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(C) To Chairmen

D E C I S I O N
of 20 September 1999
correcting an error in the decision
of 11 June 1999

Case Number: T 0905/97 - 3.4.2

Application Number: 91201875.1

Publication Number: 0460772

IPC: G03G 15/00

Language of the proceedings: EN

Title of invention:

Apparatus for forming an image on a record medium

Patentee:

Seiko Epson Corporation

Opponent:

Canon Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 100(c), 76(1)

Keyword:

"Subject-matter of the patent based on a divisional application, extending beyond the content of the earlier (parent) application as originally filed"

Decisions cited:

G 0002/92, G 0004/93, T 0434/97, T 0206/93

Catchword:

-



Case Number: T 0905/97 - 3.4.2

D E C I S I O N
of 20 September 1999
correcting an error in the decision
of the Technical Board of Appeal 3.4.2
of 11 June 1999

Appellant:
(Opponent)

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Respondent:
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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 24 June 1997
concerning maintenance of European patent
No. 0 460 773 in amended form.

Composition of the Board:

Chairman: E. Turrini
Members: A. G. Klein
B. J. Schachenmann

In application of Rule 89 EPC the reference in the second paragraph of point 12.3 of the Reasons of the decision in the appeal case T 905/97 - 3.4.2 to an earlier decision of the Board, not published in the OJ EPO, is corrected by the substitution of "T 437/97" by "T 434/97".

The Registrar:

The Chairman:

M. Beer

E. Turrini

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 11 June 1999

Case Number: T 0905/97 - 3.4.2

Application Number: 91201876.9

Publication Number: 0460773

IPC: G03G 15/00

Language of the proceedings: EN

Title of invention:

Apparatus for forming an image on a record medium

Patentee:

Seiko Epson Corporation

Opponent:

Canon Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 100(c), 76(1)

Keyword:

"Subject-matter extending beyond the content of the earlier
(parent) application as originally filed"

Decisions cited:

G 0002/92, G 0004/93, T 0437/97, T 0206/93

Catchword:

-



Case Number: T 0905/97 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 11 June 1999

Appellant:
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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 24 June 1997
concerning maintenance of European patent
No. 0 460 773 in amended form.

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Members: A. G. Klein
B. J. Schachenmann

Summary of Facts and Submissions

- I. European patent No. 0 460 773 is based on European patent application No. 91 201 876.9, a divisional application of European patent application No. 87 302 839.3 (publication No. 0 240 337) which in this decision will be quoted as "the parent application".

The parent application itself claimed priority from four Japanese patent applications, and it comprised five independent claims directed to different aspects.

A second divisional application of the same parent application matured into a European patent, opposed by the same opponent, which is now the subject of appeal case T 906/97.

A further divisional application of the present divisional application also matured into a European patent, opposed by the same opponent, which is now the subject of appeal case T 904/97.

- II. The present divisional application as originally filed comprised a description and drawings which had been substantially amended, as compared to those of the original parent application. The drawings no longer comprised the embodiments of Figures 1 to 4 of the parent application, and passages which in the parent description referred to the cancelled figures were taken over to the divisional application in conjunction with the description of the remaining figures.

During examination, in order to overcome an objection by the Examining Division that the so amended description no longer adequately supported the claims,

substantially the whole original description and drawings of the parent application were re-introduced into the divisional application.

III. An opposition was filed against the patent as so granted, on the grounds that the claimed subject-matter was not new within the meaning of Article 54 EPC, in view of the contents of document

D1: DE-A-3 401 940

and that it lacked an inventive step within the meaning of Article 56 EPC in view of the contents of document D1 considered in conjunction *inter alia* with the following further citations:

D2: JP-A-61 051 160

D6: JP-A-61 056 371.

Further grounds for opposition under Article 100(b) EPC (insufficiency of the disclosure) and under Article 100(c) EPC (inadmissibility of the later introduction into the description of the divisional application of elements disclosed only in the parent application) were invoked after expiry of the period for filing opposition, together with a number of additional citations, amongst which the documents

D9: JP-A-59 042 304, and

D15: Toshiba Technic Publication Collection
No. 83-1142.

IV. The Opposition Division, having in particular admitted into the procedure the grounds for opposition based on Article 100(c) EPC and document D9 but neither the

grounds for opposition under Article 100(b) nor document D15, issued an interlocutory decision by which it maintained the patent in amended form, i.e. with an amended version of the description and drawings no longer comprising the embodiments of Figures 1 to 4 of the parent application as filed and with the claims as granted.

- V. The appellant (opponent) lodged an appeal against the interlocutory decision.
- VI. Oral proceedings were held on 6 May 1999, which is the day after the oral proceedings held in case T 906/97 (see point I, supra). For the sake of conciseness a number of issues relevant both to the latter and to the present case were presented by the parties by referring to the submissions already made during the previous oral proceedings.

At the end of the present proceedings the chairman of the Board declared the debate closed, so that no further submissions would be accepted, and he announced that the decision would be given in writing.

- VII. The appellant requested that the decision under appeal be set aside and that the European patent No. 0 460 773 be revoked.
- VIII. The respondent (patentee) requested that the appeal be dismissed and that the patent be maintained in amended form with the claims according to the main request or one of the auxiliary requests I to XVII, all filed during the oral proceedings, with the description and drawings as maintained by the Opposition Division.

Claim 1, the only independent claim in accordance with the main request reads as follows:

"1. Apparatus for forming an image on a record medium comprising a housing (23, 25) having a front, a rear, a top, a bottom and two sides; transport means (10, 13) for causing a record medium to be transported along a transport path, within the housing (23, 25) so as to be discharged therefrom; and image-imparting means (1, 2 and 6), including a rotary image-receiving member (1), within the housing (23, 25) for imparting the image to the record medium while the latter is on the transport path, the housing (23, 25) having an immovable part (25) and a movable part (23) and being characterised by:

the movable part (23) being at the front of the housing,

the movable part being pivotable about an axis parallel to that of the image-receiving member (1) so that the movable part (23) can be moved between open and closed positions in which direct access to the transport path is respectively permitted and prevented;

the arrangement being such that when the movable part (23) is in the closed position, the transport path is in contact both with the movable part (23) and the immovable part (25),

and that the apparatus is arranged such that the record medium is discharged therefrom with the said image face down."

The only independent claim in each of the auxiliary requests I to XIV comprises the features of claim 1 of the main request, with the following additional limitations:

Claim 1 of auxiliary request I further specifies that the record medium is discharged with the said image face down "having moved from the transport means (13) after receiving the image about one centre of curvature only".

Claim 1 of auxiliary request II further specifies that the transport path includes an opening in the said top and that the movable part (23) includes the portion of the said top from the front to the said opening.

Claim 1 of auxiliary request III further specifies that the apparatus is provided with a cartridge provided with the image-receiving member (1) and the cleaning device (6).

Claim 1 of auxiliary request IV further specifies that "the apparatus is arranged such that access space for insertion and discharge of the record medium and the said access to the transport path and image-receiving member (1) is only required at the front and top sides of the apparatus".

Claim 1 of auxiliary requests V to XIV each further specifies various combinations of the additional limitations brought to claim 1 by the features referred to in connection with auxiliary requests I to IV.

As an auxiliary request XV it is requested "that the patent be maintained on the basis of the main request with claim 1 thereof further amended by the addition of any one or more of claims 2 to 10 as granted, with consequential renumbering of the remaining claims".

As an auxiliary request XVI it is requested "that the patent be maintained on the basis of the main request with claim 1 amended as in any of auxiliary requests I to XV plus any one or more of claims 2 to 10 as granted, with consequential amendments to the renumbering of the remaining claims".

As an auxiliary request XVII it is requested "that the patent be maintained on the basis of the main request with claim 1 thereof amended in accordance with the addition of the features of claim 1 of all of the combination of auxiliary requests I, III and IV, with consequential amendments to the renumbering of the remaining claims as may be necessary".

The respondent further requested that the following point of law be referred to the Enlarged Board of Appeal (request A):

"Does Article 100(c), which has two parts separated by the word "or" require a divisional application to meet both parts of Article 100(c) or only to meet the second part thereof."

The respondent also requested that the case be remitted to the Opposition Division for further prosecution, should the Board admit the late-filed citation D15 into the procedure (request B).

- IX. The arguments put forward by the appellant against the admissibility of the amendments made to the claims can be summarized as follows:

The parent application as filed described seven separate, non-unitary arrangements covered by different independent claims, which neither achieved any common technical effects nor solved any single technical problem. Rather than merely pursuing one of these

arrangements, the divisional application on which the present patent was based and, accordingly, the patent itself were directed to a new combination of features which did not correspond to any of the originally described arrangements. This new combination was not even implicitly disclosed in the original parent application. Neither was there any indication or suggestion in the parent application as filed that this new combination was essential to the disclosed invention.

In particular, the independent claims of the parent application as filed explicitly recited a casing with a paper insertion opening and a paper discharge opening, and a paper transport path extending from the former to the latter. The original description, in connection in particular with the discussion of the disadvantages of the prior art arrangements of Figures 13 and 14, also stressed the merits of the invention in terms of a reduction of the number and extent of the bends which the paper had to follow between both openings, and of an overall shortening of the transport path itself. Claim 1 of the respondent's various requests did not however include any corresponding limitations. It thus encompassed new arrangements, which in particular did not comprise any paper insertion opening and thus could instead be provided with a paper storage box located inside the casing. Such arrangements were not, however, originally disclosed.

Moreover, as a result of the deleting during the opposition procedure of several figures contained in the parent application as filed, the present version of the description now comprised a number of passages by which features disclosed originally only with reference to the arrangements of these figures were ascribed for the first time to the other arrangements as disclosed with reference to the remaining drawings.

Claim 1 of the respondent's various requests - insofar it required the transport path to be "in contact both with the movable part (23) and the immovable part (25)" - also extended beyond the subject-matter of the divisional application as filed, in contravention of Article 123(2) EPC. The divisional as filed in this respect only disclosed that the transport path ran between both parts (see claim 1), and that the transfer and fixing devices (5, 11) constituted an integral part of the movable part (see page 18, 3rd paragraph).

With respect to the patentability of the subject-matter of claim 1 of the main request the appellant first questioned the ability of the expression "front" of the casing to express any clear limitation, for it was merely a matter of convention to consider any side of a casing as its front portion. Since claim 1 stated that the movable part was at the front of the housing, any side comprising such a movable part should be considered as forming the front within the meaning of claim 1. Accordingly, the apparatus of Figure 1 of document D9 with the door, i.e. the movable part, at the left side of the figure considered as its front, exhibited all the features of claim 1. The subject-matter of this claim therefore lacked novelty within the meaning of Article 54 EPC.

The subject-matter of claim 1 of the main request also lacked an inventive step within the meaning of Article 56 EPC in view of the nearest prior art as constituted by the apparatus disclosed in document D1.

The apparatus of document D1 indeed comprised both an inner and an outer door (44, 50) but from the paragraph bridging pages 22 and 23 of the description relating to the opening procedure, it was clear that these doors

were so linked that opening the outer door automatically caused opening of the inner door, thus forming a movable part giving direct access to the transport path within the meaning of claim 1.

Thus, the apparatus set out in the claim was distinguished from the nearest prior art in particular in that it achieved discharge of the recording medium with the image facing down rather than up. Face-down delivery of printed documents, and its advantage in avoiding the need for rearranging documents consisting of successively printed pages, were however well known in the art, as was evidenced for instance by document D4. Obviously, to achieve the same type of face-down discharging of the sheets of paper in the apparatus of document D1 the skilled person would only have to tilt the receiving tray 38 for the printed sheet as shown in Figure 5 of D1 towards the left side. It would then also be obvious to re-design the right side of the apparatus shown in the figure, which already gave access to the receiving tray and to the transport path through the door 50, so that it also permitted the filling of the cassette 35 for the blank sheets and thus actually formed the front of the apparatus. Accordingly, the claimed arrangement constituted an obvious solution to the objective technical problem of improving the handiness of the known apparatus.

The claimed arrangement actually resulted from mere juxtaposition of very common features, and it could just as well be derived from a combination of the teachings of document D1 with either of documents D2 or D6.

- X. These arguments were contested by the respondent, who submitted first that in the case of a patent granted on the basis of a divisional application the grounds for

opposition under Article 100(c) EPC **only** prohibited extension of its subject-matter beyond the content of the **parent** application as filed.

In his view the conjunction "or" in the article was to be read in its disjunctive meaning. Consequently only the second part of the alternative was applicable in the case of a patent granted on the basis of a divisional application, whilst the first part, referring to the subject-matter extending beyond the content of the - then divisional - application as filed, was not to be considered. An alleged extension beyond the content of the **divisional** application as filed did not therefore fall under the grounds of Article 100(c) EPC. In view of the importance of this point of law, the respondent requested that it be referred to the Enlarged Board of Appeal.

Concerning the amendments made to the patent, he submitted in particular that the statement of the transport path being in contact both with the movable and the immovable parts simply expressed that the transport path ran between said parts, as was clearly disclosed both in the parent and in the divisional applications as originally filed.

The deletion from the claims of the features directed to the transport path extending between a paper insertion opening and a paper discharge opening was not objectionable. Such openings clearly constituted generic features of the type of apparatus concerned, which had not to be stated in the claims, accordingly. In particular, although the embodiments disclosed in the patent did not comprise any inner cassette for blank sheets of paper, the provision of such cassette would certainly also require an opening for its insertion into the housing of the apparatus.

The claimed arrangement was novel in view of the apparatus of document D9, of which the side comprising the movable part could hardly be considered as the front. Moreover Figure 1 of the document showed that the guiding elements of the paper sheets did not follow an arcuate path when brought into an open position, contrary to the access door. This clearly implied that the latter did not give direct access to the transport path within the meaning of claim 1.

The claimed arrangement was not obviously derivable from the apparatus of document D1, comprising an inner door and a separate outer door which did not give direct access to the transport path. The skilled person had no obvious reason either to proceed to the further modifications which were necessary to achieve the claimed combination of features, such as to depart from the face-up discharging scheme, which had the advantage of allowing direct visual checking of the produced prints as they left the apparatus.

Reasons for the Decision

1. The appeal is admissible.
2. *Respondent's main request*
 - 2.1 The respondent did not contest that the admissibility of the amendments made over the version of the **parent** application as originally filed had to be assessed in the present appeal (as to the assessment of the admissibility of the amendments made over the version of the **divisional** application as originally filed: see point 12 below).

The appellant *inter alia* objected to the deletion from the claims of the parent application of the features directed to the presence of an insertion opening for feeding paper sheets from the outside of the apparatus.

- 2.2 The Board notes in this respect that the description of the parent application as filed starts with the following general statement: "This invention concerns an apparatus for forming an image on a sheet of paper, the apparatus being of the type comprising a casing having a paper insertion opening and a paper discharge opening, transport means within the casing for causing the sheet of paper to be transported along a paper transport path from the paper insertion opening to the paper discharge opening, and electrophotographic means for imparting the image to the sheet of paper while the latter is on the paper transport path" (see page 1, 1st paragraph).

The introductory portion of the description then proposes several specific statements of the invention in its different aspects, which all explicitly refer to the presence of a casing having a paper insertion opening or region and a paper discharge opening or region, and an internal paper transport path in between (see the paragraph bridging pages 1 and 2, the 1st paragraph on page 6, the paragraph bridging pages 6 and 7 and the 2nd paragraph on page 7).

The subsequent description of the drawings starts with a discussion of the drawbacks of the prior art arrangements as illustrated in Figures 13 and 14, respectively, in which a horizontal transport path within a casing connects paper insertion and paper discharge openings. This discussion stresses the impact on the floor area requirements of a paper stacker 8 located next to the paper insertion opening, which in

the arrangement of Figure 13 adds the length l of the paper to the overall width w of the apparatus, a further additional paper length l being required for accommodating a paper delivery tray 18 next to the discharge opening (see page 10, lines 11 to 15 and page 11, lines 14 to 19). In the prior art arrangement of Figure 14, the paper delivery tray is provided on the top of the apparatus so that only the paper stacker 3 next to the insertion opening adds an additional paper length l to the depth D' of the apparatus (see page 11, lines 4 to 8 and 14 to 19).

The invention is then described with reference in particular to Figures 1 to 9, which all illustrate arrangements wherein sheets of paper fed from the outside of a casing follow a transport path which, in comparison with the horizontal path of the prior art arrangements of Figures 13 and 14, extends substantially vertically and behind the front wall of the casing. The printed sheets are then discharged from the front side of the casing.

The vertical arrangement of the internal transport path in these embodiments in particular allows for paper feeding from an insertion opening adjacent the top of the casing and paper delivery from a discharge opening adjacent the bottom of the front of the casing (see page 14, lines 12 to 15). Thereby the size of the floor area required for installing the apparatus can be reduced, at the cost obviously of an increased height. This is emphasized in the first specific statement in the introduction of the description, according to which the invention is characterised in that the casing has a height which is greater than its depth (see the paragraph bridging pages 1 and 2).

The remaining Figures 10 to 12 illustrate various details of a cartridge including a rotatable photosensitive member, for use with the arrangements of the preceding figures.

The parent application as filed also comprises five independent claims of which independent claims 1, 30, 31 and 32 explicitly refer to an apparatus for forming an image on a sheet of paper comprising a paper insertion opening or region (19), a paper discharge opening or region (20) and a paper transport path (21) from the paper insertion opening (19) to the paper discharge opening (20).

Substantially the same limitations are implied by the wording of claim 33, the last independent claim, which specifies that the apparatus has a relatively small bottom area and a relatively large height and **that an unprinted sheet may be inserted from the upper side of the apparatus and the printed sheet of paper may be discharged from the lower front side thereof.**

Thus, in the Board's view, the direct feeding from the outside of the casing of recording media consisting of sheets of paper, envelopes or the like (see page 28, lines 8 to 12) through an insertion opening or region of the casing to a transport path extending within the casing is an essential feature of the invention as both disclosed and claimed in the parent application as originally filed.

- 2.3 In contrast, claim 1 of the main request no longer comprises any explicit or implicit reference to an insertion opening or region of the casing for the feeding of sheets of paper or other recording media to the transport path within the casing.

The Board agrees to the appellant's submission that the deletion of this feature from the original independent claims conveys to the skilled reader the additional information that the casing may not only accommodate the transport means and the various components of the imaging means, with the recording media being fed from the outside as in the embodiments actually disclosed, but that it could also accommodate some kind of internal storage means for unprinted recording media, thereby obviating the need for a paper insertion opening in the casing, at one end of the paper transport path.

This information cannot, in the Board's judgement, be considered to be supported by the original content of the parent application as filed, which for the reasons set out under point 3.2 above discloses external feeding of paper sheets, envelopes or the like as an essential feature of the invention.

- 2.4 The respondent in this respect submitted that an insertion opening in the casing was a generic element of any imaging apparatus and that it was also necessary in an apparatus of the type comprising internally stored unprinted recording media, which still required some kind of access opening or door for the charging of the recording media into the housing. Such generic element did not need to be expressly recited in the claims.

In the Board's view, this argument misses the point insofar as it does not address the issue of whether an apparatus without an external feeding of the recording media through an insertion opening or region to the transport path was directly and unambiguously derivable from the parent application as filed. An a posteriori demonstration that the original claims, considered in

isolation from the rest of the application documents, could possibly be construed in such a way as to **cover** a specific type of apparatus with an internal storage of the recording medium cannot provide convincing evidence that such specific apparatus was actually **disclosed** to the skilled person.

2.5 The Opposition Division in the appealed decision in this respect merely stated that the location of the paper insertion and paper discharge openings was not recognised by the skilled reader of the parent application as essential in the context of the paper path accessibility (see the last sentence of point 2.3.2 of the reasons). In addition to being questionable in the light of the above detailed analysis of the contents of the parent application as filed, this statement obviously only addresses the question of the **location** of the openings, not the actual issue of whether their **presence** is an essential feature of the subject-matter originally disclosed.

2.6 For these reasons claim 1 of the main request, corresponding to claim 1 as granted, extends beyond the content of the earlier (parent) application as filed in contravention of the requirement of Article 100(c) EPC.

3. *Auxiliary request I*

The additional limitation in claim 1 of auxiliary request I that the record medium is discharged with the said image face down "having moved from the transport path (13) after receiving the image about one centre of curvature only" neither specifies nor even concerns the way the recording media are inserted into the casing.

The claim in the so amended version does not therefore overcome the above objection as raised against claim 1 of the main request, that it extends beyond the content of the earlier (parent) application as filed. Claim 1 of auxiliary request I therefore offends against the requirements of Article 76(1) EPC.

4. *Auxiliary request II*

Claim 1 of the auxiliary request II further specifies that the transport path includes an opening in the said top and that the door includes the portion of the said top from the front to the said opening.

The claim thus refers to a single opening, without specifying whether that said opening is actually provided for direct insertion of the recording media from the outside, rather than e.g. for the face-down discharging recited at the end of the claim. The version of claim 1 of auxiliary request II does not therefore overcome the above objections as raised against claim 1 of the main request.

Moreover, the parent application as filed in the Board's view also fails to unambiguously disclose the further limitation that the movable part includes the portion of the top from the front to the said opening.

As a matter of fact the only indication of the position of the movable part in relation to the top of the casing can be found in Figures 6(a), 7(a) and 9(a). These figures are side views of a housing illustrated in a schematic representation in which the upper edge of the movable part in its closed position lies flush with the top of the casing and thus in a sense "include" a portion of the top.

There is no hint whatsoever in the description itself that this detail of the schematic representation was actually meant to correspond to a technical feature of the apparatus shown in the figures, rather than being merely an expression of the draughtsman's artistic freedom.

Moreover, the precise location of an insertion opening in the top of the casing is disclosed in the parent application as filed only in conjunction with the embodiments of Figures 1, 3 and 4, which do not comprise any door at the front. But the parent application as filed does not specify the precise location of that opening in the embodiments comprising front doors as illustrated in Figures 6(a), 7(a) and 9(a). The less so does it disclose the very specific location now recited in claim 1 of auxiliary request II, namely at the junction between the upper edge of the door, which itself must lie flush with the top of the stationary part of the casing, and said top of the casing.

For these reasons, claim 1 of auxiliary request II also offends against the requirement of Article 76(1) EPC.

5. *Auxiliary request III*

The additional limitation in claim 1 of auxiliary request III as compared to claim 1 of the main request, namely that the apparatus comprises a cartridge provided with the image-receiving member (1) and the cleaning device (6), neither specifies nor even concerns the way the recording media are inserted into the casing.

The objection referred to in point 3, supra, in connection with claim 1 of the main request therefore equally applies to it.

6. *Auxiliary request IV*

As compared to claim 1 of the main request, claim 1 of auxiliary request IV further specifies that "the apparatus is arranged such that access space for the insertion and discharge of the record medium and the said access to the transport path and image-receiving member (1) is only required at the front and top sides of the apparatus".

Although referring to an access space for the "insertion ... of the record medium", the claim does not imply the feature, considered as an essential element of the apparatus originally disclosed in the parent application as filed, that the record medium is fed from the outside through an opening in the casing for a sheet of paper. As a matter of fact the wording of the claim is still sufficiently general to encompass devices in which the record medium is charged into a temporary storage tray within the housing, e.g. after having been inserted into the casing through the movable part also recited in the claim. However no such devices are disclosed in the earlier application as filed.

For these reasons, claim 1 of auxiliary request IV also offends against the requirement of Article 76(1) EPC.

7. *Auxiliary requests V to XIV*

Claim 1 of auxiliary requests V to XIV each recites the subject-matter of claim 1 of the main request, with various combinations of the additional features introduced into claim 1 of auxiliary requests I to IV.

For the reasons indicated above none of these additional features clearly expresses the direct feeding from the outside of the casing of recording media consisting of sheets of paper, envelopes or the like through an insertion opening or region of the casing to a transport path extending within the casing, which is considered an essential element of the subject-matter originally described and claimed.

Claims 1 of auxiliary requests V to XIV therefore also offend against the requirement of Article 76 EPC.

8. *Auxiliary requests XV and XVI*

In auxiliary requests XV and XVI, it is requested that a patent be granted on the basis of the main request amended in particular by adding to claim 1 "any one or more of claim 2 to 10 as granted".

These requests generally refer to a huge amount of unspecified possibilities. Admitting such auxiliary requests would pose undue difficulties to the appellant in dealing properly with a high number of combinations of claims. In any case an adjournment of the proceedings would have been necessary, leading to an unacceptable delay.

Thus the Board considers the filing of the unspecified auxiliary requests XV and XVI contrary to proper procedure and decides to refuse them (for the allowability of unspecified requests see e.g. decision T 206/93, not published in the OJ EPO, point 11 of the reasons).

9. *Auxiliary request XVII*

Claim 1 of auxiliary request XVII is a further combination of the features of claim 1 of the main request with the additional features set out in auxiliary requests I, III and IV.

The reasons given above in relation with the combinations of auxiliary requests V to XIV equally apply to claim 1 of auxiliary request XVII.

10. Thus, none of the versions proposed by the respondent for maintenance of the patent in amended form meets the requirement of Articles 100(c) and/or 76(1) EPC.

11. The question of whether document D15, cited by the appellant in support of his objections to the patentability of the claimed subject-matter, should be allowed into the procedure (respondent's request B) need not be considered further, accordingly.

12. *The question of the proper interpretation of Article 100(c) EPC in the case of a patent granted on the basis of a divisional application*

12.1 The respondent contested that, in the case of a patent granted on the basis of a divisional application, the grounds for opposition under Article 100(c) EPC encompassed the issue of the subject-matter of the

patent extending beyond the content of the **divisional** application as originally filed, and he requested that this point of law be referred to the Enlarged Board of Appeal (his request A).

- 12.2 The Board in this respect notes that the above issue, raised by the appellant only after expiry of the period for opposition, was nevertheless taken into consideration by the Opposition Division. The Opposition Division in its decision ruled that the grounds for opposition under Article 100(c) EPC prejudiced the maintenance of the patent in the version of the then main request, i.e. with the description and drawings comprising elements of the parent application not disclosed in the divisional application as originally filed (see points 2, 2.1 and 2.2 of the Grounds).

The respondent did not himself appeal against the decision. According to the ruling of the Enlarged Board of Appeal in cases G 9/92 and G 4/93 (both OJ 1994, 875), the non-appealing respondent is primarily restricted in the appeal proceedings to defending the patent as maintained. He could not therefore at this stage of the procedure request that the contents disclosed only in the parent application be re-introduced into the patent in suit, even on a different interpretation of Article 100(c) EPC, and he did not actually maintain any request to this effect, all his requests involving the maintenance of the patent description and drawings in the version accepted by the Opposition Division.

The appellant for his part submitted that the feature of claim 1 of the patent as amended directed to the transport path being in contact both with the movable and the immovable parts, still extended beyond the

content of the **divisional** application as filed. This issue does not however need to be investigated further, the respondent's requests not being allowable for other reasons.

- 12.3 In these circumstances, an answer to the point of law to be referred to the Enlarged Board of Appeal in accordance with respondent's request A would have no actual bearing on the outcome of the present appeal. This request is not allowed either, accordingly.

Incidentally, the Board notes that the above question was already considered by the Boards of Appeal. In decision T 437/97 (not published in the OJ EPO) the Board stated that in the case of a patent granted on the basis of a divisional application the grounds for opposition under Article 100(c) EPC had to be interpreted to the effect that the patent shall extend neither beyond the content of the parent application as filed, nor beyond that of the divisional application as filed (see point 3.1 of the Reasons).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The European patent No. 0 460 773 is revoked.

The Registrar:

The Chairman:

P. Martorana

E. Turrin