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D E C I S I O N
of 12 December 2000

Case Number: T 0168/99 - 3.5.1

Application Number: 91308835.7

Publication Number: 0478353

IPC: H04N 1/32

Language of the proceedings: EN

Title of invention:
Reprographic printing system

Patentee:
XEROX CORPORATION

Opponent:
Océ-Nederland B.V.

Headword:
-

Relevant legal provisions:
EPC Art. 100(a), (c)
EPC R. 57a

Keyword:
"Inventive step (main request, first and second auxiliary requests: no)"
"Amendments"

Decisions cited:
T 0064/95

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0168/99 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 12 December 2000

Appellant: (Opponent)
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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted 2 December 1998 concerning maintenance of the European patent No. 0 478 353 in amended form.**

Composition of the Board:

Chairman: A. S. Clelland
Members: R. S. Wibergh
P. H. Mühlens

Summary of Facts and Submissions

I. This appeal is by the patentee against the decision of the opposition division to maintain European patent No. 478 353 in amended form.

II. In the course of the opposition proceedings the main request now before the Board was withdrawn and was not considered by the opposition division. It was held that the claims of the then main request and the first auxiliary request lacked an inventive step having regard, *inter alia*, to the following documents:

D1: JP-A-62 135 069, translation and abstract,

D3: US-A-4 130 354.

The patent was maintained on the basis of a second auxiliary request.

III. At oral proceedings before the Board on 12 December 2000 the appellant sought maintenance on the basis of broader claims; the **main request** was to maintain the patent as granted. The **first auxiliary request** was for maintenance on the basis of claims 1 to 10 as filed by fax on 23 July 1997, and the **second auxiliary request** was for maintenance on the basis of independent claims 1 and 5 as filed on 4 September 1998. The first and second auxiliary requests before the Board correspond respectively to the main and the first auxiliary requests before the opposition division.

IV. The respondent (opponent) requested that the appeal be dismissed.

V. At the oral proceedings before the Board the primary question addressed was that of the inventive step of the independent claims of each request having regard to document D1. A further issue was whether the independent claims of the first and second auxiliary requests met the requirements of Articles 123(2) and 123(3) EPC as regards added subject-matter and claim broadening.

VI. Claim 1 of the **main request**, ie claim 1 as granted, reads as follows:

"A method of scanner fault recovery in an electronic reprographic printing system having a scanner (6) for scanning documents, a converter for converting the scanned documents to electronic images, a memory (61) for storing the electronic images, and a printer (8), the method comprising the steps of:

monitoring the scanner for scanner faults, and upon detection of a scanner fault, effecting deletion from memory of any scanned document image corresponding to a document involved in the scanner fault."

Claim 5 is a corresponding apparatus claim.

Claim 1 of the **first auxiliary request** reads as follows:

"A method of scanner fault recovery in an electronic reprographic printing system having a scanner (6) for scanning documents, a converter for converting the scanned documents to electronic images, a memory (61) for storing the electronic images, and a printer (8), the method comprising the steps of:

(a) monitoring the scanner for scanner faults, and (b) upon detection of a scanner fault, determining whether or not the detected scanner fault requires image deletion and, unless deletion is not required, deleting from memory one or more electronic images corresponding to a document involved in the scanner fault."

Claim 7 is a corresponding apparatus claim.

Claim 1 of the **second auxiliary request** reads as follows:

"A method of scanner fault recovery in an electronic reprographic printing system having a scanner (6) for scanning documents, a converter for converting the scanned documents to electronic images, a memory (61) for storing the electronic images, and a printer (8), the method comprising the steps of:

monitoring the scanner for scanner faults, upon detection of a scanner fault, effecting deletion from memory of any scanned document image corresponding to a document involved in the scanner fault, and determining whether a miscount occurred during scanning and, if a miscount occurred, aborting a Print job in progress."

Claim 5 is a corresponding apparatus claim.

Reasons for the Decision

1. *Admissibility of main request*

1.1 The granted claims were withdrawn at an early stage in

the opposition proceedings and before the opposition division had commented on them. The respondent objects that the appellant voluntarily abandoned these claims in the course of the opposition proceedings and should not now be permitted to reintroduce them. Moreover, the function of appeal proceedings was to give a judicial decision upon the correctness of the decision taken by the first instance and since no decision was taken on the granted claims no appeal could be based on them.

