

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 9 February 1999

Case Number: T 0752/98 - 3.5.1

Application Number: 93118312.3

Publication Number: 0597482

IPC: H04N 1/32

Language of the proceedings: EN

Title of invention:

A portable facsimile apparatus into which a document or a recording sheet is manually set

Applicant:

Canon Kabushiki Kaisha

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendments - added subject-matter (no)"

Decisions cited:

-

Catchword:

-



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0752/98 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 9 February 1999

Appellant:

Canon Kabushiki Kaisha
30-2, 3-chome, Shimomaruko
Ohta-ku
Tokyo (JP)

Representative:

Bühling, Gerhard, Dipl.-Chem.
Patentanwaltsbüro
Tiedtke-Bühling-Kinne & Partner
Bavariaring 4
80336 München (DE)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 4 March 1998
refusing European patent application
No. 93 118 312.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: R. S. Wibergh
S. C. Perryman

Summary of Facts and Submissions

I. This appeal is against the decision of the Examining Division to refuse European patent application No. 93 118 312.3 (filing date: 11 November 1993).

II. The decision under appeal is based on claims according to a main request and three auxiliary requests.

The subject-matters of claim 1 according to the main request and the first two auxiliary requests were found to be obvious. There were furthermore objections under Article 123(2) EPC against claim 1 according to the first two auxiliary requests.

Claim 1 according to the third auxiliary request was found to have been amended in a manner which was contrary to Article 123(2) EPC. Whether this claim and its subject-matter met the other requirements of the EPC was left undecided.

III. In the statement setting out the grounds of appeal the appellant argued against the finding of the Examining Division. A new set of claims was filed. Claim 1 was said to be based on claim 1 according to the third auxiliary request before the Examining Division.

IV. Claim 1 read as follows:

"A facsimile apparatus which is capable of communicating in an error correction mode (ECM) comprising means for recording (1-6) received image data on a recording material, said recording means being such as to have the recording material set thereon manually; characterized in that it further comprises means for providing (1-14, 2-3) a notification that an

additional piece of recording material must be set, and means for performing (1-1) a process of holding a communication link during an operation by said providing means, comprising the receiving of a first procedure signal (RR) asking for the status of the receiver and the replying to this first procedure signal by a second procedure signal (RNR) indicating that the receiver is not ready for receiving, wherein said exchange of said first and second procedure signal is started in accordance with receiving a signal of returning to control for partial page (RCP) and, said exchange of said first and second procedure signal is terminated when a predetermined time has elapsed or an additional piece of recording paper is set and wherein during said process of holding said communication link no image data is received."

Independent claim 6 was directed to a corresponding image communication method.

V. The appellant argued as follows:

The Examining Division had objected to the insertion of definitions of the signals RR and RNR into the claim according to the then third auxiliary request. These signals were however generally known, as could be seen from two documents annexed to the statement of grounds:

D4: "Annex A" of the "Recommendation T.30 (07/96)", pages 58 to 73, and

D5: "Recommendation T.30 (03/93)", pages 88, 89.

The Division had furthermore found that it was not disclosed in the application as filed how the exchange of the first and second procedure signals (RR and RNR) was terminated. But this was clear from the flow

diagram shown in Figure 32 of the application, which indicated that the "binary receiving procedure" (box S704) comprising the signal exchange would be called each time the loop of which it was a part was run through. When the signal flow left the loop, the procedure would not be called anymore. The figure showed clearly the conditions for leaving the loop and, consequently, for terminating the signal exchange.

VI. With letter dated 25 January 1999 the appellant requested:

that the appealed decision be set aside and a patent be granted on the basis of the claims filed together with the statement setting out the grounds of appeal (main request); or

that the appealed decision be set aside, that it be decided that claim 1 filed with the statement setting out the grounds of appeal fulfills the requirements of Article 123(2) EPC, and that the case be remitted to the Examining Division for further prosecution (first auxiliary request); or

that the appealed decision be set aside and a patent be granted on the basis of the claims according to "auxiliary request III" before the Examining Division (second auxiliary request); and

that oral proceedings be appointed if neither the main request nor the first auxiliary request can be granted on the basis of the written submissions.

Reasons for the Decision

1. The appeal is admissible.
2. The Examining Division rejected claim 1 according to the third auxiliary request before them solely under Article 123(2) EPC. This article stipulates that a European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. According to the Examining Division, the claim contained two features which were not disclosed in the original application. Since the present independent claim 1 still contains these features (with only some slight changes in wording) it must be decided whether the Examining Division's objection was justified or not.

The first feature is "the receiving of a first procedure signal (RR) asking for the status of the receiver and the replying to this first procedure signal by a second procedure signal (RNR) indicating that the receiver is not ready for receiving". The Examining Division pointed out that the function of the signals RR and RNR had not been defined in the application as originally filed; only an exchange of signals referred to by these names had been disclosed. Nor had the appellant presented any documents supporting the meaning given to the RR and RNR signals.

According to the second feature, "said exchange of said first and second procedure signal is terminated when a predetermined time has elapsed or an additional piece of recording paper is set". The Examining Division was

of the opinion that the flow diagram in Figure 32 did not show the conditions for terminating the "binary receiving procedure", which according to Figure 31 comprises the signal exchange. Figure 32 merely showed the conditions for initiating said procedure.

3. As to the first amendment, the appellant has filed D4 and D5 to support his submission that the signals RR and RNR are well known to the skilled person working in the technical area of fax machines.

D4 concerns the CCITT Recommendation T.30. It contains the indication "(07/96)". In the absence of any explanations relating to the publication date of D4 the Board finds that the appellant has not shown that this document was available to the skilled person on the date of filing of the present application, which is 11 November 1993. D4 will therefore not be further considered.

D5, which also concerns the CCITT Recommendation T.30, bears the indication "(03/93)". The assumption that D5 was published in March 1993 is naturally near at hand but, in the absence of further particulars, remains an assumption. Moreover, although D5 refers to the signal RNR it does not mention the signal RR.

The Board has of its own motion consulted the European patent application EP-A-0 508 659, which corresponds to the Japanese application JP-A-04 301940 briefly referred to in the decision under appeal. This European application, which was published on 14 October 1992 - ie more than a year before the filing date of the present application - contains the following passage at column 3, lines 53 to 55: "...when the transmitter sends the RR signal, the receiver sends back the RNR signal to delay the transmission". A reference is furthermore made to the CCITT Recommendation T.30.

From this information it may be concluded that the signals RR and RNR are indeed comprised in a technical recommendation of which at least those parts which are relevant to the issues of this appeal were available to the public before the filing date of the present application.

The Board takes the view that, in principle, the skilled person must be assumed to be familiar with the relevant technical standards and recommendations in his technical area. Therefore, when reference is made in the present application to the signals RR and RNR, the skilled person would know what the abbreviations mean and how the signals are normally used.

It follows that the Examining Division's first objection under Article 123(2) EPC is regarded as not justified.

4. As to the second amendment, the Board agrees with the appellant's argumentation as summarised in the last paragraph at point V above. Thus also the Examining Division's second objection under Article 123(2) is found not to be justified.
5. *Further amendments*

Compared with the claims considered by the Examining Division the present claim 1 has been amended to include the features that the apparatus is capable of ECM (Error Correction Mode) communication and that the exchange of RR and RNR signals is initiated on receiving a signal RCP for return to control for partial page. The first feature is shown eg in Figure 26, block S413. The second feature is shown in Figure 32, block S472 as explained in the description at column 20, lines 24 to 30. It should be noted that

the signal RCP is referred to in EP-A-0 508 659 (column 3, line 10) and is also explained in D5. The introduction of the definition of the signal RCP in claim 1 is thus admissible for reasons analogous to those given in respect of the signals RR and RNR.

6. The Board therefore decides that the present claims 1 and 6 have not been amended in such a way as to contain subject-matter which extends beyond the content of the application as filed.

7. The decision under appeal does not indicate whether the Examining Division regarded the subject-matter of claim 1 according to the then third auxiliary request as obvious or not. For this reason, and also because the present independent claims contain further features which have been introduced only at the appeal stage, the case is remitted to the department of the first instance for the examination to be completed. Thus the appellant's main request is refused and the first auxiliary request is granted. It follows that oral proceedings need not be held.

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.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg