



Case Number: T 0218/95 - 3.4.2

**D E C I S I O N**  
of 11 November correcting errors in the decision  
of the Technical Board of Appeal 3.4.2  
of 18 September 1997

**Appellant:**  
(Opponent) Hannenman, Henri W., Dr.  
Océ-Technologies B.V.  
Patents & Information  
St. Urbanusweg 43  
P.O. Box 101  
5900 MA Venlo (NL)

**Representative:** Hanneman, Henri W., Dr.  
Océ-Technologies B.V.  
Patents & Information  
St. Urbanusweg 43  
P.O. Box 101  
5900 MA Venlo (NL)

**Respondent:**  
(Proprietor of the patent) Eastman Kodak Company  
(a new Jersey corporation)  
343 State Street  
Rochester  
New York 14650 (US)

**Representative:** Blickle, K. Werner, Dipl.-Ing.  
Kodak Aktiengesellschaft  
Patentabteilung  
70323 Stuttgart (DE)


**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 19 January 1995  
revoking European patent No. 0 343 185 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** E. Turrini  
**Members:** M. Chomentowski  
M. Lewenton

In application of Rule 89 EPC page 1, point II, line 7 of the decision in the appeal case T 218/95 - 3.4.2 is corrected by inserting "division" after the word "Opposition" and page 3, point 2, lines 2 and 7 by substitution of "respondent's" for "appellant's".

The Registrar:



P. Martorana

The Chairman:



E. Turrini

BESCHWERDEKAMMERN  
DES EUROPÄISCHEN  
PATENTAMTS

BOARDS OF APPEAL OF  
THE EUROPEAN PATENT  
OFFICE

CHAMBRES DE RECOURS  
DE L'OFFICE EUROPEEN  
DES BREVETS

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen

**D E C I S I O N**  
**of 18 September 1997**

**Case Number:** T 0218/95 - 3.4.2  
**Application Number:** 88901681.2  
**Publication Number:** 0343185  
**IPC:** G03G 15/00, G03G 15/01

**Language of the proceedings:** EN

**Title of invention:**

Electrostatographic method and apparatus for producing  
multicolor duplex reproductions

**Patentee:**

Eastman Kodak Company (a New Jersey corporation)

**Opponent:**

Océ-Nederland B.V.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 56

**Keyword:**

"Inventive step: after amendment, yes"

**Decisions cited:**

-

**Catchword:**

-



Case Number: T 0218/95 - 3.4.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.2  
of 18 September 1997

**Appellant:**  
(Opponent)

Hanneman, Henri W., Dr.  
Océ-Technologies B.V.  
Patents & Information  
St. Urbanusweg 43  
P.O. Box 101  
5900 MA Venlo (NL)

**Representative:**

Hanneman, Henri W., Dr.  
Océ-Technologies B.V.  
Patents & Information  
St. Urbanusweg 43  
P.O. Box 101  
5900 MA Venlo (NL)

**Respondent:**  
(Proprietor of the patent)

Eastman Kodak Company  
(a new Jersey corporation)  
343 State Street  
Rochester  
New York 14650 (USA)

**Representative:**

Blickle, K. Werner, Dipl.-Ing.  
Kodak Aktiengesellschaft  
Patentabteilung  
70323 Stuttgart (DE)

**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office posted 19 January 1995  
rejecting the opposition filed against European  
patent No. 0 343 185 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** E. Turrini  
**Members:** M. Chomentowski  
M. Lewenton

## Summary of Facts and Submissions

- I. The appellant (opponent) filed an opposition against European patent No. 0 343 185, which had been granted on the basis of the European patent application No. 88 901 681.2, on the grounds that the subject-matter of the patent lacked an inventive step.
- II. The patent was maintained in amended form with 7 claims, whereby claim 1 was directed to a method of producing single pass multicolor duplex reproductions, claims 2 and 3 were dependent method claims, claim 4 was directed to an apparatus for performing the method of claim 2, and claims 5 to 7 were dependent, directly or indirectly, from claim 4. The Opposition found that the subject-matter of the patent was not rendered obvious by the state of the art.
- III. The appellant (opponent) lodged an appeal against this decision and filed further prior art documents.
- IV. During the oral proceedings of 18 September 1997, which had been requested auxiliarily by the appellant, the Board of appeal pointed out the objections made by the appellant in his last written observations and concerning the interpretation of the matter covered by the text of claim 1 as maintained by the Opposition Division, and expressed the opinion that said claim 1 appeared not to contain all the features essential to the performance of the invention and thus to lack clarity. The respondent (proprietor of the patent) then provided a new request with a set of 6 claims whereby in particular the additional step of claim 2 as maintained by the impugned decision was added at the end of claim 1 of said decision to form new claim 1, and requested that the patent be maintained on this basis.

The appellant did not put any request in this respect.

The only independent claims of respondent's request, i.e. claims 1 and 3, reads as follows:

"1. A method of producing single pass multicolor duplex reproductions comprising:

forming a plurality of electrostatic images on an insulating member;  
toning said images with toners of different colors;  
transferring, in registration, said toner images to an intermediate member to form a first multicolor toner image;  
transferring said first multicolor toner image to the first side of a copy sheet;  
repeating the first three steps to form a second multicolor toner image on said intermediate member;  
transferring said second multicolor toner image to the second side of said copy sheet and  
simultaneously fixing said first and second toner images to the copy sheet."

"3. Apparatus for performing the method of claim 1 comprising:

means (2, 3) for forming a plurality of electrostatic images on an insulating member (1);  
means (4, 5, 6, 7) for toning said images with toners of different colors, respectively;  
an intermediate member (8);  
means for transferring, in registration, a first set of toner images to said intermediate member to form a first multicolor toner image and for transferring, in registration, a second set of toner images also having different colors to said intermediate member to form a second multicolor image;  
a first transfer station (9) for transferring said

first multicolor toner image to the first side of a copy sheet;  
a second transfer station (10) for transferring said second multicolor toner image to the second side of a copy sheet;  
means for feeding said copy sheet to said first transfer station (9), for inverting said copy sheet without disturbing said first toner image after said copy sheet has received said first toner image, and for feeding said copy sheet to the second transfer station (10), means (13) for simultaneously fixing said first and second toner images to said copy sheet; and  
means for feeding said copy sheet to the fixing means without disturbing the toner images."

### Reasons for the Decision

1. The appeal is admissible.
2. *Requirements of the Convention*

The requirements of the Convention are satisfied by appellant's request. In particular, the subject-matter of each of the main claims is neither known nor rendered obvious by the state of the art. This has not been contested by the appellant.

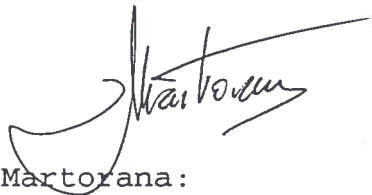
Therefore, the patent can be maintained on the basis of appellant's request (Article 102(3) EPC).

**Order**

**For these reasons it is decided that:**

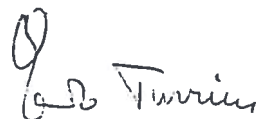
1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division with the order to maintain the patent in amended form on the basis of the new set of claims 1 to 6 submitted during oral proceedings of 18 September 1997, the drawing of the patent specification as granted, and the description to be adapted.

The Registrar:



P. Martorana:

The Chairman:

  
E. Turrini