

A		B		C	X
---	--	---	--	---	---

File Number: T 241/92 - 3.5.1
Application No.: 87 118 554.2
Publication No.: 0 271 869
Title of invention: Electronic still camera

Classification: H04N 5/225

DECISION
of 2 September 1992

Applicant: Casio Computer Company Limited

Headword:

EPC Article 111(1)

Keyword: "Late-filed claims - core of the invention radically changed -
improper burden on the Board"
"Remitted for further prosecution"



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 241/92 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 2 September 1992

Appellant : Casio Computer Company Limited
6-1, 2-chome, Nishi-Shinjuku
Shinjuku-ku
Tokyo (JP)

Representative : Strasse, Joachim, Dipl.-Ing.
Strasse & Maiwald
Patentanwälte
Balanstrasse 55
W-8000 München 90 (DE)

Decision under appeal : Decision of Examining Division of the European
Patent Office dated 11 November 1991 refusing
European patent application No. 87 118 554.2
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. 87 118 554.2, filed on 15 December 1987 (publication number 0 271 869), was refused by a decision of the Examining Division 058 dated 11 November 1991.

II. The reason given for the refusal was that the subject-matter of the application did not involve an inventive step in view of the teaching of

D1: US-A-4 366 501

and in view of the normal capabilities of a skilled person.

III. On 13 January 1992, the Appellant lodged an appeal against this decision, paying the appeal fee on the same date. A statement of grounds of appeal was filed on 12 March 1992, together with a slightly amended Claim 1.

IV. In a communication pursuant to Article 11(2) of the RPBA the Rapporteur expressed the opinion that he fully agreed with the decision to refuse the present patent application as the subject-matter of refused Claim 1 did not appear to involve an inventive step. The principal characterising feature of Claim 1 was to be seen in that the disk rotating motor of the electronic still camera was switched off after the desired image data had been recorded. Like the Examining Division the Rapporteur was of the opinion that such switching-off of the motor in order to avoid waste of power would have been quite obvious to a skilled man.

V. At the oral proceedings held on 2 September 1992, the Representative of the Appellant initially requested that

he should be permitted to file a main request having a new set of Claims 1 to 6, which were quite different from the ones refused by the Examining Division. He explained that because of problems in making contact with the Japanese Applicant and because of the pressure of meeting time limits, the prosecution of the application had been wrongly directed. New Claim 1 included in principal the features of published Claims 14, 15 and 17 and the claim was delimited against D1 in that the prior art portion of Claim 1 corresponded to original Claim 14 (although feature j had been excluded) and the characterising part was made up of the characterising features of Claims 15 and 17. Such an arrangement was neither disclosed by D1, nor was it obvious to a skilled man having regard to the prior art.

- VI. After deliberation the Board accepted the new set of Claims 1 to 6. Nevertheless, it emphasised that the set of claims should have been filed before the oral proceedings, particularly as it had been stated in the said communication pursuant to Article 11(2) of the RPBA that any further written submissions should be filed at least one month before the date of the oral proceedings. Late filed claims may delay the proceedings, in particular when filed unexpectedly during the oral proceedings and when the core of the invention is radically changed. Such conduct places an improper burden on a Board of Appeal if it attempts to examine such new claims for allowability during the course of the oral proceedings. Thus, an Applicant or Patentee party to appeal proceedings should file new claims significantly in advance of oral proceedings, so as not to delay the proceedings and in fairness to other parties in the proceedings, third parties and the Boards of Appeal.

VII. Claim 1 reads as follows:

"An electronic still camera comprising:

- a) a camera housing (1);
- b) optical means (3, 38), arranged in said camera housing (1), for forming an optical image of an object on a predetermined plane in said camera housing;
- c) image sensing means (2, 41), arranged on said predetermined plane, for converting the optical image into an electronic data form;
- d) a disk-type recording medium (101) having a plurality of recording tracks and driven by a motor (13);
- e) recording means (45-51, 14), having a recording/reproduction head (14), for recording still image data on said recording medium through said head (14);
- f) recording control means (17, 33, 37) for shifting said head in a radial direction of said recording medium in order to select a recording track, and outputting 1-frame electronic data from said image sensing means to said recording means, thereby recording, with said recording means, still image data corresponding to the optical image on said recording medium;
- g) reproducing means (14, 53) for reproducing still image data recorded on said recording medium through said head;
- h) reproducing control means (18a, 18b, 33, 37) for shifting said head in order to reproduce, by said reproducing means, arbitrary still image data from a plurality of still image data recorded on said recording medium; and
- i) composite video signal producing means (54-57) for converting still image data, reproduced by said reproducing means, into a composite video signal,

characterized in that said recording control means (17, 33, 37) comprises a manual switch for outputting trigger signals when said manual switch (17) is half depressed (SW1) and fully depressed (SW2), means, responsive to the trigger signal when said manual switch (17) is half depressed (SW1), for driving said motor (13), detecting whether an output from said reproducing means is still image data, and shifting said head (14) to a position of a non-used recording track which is adjacent to a used recording track and on which still image data is not yet recorded, and means, responsive to the trigger signal when said manual switch (17) is fully depressed (SW2), for starting recording of still image data, and further characterized in that said recording means (45-51, 14) comprises a system controller (33) detecting that recording of still image data on a last recording track of said recording medium (101) has been completed and a servo controller (36) for stopping driving of said motor (13) in response to a detection output from said detecting means."

The Appellant also filed a new introductory part of the description on new description pages 1, 2a and 2b. Pages 3 to 25 of the description as originally filed remained the same as well as sheets 1/12 to 12/12 of the drawings as originally filed.

An auxiliary request was based on Claim 1, filed with the grounds of appeal on 12 March 1992, wherein it was added (line 1) that the camera comprised "a camera housing (1)" and (at the end) "and a connector terminal (8) is provided to said camera housing (1) for outputting the composite video signal to external equipment". The dependent Claims 2 to 4, filed on 28 January 1991 and maintained in the grounds of appeal, remained the same.

VIII. The Appellant said that the electronic still camera now identified in Claim 1 was superior to the camera disclosed in D1 in that this camera gave the operator the possibility to control the camera manually. It was possible for the operator to jump over an arbitrary number of tracks before the image data was recorded onto a chosen track. This could be done both in the singular mode of operation (only one picture recorded) and in the continuous mode (many pictures recorded) and both in the forward and in the reverse direction. Moreover, this design made it possible to erase any picture on any track easily. By using the manual switch, which could be half depressed (to start up the disk driving motor and to shift the head to a desired position) and fully depressed (recording of data), the operator had a simple means for controlling all the operations. The appellant also alleged that the camera according to the invention could be used together with modern digital formatted disks which was not possible with the camera disclosed by D1. The camera according to D1 was in principle an automatic camera wherein the operations were performed automatically. Thus the said camera did not have "means for detecting whether an output from said reproducing means is still image data"; instead, the shifting of the head was controlled by a circuit containing counters.

IX. The Appellant requested that the decision under appeal be set aside and a patent be granted on the basis of new Claims 1 to 6 filed during oral proceedings (Main Request, see under VII above) or the basis of Claim 1 filed on 12 March 1992 (with amendments, see under VII above - Auxiliary Request) and dependent Claims 2 to 4 filed on 28 January 1991.

Reasons for the Decision

1. The appeal is admissible.

Main Request

2. As has been made clear above, in this case Claim 1 contains major amendments, which effectively have changed the center of gravity of the invention compared to the invention as identified in Claim 1, filed on 28 January 1991. This first revised claim was a result of the Examining Division's criticism put forward in the first communication. Up until the oral proceedings, this claim had been amended a couple of times in principle only in order to improve the clarity of - and to remove certain deficiencies from - the claim.

As has been said above, Claim 1 corresponds in principle to the original Claims 14, 15 and 17. It is observed that the Examining Division in its first communication stated that the subject-matter of Claim 14, like that of Claim 1, lacked novelty. Moreover, it said that the dependent claims appended to independent Claim 14 added nothing inventive to the subject-matter of Claim 14. With regard to the subject-matter of Claim 17, reference was made to column 36, lines 51 to 60, in D1, wherein it is disclosed that a LED is actuated in the known arrangement to show that all tracks of the recording medium have been used.

Having regard to the subject-matter of original Claim 15, it was noted in the said communication that the teaching of D1, column 36, "discloses means for finding the first empty recording track whereupon recording then follows". The Examining Division went on to make the following sweeping statement: "which switches, and how they are used

in order to carry out the recording function is a simple matter of choice for the person skilled in the art without the exercise of inventive step".

Thus the Examining Division expressed the opinion that the said features of original Claims 15 and 17 do not add anything inventive to Claim 14. However, the Board considers that this opinion is open to question and must be carefully verified.

To the Board, it appears that the part of D1 referred to by the Examining Division (column 36) describing how to find the empty track relates to an automatic method to return the recording/reproducing head to the track from which the operation started (e.g. track No. 10) after having reproduced the picture on a preceding track (e.g. track No. 6). It is hard to understand how the skilled man with the information and argumentation given in the communication could arrive at the electronic still camera according to new Claim 1, which claim, as the heart of the invention, identifies a manual switch which has two different depression levels and which co-operates with other units of the camera in a specific way.

It therefore appears that an exhaustive investigation must be made to find out whether the subject-matter of new Claim 1 would really be obvious to a skilled person or not (in that respect the Board notes that also D1, in fact, discloses a release button - reference numeral 312, Figure 8a - which apparently has different depression levels - see e.g. column 17, lines 28 to 36, although the functions controlled are different from those controlled by the switch according to Claim 1). Also the argumentation and the statements concerning the alleged advantages of the invention made by the Appellant must be taken into account and if necessary investigated.

3. In order to avoid loss of an instance, the Board makes use of its power under Article 111(1) EPC to remit the case to the first instance for further prosecution on the basis of the main request.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution of the application on the basis of the main request.

The Registrar:



M. Kiehl

The Chairman:



P.K.J. van den Berg

28/9 RR
OO
5.10
03625