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D E C I S I O N
of 14 May 1998

Case Number: T 0414/94 - 3.4.2
Application Number: 88100066.5
Publication Number: 0293543
IPC: G03G 15/01, G03G 15/00

Language of the proceedings: EN

Title of invention:
Image duplicating apparatus

Patentee:
Minolta Co., Ltd.

Opponent:
Avabridge Limited

Headword:
Right to comment/MINOLTA

Relevant legal provisions:
EPC Art. 84, 113(1), 123(2)

Keyword:
"Claims - clarity (no)"
"Amendments - inadmissible selection (yes)"
"Basis of decisions - right to comment for absent party"

Decisions cited:
G 0009/92, G 0004/92, T 0133/92

Catchword:
There is no general prohibition of amending requests during a party's absence from oral proceedings as requested by the respondent. An absent party must expect reactions of the opposing party within the legal and factual framework of the case established prior to oral proceedings, and the possibility of decisions taking account of, and being based on, such reactions (see reasons 2).



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Chambres de recours

Case Number: T 0414/94 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 14 May 1998

Respondent:
(Opponent)

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Decision under appeal: Interlocutory decision of the Opposition Division of the European Patent Office posted 18 March 1994 concerning maintenance of European patent No. 0 293 543 in amended form.

Composition of the Board:

Chairman: E. Turrini
Members: S. V. Steinbrener
M. Lewenton

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Summary of Facts and Submissions

- I. The appellant (= patent proprietor) lodged an appeal against the interlocutory decision of the Opposition Division finding European patent No. 0 293 543 as amended on the basis of an auxiliary request to meet the requirements of the EPC, while not allowing the main request.

The opposition was filed against the patent as a whole, referring to Article 100(a) and (c) EPC respectively, since the subject-matter of the patent in suit allegedly lacked novelty and an inventive step, and extended beyond the content of the application as filed.

In its decision, the Opposition Division held that the subject-matter of claim 1 according to the main request was not novel with respect to GB-A-2 101 840 (= document D6 in the numbering of the Opposition Division).

The subject-matter of claim 1 according to the auxiliary request was, however, found allowable with respect to the available prior art.

- II. Oral proceedings were appointed at the appellant's auxiliary request. In the communication of 3 March 1998 pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal, the Board expressed its concern under Articles 123(2) and 84 EPC about the amended version of claims then on file, and did not consider it possible to address the issue of patentability in view of the admissibility and clarity problems.

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III. In response to said communication, the appellant filed a set of revised claims on 14 April 1998, against which no objections were raised by the respondent (= opponent) as was pointed out in its letter dated 30 April 1998.

The respondent further indicated that it did not intend to be represented at the oral proceedings. In these circumstances, the appellant should however not be permitted to change its requests during the oral proceedings since the respondent would not then have an opportunity to comment on any such changed requests.

Despite the appellant's opinion, as expressed in the letter of 12 May 1998, that oral proceedings might no longer be necessary in view of the respondent's statement, the Board considered oral proceedings to be expedient in the present case for the reasons set out in the above communication.

IV. Oral proceedings then took place on 14 May 1998 in the respondent's absence. At the end of the oral proceedings, the decision of the Board was pronounced.

V. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the new claims (main request) submitted during the oral proceedings.

If the appeal was not considered allowable, then, of course, the patent should be maintained with the amendments shown in the annexes to the interlocutory decision of the Opposition Division. This was referred to as an "auxiliary request" although it was clear from decision G 9/92 (OJ EPO 1994, 875) of the Enlarged Board of Appeal that the maintenance of the patent as amended in accordance with the interlocutory decision may not be challenged under the present circumstances.

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VI. Claim 1 now under consideration reads as follows:

- "1. An image duplicating apparatus including
- (a) means (204, 224, 242) for designating a first and second localized areas (AREA1 AREA2) of a document sheet bearing a visible image, said first area having preference over said second area,
 - (b) input means (246, 248, 250) for entering copy conditions relating to the formation of images lying inside the first localized area (AREA1), inside the designated second localized area (AREA2) and outside the first and second localized areas (OUTSIDE), respectively, and
 - (c) image reproducing means for duplicating the thus designated image areas of the document onto a single copy sheet selectively from the first localized area of the document in accordance with the condition related to the first localized area, from the second localized area of the document in accordance with the condition related to the second localized area, and from the area outside the first and second localized areas of the document in accordance with the condition related to the outside of the first and second localized areas,
wherein
 - (d) the designating means (204, 224, 242) are arranged to enable the designation of said first area (AREA1) and said second area (AREA2) in the case, where the second area is entirely enclosed in the first area,
said image duplicating apparatus further including
 - (e) determination means for determining whether or not the second area (AREA2) is entirely enclosed in the first area (AREA1) and,

- (f) means responsive to said determining means for changing the preference, so as to give priority to the second area if it is entirely enclosed in the first area, such that said image reproducing means duplicates the images on the whole area of said document onto a single face of the copy sheet
- from the second area of the document in accordance with the copy condition related to the second area,
 - from the area inside the first area and outside the second area of the document in accordance with the copy condition related to the first area, and
 - from the area outside the first area of the document in accordance with the condition related to the outside of the first and second areas, and that
- (g) the copy conditions to be entered by said input means include three different modes of copying operation."

Claim 2 is appended to claim 1.

VII. The appellant argued as follows:

Claim 1 on which the interlocutory decision of the Opposition Division is based, has been overly restricted in two respects by

- (i) rigidly defining the succession and order in which the first and second localised areas are designated in feature (a) of the claim; and
- (ii) possibly not covering the embodiment in accordance with Figure 11B of the patent specification due to the wording of feature (f) of the claim.

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As regards restriction (i), it does not appear necessary to always enter the first area before the second area. A skilled person would readily conclude from the original disclosure (see Figures 5/6 and 51/57 and the associated text), that entering of AREA1 data could also be skipped in a first data input cycle and could then be carried out retroactively in a second data input cycle after having entered the AREA2 data in the first cycle so that, in fact, the AREA1 and AREA2 data have been designated in a different sequence and order than that provided in feature (a) of said claim. Nevertheless, in this case both areas are also well-defined in that they have been correctly attributed to their respective AREA1 and AREA2 memory sites which is the only important aspect deciding on copying priority.

Furthermore, as can be seen from Figure 11B and associated text, overlapping parts of the second and first areas are not necessarily duplicated in accordance with feature (f) of the above-mentioned claim, i.e subject to the copy condition related to the first area. On the contrary, the copy conditions of the "zones" defined in the so-called single-cycle two-coloured mode with the aid of the slide member may overrule the AREA1 priority in the overlap region. This copying mode is optionally available in addition to the edited mode of copying operation and might be considered to form an integral part of the edited mode.

In new claim 1, these undue restrictions have been removed by deleting the order in which data are entered in feature (a), however specifying the priority between both areas. New feature (a) is further explained by new feature (f) referring to the fact that the preference

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is changed if the second area is entirely enclosed in the first area. The different duplication modes clearly follow from the latter feature if no further settings are carried out. Such further settings are, however, not excluded by claim 1.

Reasons for the Decision

1. *Admissibility of appeal*

The present appeal is admissible.

2. *Admissibility of amendments in the respondent's absence from oral proceedings*

2.1 In the letter dated 30 April 1998, the respondent communicated its intention not to attend the scheduled oral proceedings, and requested that no changes of the appellant's requests should be allowed during the oral proceedings in the respondent's absence since otherwise the respondent would not have an opportunity to comment on any such changed requests (see item III above).

2.2 Having regard to an absent party's right to comment, the Enlarged Board of Appeal has ruled in its opinion G 4/92 (OJ EPO 1994, 149) that "a decision against a party who has been duly summoned but who fails to appear at oral proceedings may not be based on facts put forward for the first time during those oral proceedings. Similarly, new evidence may not be considered unless it has been previously notified and it merely supports the assertions of the party who submits it, whereas new arguments may in principle be used to support the reasons for the decision."

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2.3 From this finding, it can be concluded that there is no general prohibition of amending requests during a party's absence from oral proceedings as requested by the respondent. An absent party must expect reactions of the opposing party within the legal and factual framework of the case established prior to oral proceedings, and the possibility of decisions taking account of, and being based on, such reactions. What has been excluded by the Enlarged Board of Appeal is the possibility of taking decisions against the absent party on the basis of a surprising course of events at the oral proceedings, which changes the legal and factual framework of the case in an unforeseeable way (see e.g. T 133/92, unpublished).

2.4 In the present case, detailed objections under Articles 84 and 123(2) EPC have been raised in the Board's communication of 3 March 1998 against the version of claims then on file, and it was apparent that claim 1 filed in response to said communication before the oral proceedings did not overcome all of these objections. Therefore, a discussion of, and possibly further amendments to, the claims in this respect had to be expected at the oral proceedings, and a decision may be based on such amended claims in the respondent's absence without infringing Article 113(1) EPC.

Moreover, the present decision does not appear to be against the absent respondent.

3. *Article 84 EPC*

3.1 In the Board's view, claim 1 offends against Article 84 EPC in that the expression in feature (a) "said first area having preference over said second area" is not clear.

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In particular, it is not apparent from the claim in which respect one area is preferred to the other and what "preference" generally means in the present context. Although feature (f) of the claim refers to a change of the "preference" in the specific configuration of AREA2 being entirely enclosed in AREA1, this change leading to a priority of the second area with respect to the copying conditions, the meaning and scope of "preference" in configurations different from said specific one is left open.

3.2 On the other hand, if - as suggested by the appellant - the subject matter of claim 1 were interpreted such that in any other relationship of both areas AREA1 is given priority over AREA2 with respect to copying conditions, then the result aimed at by the appellant, i.e. the inclusion of the embodiment according to Figure 11B, would not seem to be reached since in the case of partial overlap of both areas duplication in analogy to feature (f) of new claim 1 with AREA1 having "preference" over AREA2 inevitably leads to the embodiment of Figure 11A only.

3.3 Moreover, the Board would like to add that it is at least doubtful whether the appellant's problem in view of the above restriction (ii) does not also exist with respect to the wording of feature (f) of new claim 1 since the original application documents seem to indicate that the copying conditions of the single-cycle two-coloured mode always overrule the conditions set in the edited mode of operation, i.e. also in the case of AREA2 lying fully within AREA1 and the slide member position crossing both areas (see the application as filed, in particular page 35, second half of first paragraph).

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3.4 Thus, in the Board's view the wording of claim 1 lacks clarity and if interpreted in accordance with the appellant's suggestions would not meet the appellant's expectations so that these suggestions do in no way clarify the situation.

4. *Article 123(2) EPC*

4.1 The subject matter of original claim 1 related to the designation of one localised area only and therefore did not address any conflict issues arising from the reproduction of two different overlapping localised areas for which different copy conditions have been entered.

4.2 When aiming to restrict the original claim by specifying a priority concept with respect to such conflict situations, the following teaching can be derived from the application documents as filed:

(A) The so-called "first" area (AREA1) is the area the coordinate data of which are entered **first**. The so-called "second" area (AREA2) is the area the coordinate data of which are entered **second**, i.e. **after** the data of the first area. Apparently, no modifications of this sequence and relationship are provided (see the original application documents, in particular page 26, last paragraph - page 27, first paragraph and Figure 6: entry of data requested by successive illumination; page 33, last paragraph and Figure 10A: numerical data of AREA2 entered after those of AREA1; page 49, second paragraph and Figures 17, 19 and 57: input of AREA1 data before input of AREA2 data).

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- (B) According to Figures 10 - 12, the following priority "rules" prevail in the edited mode of operation (i.e. without making use of the additional option of said single-cycle two-coloured mode of operation):

If AREA1 and AREA2 are separate...
then there will be separate duplication according to the respective conditions (see Figure 10A).

If AREA1 and AREA2 overlap...
then the copying condition of AREA1 takes precedence in the overlap region (see Figure 11A).

If AREA2 is wholly within AREA1...
then the copying condition of AREA2 takes precedence in AREA2 (see Figure 12).

- (C) These rules are confirmed by Figure 24 and associated text, underlining that the copying condition of AREA1 takes precedence over the condition of AREA2 **except** when AREA2 is wholly within AREA1 (see page 57, last line to page 58, first paragraph of the original application documents).

4.3 Since no other priority concept has been originally disclosed, the Board considers the above rules to constitute the essential set of features to be included in any such restriction of claim 1 after the filing date.

4.4 The subject matter of present claim 1 offends against Article 123(2) EPC in that

- the sequence and order of data input determining the respective first and second areas and associated priorities (see items (A) and (B) above) has not been specified; and
- from the priority "rules" (see items (B) and (C) above) only the exceptional one concerning the specific configuration "AREA2 wholly within AREA1" has been clearly defined (see the arguments given above in item 3 with respect to clarity).

4.5 The appellant's arguments in this context are not considered convincing:

Although AREA1 (or AREA2) may be cancelled if only designation of a single localised area is desired in the edited mode of operation (see e.g. page 34, first paragraph of the original application documents), there is no direct and unambiguous disclosure in the original application documents that this possibility might be used to enter the data of the area cancelled in a first data input cycle, e.g. AREA1, in a subsequent data input cycle while keeping the data of the other areas, e.g. AREA2 and OUTSIDE, entered in said first data input cycle so that the respective areas for one and the same duplication operation have in fact been entered in a different sequence. In particular, such a teaching cannot be derived from the Figures referred to by the appellant, which consistently disclose the sequence set out in item (A) above in combination with the possibility of cancelling one area.

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Furthermore, an arbitrary selection of the priority rule concerning the exceptional situation of "AREA2 wholly within AREA1" from the general set of priority rules originally disclosed in combination is neither justified nor would it solve the appellant's problem with respect to restriction (ii) as has already been pointed out above (see item 3).

5. In consequence, the Board does not consider claim 1 to be allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

E. Turrini

