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D E C I S I O N
of 8 June 1999

Case Number: T 0347/97 - 3.5.1

Application Number: 90915023.7

Publication Number: 0450013

IPC: H04N 1/21

Language of the proceedings: EN

Title of invention:

Reproduction apparatus operation during malfunction recovery

Patentee:

Eastman Kodak Company

Opponent:

Océ-Nederland B.V.

Headword:

-

Relevant legal provisions:

EPC Art. 52(1), 56, 114(2)

Keyword:

"Late-filed document (not admitted)"
"Inventive step (yes)"

Decisions cited:

-

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0347/97 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 8 June 1999

Appellant: Océ-Nederland B.V.
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 16 January
1997 concerning maintenance of European patent
No. 0 450 013 in amended form.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: A. S. Clelland
M. J. Vogel

Summary of Facts and Submissions

I. This is an appeal against the Opposition Division's decision to maintain European patent No. 0 450 013 in amended form. The opponent, the present appellant, had filed an opposition on the ground that the claims lacked an inventive step having regard, *inter alia*, to the disclosure of the following document:

D6: GB-A-1-531 401.

II. The appellant appealed this decision and requested that the patent be revoked; an auxiliary request was made for oral proceedings.

The respondent (proprietor) requested that the appeal be dismissed and also made an auxiliary request for oral proceedings.

III. In the statement of grounds of appeal the appellant referred to a document not previously discussed in the proceedings:

D7: JP-A-62-135069

A translation into English of D7 was also submitted. The appellant asked that D7 be admitted into the proceedings because of its relevance.

IV. Oral proceedings were held on 8 June 1999. At these proceedings the appellant argued that D7 was so relevant as to prejudice maintenance of the patent, in that the subject-matter of claim 1 lacked an inventive step having regard to the disclosure of D7. The

patentee had had sufficient time to consider the document and to present comments. It was in the interests of the EPO that only valid patents be granted and D7 should therefore be admitted to the proceedings.

- V. It was also argued that the subject-matter of claim 1 lacked an inventive step starting out from the disclosure of D6. This document disclosed the features of the preamble of claim 1 and taught the decoupling of the scanning and printing processes. It was clear from various passages, particularly those describing the buffer memories, that when scanning stopped it was possible for printing to continue. D6 was a very early document, being dated 1978, and disclosed a system quite different to the then known analog systems in which there was no possibility of decoupling the scanning and printing processes. The skilled person, aware of the D6 apparatus and faced with a scanning malfunction, would be aware that because of decoupling a scanning error was no longer fatal. It was obvious to take advantage of this to continue printing until the memory was entirely empty. There were only two possibilities as to when printing could be stopped: either up to, or including, the affected page. Since a partial page would be useless and require to be removed, it would be obvious for the skilled person to print up to this page and then stop.

Although the preferred embodiment of D6 disclosed memories which could not read and write at the same time, the Figure 4 embodiment disclosed such a memory. The skilled person, applying the common general knowledge at the priority date of the patent in suit, would have had available suitable read/write memories

in order to carry into effect the Figure 4 embodiment and provide full decoupling between scanning and printing.

Moreover, it was known in the context of fax apparatus to decouple scanning and printing. D2 showed a device which could still receive data even if the printer portion had jammed; applying this to D6 merely involved what was in effect a "kinematic inversion".

VI. The respondent argued that D7 should not be admitted because it was not relevant. In D7 a malfunction resulted in deletion of all data except address data. As for D6, this document made no mention of any kind of malfunction and discussion as to what would happen in the event of one was pure speculation. There were many ways in which shutdown in the event of a malfunction could be accomplished other than the two proposed by the appellant. D2 related to a fax machine rather than a copier and dealt with a malfunction in the writing rather than the signal generating means. There was no reason why the skilled person would combine the teaching of D2 with that of D6. Even if such a combination were considered obvious it would not lead to the claimed invention, since a "kinematic inversion" was necessary to deal with a malfunction in the signal generating means rather than in the writer means as disclosed in D2.

VII. Claim 1 as amended in the course of the opposition proceedings reads as follows:

"1. Reproduction apparatus for multiple page originals, said apparatus comprising:

- A. means (14, 16) for generating a series of electrical signals representative of the image content of a plurality of original pages
 - B. an electronic multiple page buffer memory (64) for receiving and storing such a series of electrical signals;
 - C. means for writing such a series of electrical signals to said memory
 - D. writer means (74, 76) responsive to applied electrical signals for forming images on receiver sheets;
 - E. a processing unit (65, 66) for reading stored signals from the multiple page buffer memory in a predetermined page sequence, and for applying such signals to said writer means;
- characterized by: means operative upon the occurrence of a malfunction in said signal generating means for continuing operation of said writer means until the next page in the predetermined sequence, which is to be formed on said receiver sheets, and which has not been stored in said buffer memory."

Reasons for the Decision

- 1. *Late-filed documents (Article 114(2) EPC)*
 - 1.1 The appellant's statement of grounds introduces document D7 into the proceedings and raises an inventive step objection based on this document.
 - 1.2 Article 102(3) EPC confers jurisdiction on the Opposition Division, and hence on the Boards of Appeal, to decide whether an amended patent meets the

requirements of the EPC, whilst Article 114(1) EPC gives each Board the power to examine the facts of its own motion. According to Article 114(2) EPC however, facts or evidence which are not submitted in due time by the parties concerned may be disregarded.

- 1.3 It is the established jurisprudence of the Boards of Appeal that the main criterion for whether a document should be admitted or disregarded is its relevance, i.e. its likely bearing on the outcome of the case. It has accordingly been necessary for the Board to consider the content of D7 to determine whether it is of such relevance as to have a material bearing on the decision.
- 1.4 D7 deals with the problem of scanning malfunction in the context of a system employing on the one hand a scanner and on the other a printer. It solves this problem by deletion, in the event of a malfunction, of all scanning information which has been accumulated on a disk store. Only address information is retained. The invention as claimed on the other hand makes use of the accumulated information in order to continue printing ("continuing operation of said writer means", in the terms of claim 1). D7 therefore represents the simplest solution to the problem of scanner malfunction in that it invites the skilled person to re-scan *ab initio*. The subject-matter of the characterising part of claim 1 is not present in D7, nor is it suggested by it. Moreover, the Board cannot see any combination of D7 with D6 or any of the other documents cited in the course of the opposition proceedings which would lead the skilled person to the claimed invention. Applying the teaching of D7 to D6 would provide a mechanism in the D6 system

for dealing with a scanning malfunction, but it would do so by deletion of the stored data.

1.5 The Board therefore concludes that D7 should not be admitted to the proceedings.

2. *Inventive step*

2.1 It was common ground at the oral proceedings that the features of the preamble of claim 1 are known from D6. This document discloses a digital copier incorporating a document feeder, i.e. reproduction apparatus for multiple page originals, in which, referring to Figure 1, a CCD unit 22 generates a series of electrical signals representative of the image content of a plurality of original pages. By means of a memory controller 44 these signals are written into an electronic multiple page buffer memory 42, 43. A processing unit 37 reads stored signals from the multiple page buffer memory in a predetermined page sequence and applies them to a printer 62.

2.2 D6 is completely silent as to its operation in the event of a malfunction. Although by analogy with analog copiers the occurrence of a malfunction at any point in the system might be expected to cause immediate shutdown, it was argued by the appellant that D6 in fact teaches the skilled person that the scanning and printing process are decoupled from one another, so that when scanning stops because of a malfunction there is no reason why printing should not continue. The skilled person aware of the D6 apparatus and faced with a scanning malfunction would therefore appreciate that an error in scanning was not necessarily fatal to

printing and would permit printing to continue as long as the buffer memory contained data. The Board accepts this argument. Although it was argued by the respondent that any discussion of malfunctions of D6 must be speculative as the document makes no mention of the subject, it appears to the Board that the skilled person, faced with the appearance of a malfunction on the scanning side, would find it obvious to permit the printer to continue until all stored data had been read out. Although the respondent argued that the Figure 1 system of D6 required two memories because the individual memories could not be read from and written to simultaneously, it is clear from the description that this is a reflection of the memory technology at the priority date (1976) and the Figure 4 embodiment shows a read/write memory 120 which would permit this to be done.

2.3 However, claim 1 is more restricted than autonomous scanning and printing; the claim requires that when a malfunction occurs in the scanner the printer continues until the next page in the predetermined sequence which has not been stored in the buffer memory. Implicit in this feature is that in the event of scanner malfunction the page currently being scanned is not stored in the buffer memory. Such an arrangement has the advantage that there is no need for a user to search through the printed pages for a page containing partial data.

2.4 In the Board's view the skilled person would not be led by the disclosure of D6 to provide this additional facility. Although the scanning and printing portions of the apparatus appear sufficiently modular to

function independently in D6, the Board notes the Opposition Division's argument that both the start and end address of a page are generated and stored in read/write memory 41 at the beginning of a scan rather than generating an initial start signal and subsequently an end signal once the scan has been finished. This reading appears to be confirmed by the passage at page 2 line 115 to page 3 line 13, which suggests that the read buffers 35 and 36 are controlled by an up/down counter in read buffer controller 33 under the control of a clock 23 within the CCD unit. This suggests that in the absence of additional means the CCD unit will continue scanning once a start signal has been received from the shaft angle encoder 34 which provides the page sync signal. In other words, once the scanner commences operation, data will be fed into the memory even if a paper feed jam or other mechanical malfunction occurs.

2.5 The Board accordingly concludes that the subject-matter of claim 1 involves an inventive step having regard to the disclosure of D6.

2.6 The appellant also argued that D6, when read in the light of the disclosure of D2, would lead the skilled person to the claimed invention. D2 discloses a fax machine in which jamming of the recording paper does not cause the reception of data to be interrupted, the data being stored in a memory, see page 7 lines 48 to 52. It was argued by the appellant that the teaching of D2 that a malfunction of one part of a combined apparatus need not necessarily lead to interruption of operation of a further part of the same apparatus would, when applied to the D6 apparatus, lead the

skilled person to the claimed invention.

2.7 The Board does not consider that a combination of D2 and D6 leads to the claimed result. Even if for the sake of argument the skilled person were to find it obvious to apply teaching in the field of fax machines to a copier, D2 is concerned with the opposite case to that of the invention, namely a malfunction in the printing whilst scanning (in this case at a remote fax machine) continues. It is not clear that anything more could be derived from such a combination than the mere teaching that the component parts of the D6 copier are essentially autonomous, an argument which has been accepted. The combination of D2 with D6 would not lead the skilled person to the characterising feature of claim 1, namely stopping storage of the data after the last full page which has been scanned.

2.8 Nor, in the Board's view, do any of the other documents on the opposition file, whether considered individually or in combination with another document, lead to a conclusion different to that reached above with respect to D6 and D6 in combination with D2.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg