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**Datasheet for the decision
of 7 August 2013**

Case Number: J 0002/12 - 3.1.01
Application Number: 08154835.6
Publication Number: 2204700
IPC: G03G 15/00, G03G 15/01,
B41J 13/00
Language of the proceedings: EN
Title of invention:
Image forming apparatus
Patent Proprietor
Canon Kabushiki Kaisha
Headword:
Missing drawings
Relevant legal provisions:
EPC R. 56, 40(1)
Keyword:
"Drawings to be added to application documents - yes"
Decisions cited:
J 0027/10

Catchword:

Where (a) the description as filed with an application includes references to numbered drawings and (b) drawings with corresponding numbering are also filed with the application, different drawings may nevertheless be filed later under Rule 56 EPC as "missing drawings" if it can be established without having to apply technical knowledge that the drawings originally filed with the application are not the drawings referred to in the description and that the later-filed drawings are the drawings referred to in the description (see point 9).



Case Number: J 0002/12 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 7 August 2013

Appellant: Canon Kabushiki Kaisha
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Decision under appeal: Decision of the Receiving Section of the
European Patent Office posted 7 July 2011.

Composition of the Board:

Chairwoman: B. Guenzel
Members: D. Prietzel-Funk
K. Garnett

Summary of Facts and Submissions

- I. This appeal lies against the decision of the Receiving Section dispatched on 7 July 2011 refusing various requests of the applicant (hereafter: the appellant) under Rule 56 EPC in respect of the European Patent application 08 154 835.6.
- II. The application was filed on 18 April 2008 with a description, 13 claims and 10 sheets of drawings numbered 1/11 to 10/11, comprising Figures 1 to 10 respectively. The application claimed priority from the application JP 2007-111933 of 20 April 2007.
- III. On 23 June 2008 the EPO issued a communication under Rule 56(1) EPC and Article 90(1) EPC, in which it informed the appellant that "Figure 11", which was mentioned and described on page 13 of the description, was missing. The appellant was invited to file the missing Figure 11 within two months.
- IV. With the letter dated 30 June 2008 the appellant filed a set of drawing sheets numbered 1/11 - 11/11, comprising Figures 1 to 11 respectively, as "replacement drawings". Figures 1 to 10 were different drawings to those submitted with the application, and sheet 11/11 showed a Figure 11. The appellant requested that the date of filing of the application remain 18 April 2008. It noted the newly filed drawings were identical to those filed with the Japanese application, from which priority was claimed.
- V. By letter dated 11 August 2008 the appellant requested that an additional priority claim be added, namely

patent application US 12/056 972 of 27 March 2008. The appellant enclosed a certified copy of this document which contained 11 drawing sheets numbered 1/11 to 11/11 comprising Figures 1 to 11 respectively. On 22 August 2008 this request was granted and confirmed to the appellant.

VI. In a further letter, the appellant stated that as a result of an error in the representative's office the drawings as originally filed were not the drawings intended to be filed. The correct drawings were those filed with the letter of 30 June 2008. For the purposes of Rule 56(3) EPC the appellant relied on the US priority application instead of the Japanese priority application for its Main Request, and on the latter application as an auxiliary measure. The appellant stated that the drawings filed on 30 June 2008 were completely contained in the US priority application.

VII. By the impugned decision the Receiving Section rejected all requests, noting that all references to Figure 11 in the application should be deemed to be deleted and should be deemed not to have been made. The Receiving Section held that, no matter which of the two priority applications were taken into consideration, the newly filed drawings could not be accepted. Rule 56(3) EPC could not be used to correct errors in the original application by the filing of a new set of drawings. Rather, the rule was applicable in cases where an application was completed by the filing of missing parts, in particular if they have been omitted. In support of the reasoning, reliance was placed on what were considered to be the purposes of Rule 56(3) EPC. The Receiving Section pointed out that studying the

brief specification of the drawings in the description usually - and also in this case - required substantive technical knowledge, whereas formalities officers were generally not expected to carry out any substantial examination.

- VIII. The appellant filed a notice of appeal on 7 September 2011, paying the appeal fee on the same date. A statement of the grounds of appeal was received at the EPO on 7 November 2011.
- IX. Following the sending of a communication with the Board's provisional opinion of the case, the appellant filed comments on 5 July 2013.
- X. Oral proceedings were held on 7 August 2013, during which the appellant filed an annotated copy of the description of the US priority application and also an annotated copy of drawings headed "Drawings comparison JP '933 vs EP intended drgs".
- XI. At the end of the oral proceedings the appellant requested that the decision under appeal be set aside and that the case be remitted to the Receiving Section with the order that the filing date remain 18 April 2008 including Figures 1 to 11 filed on 30 June 2008.
- XII. The appellant's arguments in support of this request can be summarised as follows:
- Rule 56 EPC was not limited to drawings which had been omitted from the original application but applied also to cases where drawings, being

referred to in the description, were not filed, in particular where wrong drawings had been unintentionally filed.

- It was apparent from the wording of Rule 56(1) EPC that where a drawing is referred to in the description (or in the claims) but the drawing referred to is not actually present as part of the drawings as filed, the drawing is a "missing drawing" for the purpose of Rule 56 EPC.

- None of the correct Figures 1 - 11 as referred to in the application were present in the drawing sheets as originally filed. Thus they were "missing".

- It was immediately evident from the comparison of the brief description of Figures 1 to 10 in the application with the 10 figures as originally filed that each Figure 1 to 10 either showed something totally different and/or none of the reference numbers mentioned in the relevant paragraphs of the description in fact appeared in the originally filed figures.

- The Receiving Section would not have had to apply any specific technical knowledge to reveal that the originally filed drawings were wrongly filed, since the appellant had provided it with the appropriate guidance as to how to compare the actually filed Figures 1 to 10 with the description of each of these figures in the description.

XIII. At the end of the oral proceedings the Board announced its decision to set aside the decision under appeal and to order that the application date shall remain 18 April 2008 and the application shall include Figures 1 to 11 as filed with the letter dated 30 June 2008.

Reasons for the Decision

1. The appeal satisfies the requirements of Articles 106 to 108 EPC and Rule 99 EPC and is therefore admissible.
2. The question arising in this case concerns what are to be considered as "drawings referred to in the description [that] appear to be missing" or as "missing drawings". The answer has in particular a decisive impact on cases in which the application claims priority from an earlier application in which the allegedly missing drawings are completely contained. Under Rule 56(3) EPC, the application date may then remain unaltered and does not have to be re-dated to the date when the correct drawings were subsequently filed.
3. a) Rule 56 EPC reads in its relevant parts:
"(1) If the examination under Article 90, paragraph 1, reveals that parts of the description, or drawings referred to in the description or in the claims, appear to be missing, the European Patent Office shall invite the applicant to file the missing parts within two months. (...)
(2) If missing parts of the description or missing drawings are filed later than the date of filing, but within two months of the date of filing or, if a

communication is issued under paragraph 1, within two months of that communication, the application shall be re-dated to the date on which the missing parts of the description or missing drawings were filed. (...)

(3) If the missing parts of the description or missing drawings are filed within the period under paragraph 2, and the application claims priority of an earlier application, the date of filing shall, provided that the missing parts of the description or the missing drawings are completely contained in the earlier application, remain the date on which the requirements laid down in Rule 40, paragraph 1, were fulfilled, where the applicant so requests and files, within the period under paragraph 2; ...".

b) Article 90(1) EPC provides that the EPO shall examine, in accordance with the Implementing Regulations to the EPC, whether the application satisfies the requirements for the accordance of a date of filing. The particular requirements are found in Rules 40 and 42 EPC.

4. Rule 56(1), first sentence, EPC refers to drawings referred to in the description or in the claims which appear to be missing. Hence, where a drawing referred to in the description is missing in the application documents as filed, Rule 56 EPC is applicable and the missing drawing can be filed later in accordance with the procedure laid down in Rule 56 EPC.

5. In the present case the Receiving Section appreciated that Figure 11, referred to in the description, was missing. The appellant then not only filed the missing Figure 11 as the Receiving Section had invited it to do, but it also filed a new set of drawings consisting of

sheets 1/11 to 10/11, these sheets comprising Figures 1 to 10 respectively. These drawings were to take the place of the sheets with Figures 1 to 10 filed before.

6. It has been decided by the Legal Board of Appeal that while it is not expressly stipulated in Rule 56 EPC that an applicant may file on his own motion missing parts of the description or missing drawings, an applicant may nevertheless do so (decision J 27/10 of 9 December 2011, point 4 of the reasons). Thus, the appellant was entitled to file on its motion matter that it considered to be missing.

7. The references to "missing" drawings appearing in each of paragraphs (1) to (3) of Rule 56 EPC must be interpreted consistently with each other to give a meaningful effect to the rule as a whole (see also J 27/10, point 10 of the reasons). In this respect the Board considers that the "missing drawings" which are referred to in Rules 56(2) and (3) EPC are the same as the "drawings referred to in the description or in the claims [which] appear to be missing" referred to in Rule 56(1) EPC. There are thus two questions which need to be answered: (1) Does an examination of the application reveal that "drawings referred to in the description" appear to be missing? (2) Were the drawings which the appellant filed on 30 June 2008 (the) "missing drawings"?

8. As to the first question, in the simple case where drawings are referred to in the description but no drawings are filed, the answer will clearly be yes. The same is true where, as in the present case, the description referred to Figures 1 to 11, but no Figure

11 was filed: Figure 11 was clearly missing (see also J 15/12 of 18 February 2013). In the Board's view, however, there are other situations in which drawings referred to in the description can be said to be missing within the meaning of Rule 56 EPC. So, for example, in the present case the description referred *inter alia* to Figure 1, which in the Brief Description of the Drawings was said to illustrate an "overall configuration of a tandem-type color image forming apparatus according to the exemplary embodiment of the present invention." In the Detailed Description of the Embodiments, Figure 1 was further said to illustrate such an apparatus according to the first embodiment of the invention, this embodiment then being described in detail by reference to this drawing. This was done by reference to numerous named and numbered features which were apparently to be found in the drawing. Figure 1 as originally filed, however, while it relates to something called an "Image Processing Apparatus", contains named and numbered features, none of which are to be found in the description. Similarly, none of the numerous named and numbered features referred to in the relevant passages in the description are to be found in the drawing. It is immediately apparent that the drawing originally filed as Figure 1 is not the Figure 1 referred to in the description. There is simply no correspondence between the description and the drawing at all. Therefore Figure 1 referred to in the description is not Figure 1 as originally filed; the drawing is missing. The same is also true, *mutatis mutandis*, for each of Figures 2 to 10.

9. The Board takes full account of the fact that, as was correctly pointed out in the impugned decision, the

Receiving Section is not expected to carry out any substantial examination which requires explicitly technical knowledge. The Receiving Section will not normally do anything more than check that the number of drawings filed corresponds to the number of drawings referred to in the description (as apparently happened in the present case). However, once one's attention has been drawn to the point it is immediately apparent that the Figures 1 to 10 referred to in the description are not the Figures 1 to 10 as originally filed. As explained above, to appreciate this, one does not need to have any notion of what a tandem-type colour image forming apparatus might be or to understand what the relevant passages of the description are talking about or what the drawings originally filed in fact illustrate. In other cases it may be that such a conclusion cannot be reached so readily but the Board does not have to consider where in general the dividing line should be drawn in such cases. This is because in the present case it is not in doubt that drawings referred to in the description were missing.

10. The Board therefore concludes that "drawings referred to in the description appear to be missing" from the application as filed (Rule 56 EPC). The Board therefore disagrees with the conclusion of the Receiving Section that Rule 56 EPC is not in any circumstances applicable where the "wrong" drawings are filed as opposed to where an incomplete set of drawings is filed (point 8 of the Reasons). The Receiving Section pointed out that Rules 40 and 56 EPC were designed to implement Article 5 PLT so that it was helpful to consider the intentions of the drafters of this latter provision, as to be found in the explanatory notes prepared by WIPO's

Standing Committee on the Law of Patents (SPC/1/4, Geneva, 5th session, 1998). There it was stated that the provisions concerning missing matter from the application would apply, in particular, where a sheet of the description or drawings is unintentionally omitted. The Board agrees but the cited situation is clearly not intended to be exhaustive as regards the application of Rule 56 EPC. The Board also disagrees with the Receiving Section's conclusion from this statement that if an application "contains a set of (wrong) drawings, it is not *absent of* or *lacking* any drawings", certainly to the extent that this was meant to be an exhaustive statement about the application of Rule 56 EPC in this context. The Receiving Section also concluded that what the appellant was attempting to do was essentially to amend or correct the application under Rules 137 or 139 EPC respectively, something that is not permissible via Rule 56 EPC. The effect of the application of Rule 56 EPC will in one sense always be to amend or correct the application but this is not the relevant issue. The issue is whether drawings referred to in the description were missing.

11. This conclusion is also consistent with the existing case law of the Boards of Appeal. In J 27/10, the applicant's case was that although the drawings originally filed were the correct drawings, the description as originally filed was the "wrong" one. The applicant's request under Rule 56 EPC to substitute it with the "right" description was refused on the basis that Rule 56 EPC did not allow some, or all, of the description that was originally filed in order to obtain a filing dated to be amended, replaced or deleted: see point 12 of the reasons. The decision was

thus concerned with whether "parts of the description ... appear[ed] to be missing" within the meaning of Rule 56(1) EPC and not with when drawings referred to in the description could properly be considered as missing. In J 15/12, citing J 27/10 but now in the context of missing drawings, it was again said that an interpretation of Rule 56 EPC that some, or all, of the application documents that were originally filed in order to obtain a filing date could be amended, replaced or deleted would be incorrect. The present decision does not bring these statements into doubt: the effect of the Board's decision will not be to amend, replace or delete the drawings filed with the original application, since these drawings will remain part of the application.

12. As to the second question, the evidence necessary to establish that the drawings which the applicant has filed under Rules 56(2) or (3) EPC are in fact (the) missing drawings will depend on the circumstances. In the present case:

(a) It is apparent by simply reading and without the need for any technical knowledge that the drawings consisting of Figures 1 to 11 filed with the letter dated 30 June 2008, together with their named and numbered features, correspond to what is explained in the description, and *vice versa*.

(b) Further, the Board has compared these later-filed drawings with those in the US priority document. Both consist of identical Figures 1 to 11 with the identical reference numbers. Also the wording of each application, including the descriptions of the figures, is for all intents and purposes identical.

(c) These considerations established to the satisfaction of the Board that the drawings filed by the appellant with the letter dated 30 June 2008 were the drawings referred to in the description.

13. As to the further requirements of Rule 56(3) EPC, the Receiving Section accepted that the US priority application could be used for the purposes of Rule 56 EPC (see point 10 of the impugned decision). Consequently, the further Japanese priority application need not be taken into consideration separately for the purpose of this appeal.

14. As a result, the Board concludes that Figures 1 to 11 filed with the letter dated 30 June 2008 are to be treated as missing drawings under Rules 56(3) and (2) EPC. Consequently, pursuant to Rule 56(3) EPC the date of filing remains 18 April 2008, i.e. the date on which the requirements of Rule 40(1) EPC were fulfilled. The incomplete application documents filed originally are to be completed by the missing drawings. The drawings with Figures 1 to 11 filed with the letter dated 30 June 2008 must be added to the text of the application. Therefore, the European Patent Office will also have to provide for a publication of the drawing sheets with Figures 1 to 11.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The filing date of the application shall remain 18 April 2008 and the application shall include Figures 1 to 11 as filed with the letter dated 30 June 2008.
3. The case is remitted to the Receiving Section for further prosecution.

The Registrar:

The Chairwoman:

C. Eickhoff

B. Günzel