1.2 The Board has accordingly considered whether consent to filing of the main request should be refused on the ground that it consitutes an abuse of procedure, since it returns to a request withdrawn before it could be considered by the opposition division and therefore abandoned.

1.3 However, withdrawal of subject-matter does not necessarily mean that it has formally been abandoned. The boards have in the past allowed the reinstatement of a granted main claim, following its replacement in the course of opposition proceedings. Reference is directed to decision T 64/85 (not published) in which the circumstances were as in the present case. The Board stated at point 2.4 that in its opinion "an action taken in opposition proceedings by the proprietor of a patent before the opposition division has issued any comments on the relevance of the grounds for opposition should, unless its finality is clear from the context, be *prima facie* considered as a mere proposal directed to the opponent and made with a view to reaching with him an early agreement on a form of the patent acceptable to both parties...".

1.4 In the present case, the Board notes that with a letter

received by fax on 23 July 1997 the patentee filed revised claims "to replace all the claims at present on file". The letter does not contain any wording either stating or implying that the subject-matter of the granted claims was being abandoned.

1.5 An additional reason for exercising the Board's discretion in the appellant's favour arises from the issues of added subject-matter, Article 123(2) EPC and claim broadening, Article 123(3) EPC, raised with respect to the claims of the first and second auxiliary requests. It would be inequitable to refuse the appellant permission to return to a claim which could not give rise to this objection.

1.6 In the circumstances of the present case the Board has accordingly concluded that the main request should be admitted.

2. *Inventive step (main request)*

2.1 The patent is concerned with a photocopier of the kind in which documents are scanned and stored in a memory prior to being printed. Such a copier is referred to in the patent as an "electronic reprographic printing system", as opposed to a so-called "light lens copier" in which a document is scanned and an image synchronously formed on a photosensitive drum and printed more or less immediately. In the traditional light lens copier as exemplified by D3 a fault condition such as a paper jam is handled by keeping a running total of successful copies and after a fault has been cleared restarting from the last correctly completed copy. The known copiers also make provision for a complete reset in the event of a major machine

fault. However, in a copier in which a memory is provided, it may be that the fault originated either in the scanner or in the printer; the nature of the fault determines whether it is necessary to rescan the document. The method of claim 1 provides scanner fault recovery by monitoring the scanner for scanner faults and when a scanner fault is detected, effecting deletion from memory of the corresponding document image.

2.2 The Board observes that claim 1 of the main request makes no distinction between fatal and non-fatal errors. The claim merely requires that upon detection of a scanner fault "any scanned document image corresponding to the document involved in the scanner fault" is deleted from memory. The Board interprets this as requiring that in the event of a scanner fault the entire scanned document image is deleted; the wording does not leave room for deletion of only part of a document.

2.3 In the Board's view the correct starting point for a consideration of inventive step is document D1, which discloses a fax machine having scanner fault recovery. The single drawing of D1 shows a scanner 1 having a "scanning abnormality detector" 2 and a hard disk 5, the scanner and hard disk being controlled by a controller 6 which contains an image table 7 and address information 8. In normal operation the image stored on the hard disk is passed to a communications module 9 for transmission. In the event of a fault, detector 2 causes the controller to inhibit scanning and delete the stored image from disk 5. The translation and abstract refer to scanning an "original", which the Board understands to refer to a

single page rather than an entire document; D1 is silent as to whether an original can comprise a plurality of pages. In the event of a scanning error the original is rescanned.

2.4 It is therefore apparent that D1 provides for the monitoring of the scanner for scanner faults and, upon detection of a scanner fault, effects deletion from memory of any scanned document image corresponding to a document involved in the scanner fault. The only distinction between the method disclosed in D1 and that of claim 1 is that the latter is for scanner fault recovery in an electronic reprographic printing system rather than a fax machine.

2.5 It was argued by the appellant that the scanner of D1 was not in the same technical field as the printing system of the invention and the skilled person would therefore not look to D1 for a solution to the problem of scanning faults. In the patent the document page to be scanned was positioned on a platen and the scanner was moved relative to the document, whereas in a fax machine a page was usually moved past a fixed line of sensors to effect scanning. The Board is unable to accept this argument; D1 does not disclose any particular form of scanner and, even if it did, the claim does not require any particular form of scanner. A fax machine is not designed as a copier but can normally be used to provide a copying facility. The Board accordingly considers that no technical prejudice would prevent the skilled person from applying the fault recovery of D1 to an electronic reprographic printing system as in the patent. If the skilled person were to make use of the fault recovery method known from D1 he would inevitably arrive at the claimed

method. The subject-matter of claim 1 of the main request accordingly lacks an inventive step.

2.6 Claim 5 relates to apparatus for scanner fault recovery in an electronic reprographic printing system and has features corresponding to those of the method of claim 1. Claim 5 is accordingly open, *mutatis mutandis*, to the same objection of lack of inventive step as claim 1.

3. *Inventive step (first auxiliary request)*

3.1 In the course of the oral proceedings the primary issue addressed in relation to this request was that of inventive step. In view of the Board's decision on this issue it has not proved necessary to consider the issues raised under Articles 123(2) and (3) EPC.

3.2 Claim 1 of this request differs from that of the main request in that upon detection of a scanner fault the method determines whether or not the detected scanner fault requires image deletion and, unless deletion is not required, deletes from memory one or more electronic images corresponding to a document involved in the scanner fault.

3.3 The appellant argued that this claim made a distinction between so-called fatal and non-fatal errors, thus permitting more efficient operation in that deletion of an image was only carried out if necessary. It was argued that the claimed system distinguished between three different cases: no deletion, some deletion and complete deletion. The invention lay in the decision to make this distinction. D1 deleted all image data in the event of a scanner fault and merely retained the

address, ie the telephone number, corresponding to the fax to be sent.

3.4 The Board notes that claim 1 does not state that in the event of a fault only part of a document need be deleted but rather that "one or more electronic images corresponding to a document involved in the scanner fault" are deleted from memory. In other words, the claim covers the case which apparently arises in D1, where the entire scanned image is deleted in the event of a scanner fault. Accordingly, the only subject-matter which this claim adds to that of the main request is that a decision is made whether or not the fault requires image deletion. The Board considers that the skilled person would have been aware that there might be faults which would not require deletion of an image, the claim thus merely stating the *desiderata* in any practical system. The skilled person, faced with the problem of the most efficient manner of handling scanner faults, would seek to avoid deleting an image if at all possible because of the resulting rescanning. The subject-matter of claim 1 of the first auxiliary request accordingly lacks an inventive step.

3.5 Claim 7 of this request is an apparatus claim having features corresponding to those of the method of claim 1 and is accordingly open, *mutatis mutandis*, to the same objection of lack of inventive step as claim 1.

4. *Inventive step (second auxiliary request)*

4.1 In the course of the oral proceedings the primary issue addressed in relation to this request was that of inventive step. In view of the Board's decision on this

issue it has not proved necessary to consider the issues raised under Articles 123(2) and (3) EPC.

4.2 Claim 1 of this request adds to that of the first auxiliary request the feature of determining whether a miscount occurred during scanning and, if a miscount occurred, aborting a Print job in progress.

4.3 The description, in the passage bridging columns 6 and 7, states that if a miscount occurs the Print job is aborted. The argument advanced above in relation to the first auxiliary request would appear to apply to this request also; in other words, once the skilled person sets out the *desiderata* for a practical copier he would as a matter of course provide for a complete stop to printing in the event of a miscount. The claim accordingly merely states how any practical system must work. The subject-matter of claim 1 of the second auxiliary request accordingly lacks an inventive step.

4.4 Claim 5 of the second auxiliary request is an apparatus claim having features corresponding to those of the method of claim 1; this claim is accordingly open, *mutatis mutandis*, to the same objection of lack of inventive step as claim 1.

5. In the course of the oral proceedings the appellant indicated that he was prepared to make further amendments to the claims if the Board considered that an allowable claim might be formulated. In the Board's view however this is not the case.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Kiehl A. S. Clelland