 February 1988, stating the text for which it intended to grant a patent (including Claim 1 of the auxiliary request before the Board of Appeal). Thereafter, by letter dated 19 February 1988 addressed to the Boards of Appeal, the Appellant stated his belief that the application in its originally filed form had been incorrectly refused, and requested reconsideration of the originally filed claims by the Board of Appeal, or alternatively referral to the Enlarged Board of Appeal, having regard to important legal issues raised as set out on page 2 of the letter.

Such major legal issues were said to include the following:

- "(i) Where an originally-filed application includes generic independent claims indisputably broad enough to cover two species of one invention, can the EPO, under Article 84 EPC, force all the claims to be narrowed to the scope of only dependent original claims to one of the species solely on the basis of statements in the description directed to that dependent species, even though generic statements of the invention and its features are also in the original description?

- (ii) Bearing in mind Article 113 EPC, can the decision of the Board be set aside when the Board has raised sua sponte for the first time in an Appeal Decision a new ground of rejection?"

Detailed submissions in support of these issues were also set out.

By letter dated 9 March 1988 the Appellant disapproved of the text accompanying the Rule 51(4) communication, and requested that the examination of the application be reopened on the basis of the originally filed description and claims, but modified by the addition of new claims set out in an Annex (I), or by substitution of original Claims 1 and 10 for these annexed claims.

The Reasons for the Decision of the Examining Division are short and are here quoted in full:

1. The applicant has expressed disapproval of the text communicated under Rule 51(4), which corresponds to the text on the basis of which the Examining Division was ordered, by the Board of Appeal, to complete the examination of the application.
2. The request of the Applicant to reopen the examination on the basis of newly filed claims, including an independent apparatus claim, clearly goes beyond the order of the Appeal Board. This request thus constitutes an attempt to call into question the outcome of the procedure before the Appeal Board. The Examining Division has at this stage in the proceedings no mandate to consider alternative claims and has therefore refused its consent to the amended claims filed with the letter dated 9 March.
3. In the absence of an approved text as required by Article 97(2)(a) the Examining Division has no option but to refuse the application.

III. The Appellant filed a notice of appeal on 20 August 1988 and duly paid the appeal fee. In his grounds of appeal filed on 30 November 1988, the Appellant again requested

that the application should proceed to grant on the basis of the text as originally filed, preferably with claims and description modified in accordance with Annexes 1 and 2 respectively. The Decision of the Board of Appeal dated 25 August 1987 was said to be inappropriate because it was not in accordance with the Guidelines and was based on an error of interpretation of the description as originally filed (in particular of that part of the description which referred to a US patent). Furthermore, the Decision of the Examining Division dated 28 July 1988 was inappropriate, because the claims currently requested were not the same as those which had been before the Board of Appeal, and had been presented in response to new issues which had been raised for the first time by the Board of Appeal in its Decision, so that the Appellant had had no opportunity to respond.

If such a situation arose before the United States Patent Office, the case could be reconsidered as a matter of right. This principle was equally applicable to the EPO by way of analogy. The inherent function of a Board of Appeal is to hear appeals, i.e. to serve an appellate function of reviewing decisions previously made by an examiner, thus providing proper opportunities for a party to respond, and to receive a second opinion from a second instance. If a Board of Appeal functions as an initial examiner at first instance, fundamental legal principles require an opportunity to respond (including proposing amendments), and an opportunity for further independent appellate review.

The Appellant's earlier letters dated 19 February and 9 March 1988 were attached to the grounds of appeal and incorporated therein.

By letter dated 27 July 1989 the Appellant referred to Decisions T 6/84 dated 21 February 1985 and Decision T 292/85 (OJ EPO 1989, 275) in support of the submissions made in his letter dated 19 February 1988.

IV. In a communication on behalf of the Board dated 22 March 1990, the relevant history of the case was summarised, and the Board's view was stated that essentially three issues arose in the appeal as follows:

- (1) Does the Examining Division have any discretion to re-open examination on the basis of newly filed claims in the circumstances of a case such as the present (where an appeal concerning the grant of a patent has been heard by a Board of Appeal, and the case has been remitted to the Examining Division with an order to complete examination of the application on the basis of a particular "request" made by the applicant)?
- (2) If the Examining Division does have a discretion in the matter, did it correctly exercise its discretion in the particular circumstances of this case?
- (3) Is there an important point of law in issue in the present case, which should be referred to the Enlarged Board of Appeal?

Preliminary views were set out in relation to each of these issues.

V. In his observations in reply dated 28 June 1990, the Appellant submitted in connection with issue (3) above that important points of law should be referred to the Enlarged Board of Appeal as follows:

"Under Article 112(1)(a) EPC:

(i) There is an important point of law in this question: Can the Board of Appeal raise a point *sua sponte* and make a decision on that point without the applicant having a chance to reply? In our submission, it is prevented from doing so by Article 113(1) EPC.

(ii) There is a non-uniform application of the law, as between the decision of the Board of Appeal in the present case and the Guidelines for Examination in the European Patent Office.

Under Article 112(1)(b) EPC:

(iii) There is a non-uniform application of the law, in that the Board of Appeal in the present case, and other Boards of Appeal, have given different decisions on the same point of law. We therefore request that the President of the EPO refers this point to the Enlarged Board of Appeal."

As to (i), the point raised "*sua sponte*" by the Board of Appeal was its interpretation of the description as originally filed, where it referred to an earlier US patent.

As to (ii), reference was made back to the letter dated 19 February 1988.

As to (iii), reference was made to the Decisions identified in III above.

As to Article 112(1)(a) EPC, it was submitted that a Board of Appeal could refer points of law to the Enlarged Board of Appeal "during proceedings on a case". In the present

case, it was submitted that the proceedings were still in being, since there was still no approved text under Rule 51(4) EPC.

As to Article 112(1)(b) EPC, there was no restriction as to when the President could refer a point of law.

Requests for referral had first been made in the letter dated 19 February 1988, to which no reply had been received.

VI. Furthermore, the Appellant made an auxiliary request for grant of the patent with text as in the Rule 51(4) communication.

Oral proceedings took place on 9 July 1990, at which the Appellant supported his previous submissions, and confirmed that his main request was for grant of a patent with text as originally filed but amended in accordance with Annexes 1 and 2 to his letter dated 9 March 1988, and his auxiliary request was as stated in his letter dated 28 June 1990 (see V above).

In response to the Board's explanation that a referral to the Enlarged Board by the President under Article 112(1)(b) EPC could not affect this Board's decision upon the patent application before it in this case, the Appellant withdrew his request for referral of question (iii) in paragraph V above to the Enlarged Board, but confirmed that he requested that questions (i) and (ii) should be so referred.

At the conclusion of the oral proceedings the Board's decision was announced that the main request was rejected together with the request for referral of questions (i) and (ii) to the Enlarged Board. The case was to be

remitted to the Examining Division with an order to grant the patent with text in accordance with the auxiliary request.

Reasons for the Decision

1. The appeal is admissible.
2. Previous procedure before the Board of Appeal
 - 2.1 During the course of examination proceedings in respect of a European patent application before the Examining Division, an applicant has a right to amend the description, claims and drawings once in reply to the first communication and may thereafter make amendments only with the consent of the Examining Division (Rule 86(3) EPC). An applicant is invited to file amendments when appropriate and necessary in the circumstances of each individual case (Article 96(2) and Rule 51(2) EPC). During appeal proceedings before a Board of Appeal, the same principles apply (Article 110(2) and Rule 66(1) EPC).

An auxiliary request is a request for amendment covered by the above principles. As was stated in Decision T 153/85 (OJ EPO 1988, 1), "an auxiliary request is a request for amendment which is contingent upon the main request (...or preceding auxiliary requests...) being held to be unallowable".

In the present case, during the proceedings before the Examining Division the Appellant made only one request, namely the grant of the patent with amended claims. The claims as originally filed were amended in response to an objection raised, and no request was finally made before

the Examining Division for grant of the patent with text as originally filed.

During the proceedings before the Board of Appeal leading to Decision T 133/85, the Appellant originally contested the Decision of the Examining Division with respect to the claims which were before it, as well as making an auxiliary request in respect of amended claims in respect of which the Examining Division had made a favourable indication. Subsequently, at the oral proceedings before the Board of Appeal, the Appellant withdrew his request in respect of the claims with text as rejected by the Examining Division, and substituted as his main request a set of claims having subject-matter corresponding to the claims as originally filed (as well as maintaining his auxiliary request).

Pursuant to Article 113(2) EPC, the Board of Appeal could only consider and decide upon the patent application with text corresponding to the main request or the auxiliary request.

- 2.2 With respect to the main request, the Appellant has suggested that the Board of Appeal functioned as an initial examiner at first instance, and that accordingly there should be a right to further independent appellate review as well as a right to present further amendments.

The present Board does not accept these submissions, for the following reasons:

- (a) Under Article 111(1) EPC a Board of Appeal has a discretion during appeal proceedings before it, either to "exercise any power within the competence of the department which was responsible for the decision appealed (here, the Examining Division) or

(to) remit the case to that department for further prosecution". Thus even when a request is made before a Board of Appeal whose subject-matter does not correspond to any request made before and decided upon by the first instance, a Board of Appeal has the power to act as the first and only instance in deciding upon such request, without the possibility of further appellate review.

In this connection, the Appellant's submissions concerning comparative procedure in the United States are not relevant. The procedure before the EPO is governed by what is prescribed by the EPC.

In the present case, as set out above, in the previous proceedings before it the Board of Appeal exercised such discretion by rejecting the main request; this being within the power of the Examining Division. This would seem to have been an appropriate exercise of discretion under Article 111(1) EPC, since the main request before the Board of Appeal was rejected on the same ground as the Examining Division had relied upon in objecting to the text of the claims as originally filed.

- (b) The fact that a Board of Appeal exercises the power of an Examining Division to reject a request does not give any right for the applicant to make further requests. The possibility of proposing further amendments by way of further requests remains a matter of discretion under Rule 86(3) EPC.

2.3 The Appellant has also submitted that the Board of Appeal's rejection of the main request was contrary to Article 113(1) EPC, in that he had no opportunity to

comment upon the Board's interpretation of a passage in the description of the application as filed, which referred to a US patent Adamek, which interpretation formed the basis for rejection of the main request.

The Board does not accept this submission for the following reasons:

- (a) The reference to US patent Adamek in the description was only one passage out of many which the Board relied upon in its previous Decision when interpreting the description of the invention as filed in a limited manner - see page 7 of the Decision.
- (b) The limited scope of the description as filed had been the basis for the Examining Division's objection to the claims as originally filed - see the communication dated 8 July 1982.
- (c) The Appellant had full opportunity to comment upon the interpretation of the description as originally filed during the oral proceedings before the Board of Appeal when the main request was presented in place of the previous main request.

3. The legal effect of the Board of Appeal's previous Decision

In the present case, the Board rejected the Appellant's main request, and remitted the case to the first instance for further prosecution on the basis of the auxiliary request. In this circumstance, Article 111(2) EPC is applicable: the first instance department "shall be bound by the ratio decidendi of the Board of Appeal, insofar as the facts are the same".

The ratio decidendi of the Board of Appeal's previous Decision was that the subject-matter of the main request was not allowable, but that the grant of a patent in accordance with the auxiliary request was subject to consideration of its patentability by the Examining Division.

In this circumstance, in the Board's judgment, following issue of the Board of Appeal's previous Decision, the Examining Division clearly had no power to re-open examination on the basis of the claims which the Appellant requested (with subject-matter corresponding to the previously rejected main request). Having examined the subject-matter of the auxiliary request for patentability and found no objection to it, the Examining Division was bound to issue a communication under Rule 51(4) EPC with text based upon the auxiliary request (as it did in its communication dated 10 February 1988).

Furthermore, in the absence of approval of such text, in the Board's judgment the Examining Division was bound to refuse the application, for the reasons set out in its Decision dated 28 July 1988 (see paragraph II above).

Since the Examining Division had no power to re-open examination in respect of the claims as requested by the Appellant, in the context of this appeal the Board of Appeal necessarily has no power to re-open examination in respect of such claims, because it can only exercise any power which is within the competence of the Examining Division (Article 111(1) EPC). Thus the main request of the Appellant must be refused.

4. Referral of questions to the Enlarged Board of Appeal

4.1 The Appellant first made requests that certain questions should be referred to the Enlarged Board in his letter dated 19 February 1988, which was after the Board of Appeal had issued its previous Decision dated 25 August 1987. The form of the requests was finalised during the oral proceedings on 9 July 1990.

The previous Decision was a final decision in respect of the issues which were decided on 25 August 1987, namely, rejection of the main request and the allowability of the auxiliary request subject to the further consideration of patentability by the Examining Division. Thereafter, the Board's decision in respect of such issues could not be changed. After issue of the Decision on 25 August 1987, the case was duly remitted to the Examining Division.

In the Board's judgment, therefore, on or after 19 February 1988 the Board of Appeal (to whom the letter of that date was addressed) had no power to refer any questions of law to the Enlarged Board which may have arisen in respect of issues which had already been decided by the Board in its Decision.

The proper interpretation of Article 112(1)(a) EPC in its context is such that a Board of Appeal may only refer questions of law to the Enlarged Board "during proceedings on a case" and before it decides upon the issues in the appeal in relation to which such questions of law are considered to arise. This is clear from Article 112(1)(a) EPC itself, which envisages the presence of reasons for rejection of requests for referral of questions in the "final decision" of the Board of Appeal. This would not have been possible in the present case, where as explained

above the Board issued its "final decision" on the matters in issue in the appeal before it received any request for referral of questions of law from the Appellant.

Furthermore, in the event that a Board does refer questions to the Enlarged Board, Article 112(2) EPC makes it clear that the parties are also parties to the Enlarged Board proceedings, and Article 112(3) EPC prescribes that the decision of the Enlarged Board is binding on the Board of Appeal: this can only make sense if questions are referred to the Enlarged Board before a Board of Appeal has decided the issues in the appeal in connection with which the questions of law arise.

The Appellant submitted that such an interpretation of Article 112 EPC provided a procedural system which was in effect upside down, and contrary to normal national appeal systems, where a possibility of appeal to a further instance is provided after a lower instance has issued its decision. However, the Boards of Appeal are of course required to interpret and apply Article 112(1)(a) EPC as it is, namely as discussed above. The Enlarged Board of Appeal is not a third instance within the EPO, but part of the second instance constituted by the Boards of Appeal.

4.2 In any event, even if the Appellant had requested referral to the Enlarged Board of the questions which he has put forward before issue of the Board of Appeal's previous Decision, the Board would have rejected the requests for referral, for the following reasons, with reference to the questions as set out in paragraph V above:

- (i) It seems very clear that a Board cannot lawfully contravene Article 113(1) EPC, and there is nothing further for the Enlarged Board to decide in this

respect. As explained in paragraph 2.3 above, in the Board's judgment there has been no contravention of Article 113(1) EPC in the previous proceedings before the Board.

- (ii) The Guidelines do not bind the Board of Appeal. The Board does not accept that there is any inconsistency between its previous Decision and the Guidelines, but in any event it considers that there would have been no sufficient reason to refer this matter to the Enlarged Board. Furthermore, with reference to the previous Decisions cited by the Appellant, the Board is not satisfied that there is any inconsistency with such decisions which would have justified referring any question of law to the Enlarged Board in order to ensure uniformity in the application of the law.

5. The auxiliary request

The Appellant has made an auxiliary request to the Board of Appeal for grant of a patent with text in accordance with the Rule 51(4) EPC communication. Such request was filed at a late stage in the proceedings, and the Appellant had previously disapproved of this same text to the Examining Division.

Nevertheless, in the Board's view the Appellant was entitled in the special circumstances of this case to take the course which he did before the Examining Division, in order to raise the issues in this appeal and have them decided.

Thus the Board admits this auxiliary request in the exercise of its discretion under Rule 86(3) EPC; the request is then automatically allowable having regard to

the previous Rule 51(4) communication. However, in the Board's view no further amendments to the text should be admitted for consideration in this case: the patent should only be granted with text in accordance with the auxiliary request.

Order

For these reasons, it is decided that:

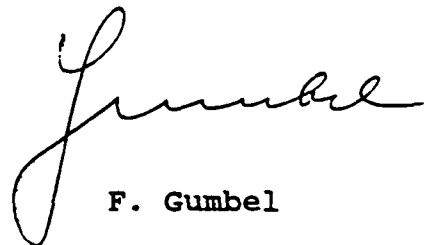
1. The Decision of the Examining Division is set aside.
2. The main request is rejected.
3. The request for the referral of questions of law to the Enlarged Board is rejected.
4. The case is remitted to the Examining Division with an order to grant a patent with text in accordance with that accompanying the Rule 51(4) communication dated 10 February 1988.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel