

Publication in the Official Journal ~~Yes~~ / No

File Number: T 135/92 - 3.5.1

Application No.: 84 114 430.6

Publication No.: 0 147 657

Title of invention:

Classification: G06K 9/62

D E C I S I O N
of 15 May 1992

Applicant: International Business Machines Corporation

Headword:

EPC Article 111(1)

Keyword: "Substantial amendments"

Headnote



Case Number : T 135/92 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 15 May 1992

Appellant : International Business Machines
Corporation
Old Orchard Road
Armonk, NY 10504 (US)

Representative : Blakemore, Frederick Norman,
IBM United Kingdom Limited
Intellectual Property Department
Hursley Park
Winchester
Hampshire SO21 2JN (GB)

Decision under appeal : Decision of Examining Division of the European
Patent Office dated 1 October 1991 refusing
European patent application No. 84 114 430.6
pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : R. Randes
G. Davies

Summary of Facts and Submissions

I. European patent application No. 84 114 430.6 (publication No. EP-A-0 147 657), filed on 30 November 1984, was refused by a decision of the Examining Division on 1 October 1991.

II. The reason given for the refusal was that the independent Claims 1 and 3 (filed on 30 January 1991) were not allowable in that they did not comply with Article 56 EPC because of lack of inventive step having regard to the prior art known from

D3: JP-A-56 149 676,

which document was interpreted with the help of a translation into English which was supplied by the EPO.

III. On 28 November 1991, the Applicant filed a Notice of Appeal and paid the appeal fee on the same day. A Statement of Grounds of Appeal was filed on 6 February 1992 accompanied with a new set of Claims 1 to 12. Claim 1 reads as follows:

"A method of processing image data for identifying unknown characters of a known character set comprising the steps of:

scanning the unknown characters and generating image data representing the unknown characters;

storing the image data;

applying a first stage of a first set of discriminatory logic tests to the stored image data for identifying the stored image data, the first set of discriminatory logic

tests being for identifying data representing a first subset of the known character set, the first subset consisting of characters having the highest frequencies of occurrence;

applying a first stage of a second set of discriminatory logic tests to stored image data not identified by the first stage of the first set of logic tests, the second set of discriminatory logic tests being for identifying data representing a second subset of the known character set; and

applying a second stage of the first set of discriminatory logic tests to stored image data not identified by previous logic tests, the second stage of the first set of logic tests being for identifying data representing the first subset of the known character sets and being discrete from the first stage of the first set of logic tests."

The independent Claim 7, defining an apparatus for processing image data, corresponds to Claim 1 in that the wordings of the features of Claim 7 correspond almost exactly to the wordings of the respective features of Claim 1, but they formally identify the means for performing the method steps according to Claim 1.

The Appellant also filed amended pages 2a, 3 and 3a. Original pages 1, 4 to 11 and page 2 filed with Appellant's (then Applicant's) letter of 24 January 1991 remain unamended as well as the original drawing sheets 1/3 to 3/3.

IV. The Appellant contested that the invention lacked an inventive step. However, he did not contest the statements made in the paragraphs 7, 8 and 9 of the impugned decision

to refuse the application. Having regard to the subject-matter of the amended independent claims (wherein the last paragraph of Claim 1 as well as the last feature of Claim 7 defines a feature not present in any of the refused claims), the Appellant inter alia pointed out that "the sets of logic tests comprise different "stages" of logic tests for identifying characters in each group respectively. In practice the first stage may be designed to recognise well written or well presented characters and a later stage may be designed to recognise poorly written or poorly presented characters, however, this is a matter of design choice. Each of the stages of logic tests are independent of and discrete from the others."

The Appellant moreover stated that D3 did not disclose or suggest that characters could be grouped together with other characters having similar frequencies of occurrence. Furthermore, D3 did not disclose or suggest that logic tests for identifying unknown characters could comprise different stages of tests, the performance of each stage being independent of the other stages.

- V. The Appellant requests that the decision to refuse the present application be set aside and the application be granted on the basis of the documents as cited under paragraph III above. Moreover, were the Board minded to issue a decision dismissing the appeal, the Appellant requests oral proceedings.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

2. As has been made clear above, the Appellant has added a feature to Claim 1 (last paragraph) and a corresponding feature to the independent Claim 7, which features were not present in the refused Claims 1 to 4. These features try to make it clear that the method and apparatus according to the invention are arranged to work in different "stages" of operation (cf. Figure 3 of the application) i.e. in the first stage, different sets of logic tests are used for the identification of the characters. Were a character, however, not to be identified by the said logic tests, the character would be tested in the second stage by logic tests which are discrete from the tests of the first stage.

Thus the intention of the Appellant was to let the independent Claims 1 and 7 define the system as shown in Figure 3, with different stages or levels. The Board in this analysis does not investigate whether the said claims meet the requirements of clarity - Article 84 - or any other requirements of the EPC, but concludes that the refused claims as well as the cited reference D3, however, clearly relate to one stage only (corresponding to the first line of Figure 3).

The new feature introduced into the independent claims corresponds partly to Claims 3 and 9 of the original claims. It is true that the Examining Division in paragraphs 5.2 and 5.4, of a communication, dated 30 July 1990, stated that the subject-matter of these claims did not contain an inventive step. It was said that these claims defined "additional sets of tests which corresponded to character tests lower down in the priority table in D3".

Apart from such an interpretation of the said original Claims 3 and 9 made by the Examining Division in the said communication the Board finds that having regard to the

wording of the said original claims, the new feature is clearly distinguished from the teaching of D3 as it is stated now clearly therein that the tests of the second stage logic tests are discrete from the first stage logic tests, e.g. the first stage may be designed to recognise well-written and the second may be designed to recognise poorly-written characters (see paragraph IV above).

Thus, it appears that the Examining Division has neither considered the patentability of a method corresponding to new Claim 1, nor of an apparatus corresponding to new Claim 7. The Examining Division has not rectified the decision under Article 109 EPC. Nor is it obliged to explain the grounds on which it based its refusal to rectify the impugned decision. For this reason, the Board is unable to examine the said refusal.

However, the Board finds that substantial amendments have been made which require a further examination of the application. The Board, therefore, deems it appropriate to remit the case to the first instance for further prosecution (Article 111(1) EPC).

3. As the Examining Division has not explicitly dealt with the issues arising under Article 52(2) and 52(3) with regard to the refused set of claims, it is to be understood that it considered the subject-matter of these claims as not excluded from the patentability under Article 52(2) EPC. Having regard to the valid claims, the Board does not see any reason to investigate whether the subject-matter of the refused claims met those requirements or not. The new claims clearly do.

Under preceding reason 2, the Board has stated in the second paragraph that it has not investigated whether Claims 1 and 7 meet the requirements of Article 84 or any

other requirements of the EPC, since this was not necessary to arrive at the conclusion presented there. As an exception to this the Board thinks it appropriate in this particular case to deal with the exclusions under Article 52(2) EPC and 52(3) EPC.

The alleged invention relates to a technical field, i.e. the automatic scanning and identification of unknown characters.

Starting from the closest prior art according to D3, the teaching of which discloses the use of one "stage" only, and comparing this known art with the subject-matter of Claims 1 and 7, it can be seen immediately that the invention provides that characters which could not previously be identified by the known system now can be identified. The main problem to be solved (for investigating whether the problem is a technical problem an exhaustive analysis of the problem-solution aspect appears to be superfluous) therefore appears to be to identify characters that could not be identified by the known system of D3. This problem is clearly technical.

The solution is also of a technical character, as the addition of additional stages to a first stage clearly represents a technical measure (cf. Figure 3 of the present application).

The solution moreover is defined by said last paragraphs of the said Claims 1 and 7, which define technical functions and activities, although parts of the features may relate to mental acts. However, the EPC does not prohibit patenting of inventions consisting of a mix of excluded and non-excluded features. In this case, the subject-matter of Claims 1 and 7 clearly make a contribution to a field outside the range of matters

excluded from patentability under Article 52(2) in connection with Article 52(3) EPC (cf. T 22/85, OJ EPO 1990, 012).

4. Since the appeal is not being dismissed (cf. paragraph V above), there is no need to hold oral proceedings.

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 on the basis of the Appellant's request (see paragraphs III and V).

The Registrar:

The Chairman:

M. Kiehl

P.K.J. van den Berg