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**Datasheet for the decision
of 27 March 2015**

Case Number: J 0012/14 - 3.1.01

Application Number: 12150772.7

Publication Number: 2484234

IPC: A41D13/00, A41D31/02

Language of the proceedings: EN

Title of invention:

Performance apparel with flexible portion

Applicant:

Reebok International Limited

Headword:

Missing drawings

Relevant legal provisions:

EPC R. 56, 58, 49

Keyword:

Drawings to be added to application documents - no
Formal examination procedure before the Receiving Section

Decisions cited:

J 0002/12, J 0004/09

Catchword:

1.

The filing of drawings where the re-production of the figures is of low visual quality cannot be remedied by Rule 56 EPC.

2.

It is within the responsibility of the applicant to determine the scope of the disclosure by selecting a readable version of the application documents including the figures reproduced in the drawings. However, the question of what technical features the figures in the drawings show with respect to the claimed invention is not part of the formal examination procedure before the Receiving Section.



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: J 0012/14 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 27 March 2015

Appellant: Reebok International Limited
(Applicant) 11-12 Pall Mall
4th floor
London SW1Y 5LU (GB)

Representative: Wegner, Hans
Bardehle Pagenberg Partnerschaft mbB
Patentanwälte, Rechtsanwälte
Prinzregentenplatz 7
81675 München (DE)

Decision under appeal: **Decision of the Receiving Section of the
European Patent Office posted 24 March 2014**

Composition of the Board:

Chairwoman C. Vallet
Members: D. Prietzel-Funk
D. Rogers

Summary of Facts and Submissions

- I. This appeal lies against the decision of the Receiving Section dated 24 March 2014 refusing the request for the issuance of a communication under Rule 56(1) EPC concerning missing drawings with respect to the European Patent application 12150772.7.
- II. The application concerns performance apparel with a basis layer and one or more layers (garments worn during a physical activity) with improved functionalities. On 11 January 2012, the EPO received the patent application via EPO-line electronically. It was accompanied by a set of 19 drawings with 39 figures. Figures 1 to 37B were supposed to show schematic torsos with various views of the garment. When the application was received at the EPO some of the figures were partly blurred and Figs. 4 and 5 were nearly black all-over.
- III. The Receiving Section invited the appellant to remedy the deficiencies according to Rule 58 EPC and Rule 49(2) and (12) EPC.
- IV. The appellant filed two sets of drawings to replace the drawings on file. The first set was said to be identical to the drawings of the US priority document. The second set showed corresponding formal drawings.
- V. The new sets of drawings were not accepted by the Receiving Section for the reason that they revealed information which was not present in the original application documents.

- VI. The appellant then replaced all drawings on file by a further set of drawings in which the figures were either left out entirely (Figs. 4, 5) or they showed no further information other than the outer lines of a torso. Together with these drawings the application was published.
- VII. The appellant also requested the Receiving Section to issue a communication under Rule 56(1) EPC for the reason that the bad quality drawings filed with the application appeared to have missing parts, and those missing parts of the drawings were to be seen as "missing drawings" under Rule 56(1) EPC.
- VIII. With the impugned decision the Receiving Section rejected the request. The Receiving Section was of the opinion that there were no "missing drawings" within the meaning of Rule 56(1) EPC and that Rule 56 EPC only allowed the filing of missing drawings, but not the replacement of filed drawings by an identical set of better quality drawings, without losing the earlier filing date.
- IX. Following the dispatch of a communication with the Board's provisional opinion of the case, oral proceedings were held on 27 March 2015 where 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 it issue a communication under Rule 56(1) EPC.
- X. The appellant's arguments in support of this request can be summarised as follows:

The Receiving Section misunderstood the term "missing drawings" and did not properly take into consideration

the decision of the Legal Board of Appeal J 2/12 of 7 August 2013. According to this decision, different drawings replacing the drawings on file may be filed later according to Rule 56 EPC not only in a case where drawings were actually absent upon filing, but also if it could be established without having to apply technical knowledge that the drawings originally filed were not the drawings referred to in the description. In the present case the second situation above applied. Taking for example Fig.4, according to the brief description of the drawings on page 3 of the description this figure was supposed to show "a front view of a garment according to an embodiment of the present invention". It was immediately apparent without applying technical knowledge that no such thing was shown by Fig.4 as actually filed since the figure was almost entirely dark. The same was also true, *mutatis mutandis*, for each of Fig. 5, 8A, 10A, 10B, 13A, 13B, 15A, 16A, 16B, 17A, 17B, 18A, 20-22, 23A, 23B, 26, 28, 31A, 31B and 32-34. Thus, these were to be considered as missing in the sense of Rule 56 EPC.

According to decision J2/12 the Receiving Section was obliged to issue a communication once its attention had been drawn to the missing figures and to invite the appellant to file the missing drawings. This decision did not distinguish between filing wrong drawings and filing drawings of deficient quality. Rather it required the Receiving Section to compare the drawings as filed with the description. If the drawings were not the ones referred to in the description then drawings could be filed under Rule 56(1) EPC. Whether the drawings were missing because no, or wrong drawings had been filed, or whether bad quality, illegible versions of the correct drawings had been filed, makes no

difference: in the above cases Rule 56(1) EPC is applicable.

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 whether the drawings submitted with the original application are to be considered as "drawings referred to in the description [that] appear to be missing" within the meaning of Rule 56(1), first sentence, EPC which reads:
"(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. (...)
Hence, where a drawing referred to in the description appears to be missing from 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.
3. In the present case the Receiving Section, after having received the original application issued a communication under Rule 58 EPC for the reason that Figs. 4 and 5 as originally filed were black shapes and the other figures were blurred and thus contravened Rule 49(2) and (12) EPC. The preliminary aim of this communication was to optimize the visual quality of the

drawings as such. The Receiving Section was correct in its assessment that the originally filed drawings, Figures 1 to 39, belonged to the application documents submitted and were identical to those which were referred to in the description. The appellant did not argue against this view but rather confirmed it in its letter dated 23 April 2012, page 2 under number 3, where it stated that the drawings were "erroneously submitted with a quality worse than in the priority document". Thus, the problem related to the bad quality of the filed drawings and not to whether these drawings actually belonged to the application at all.

4. The question is whether the construction of Rule 56(1) EPC allows the conclusion that the scope of the Rule encompasses not only missing drawings but also the replacement of bad quality drawings with better quality versions of the same drawings. Decision J 2/12 to which the appellant referred relates to this question. But, contrary to the appellant, the Board did not find that the principles and main considerations set out in this decision were also applicable in the present case.

5. In decision J2/12 the Legal Board decided that not only drawings that were physically absent from the original application could be seen as missing drawings within the meaning of Rule 56 EPC but also, for example, those drawings where - firstly - the brief and the detailed description contained named and numbered features, which did not correspond at all to the filed drawings, and where - secondly - this could be established by the Receiving Section during the initial formal examination without having to apply technical knowledge. In J2/12 drawings were submitted which did not belong to the application as filed. The catchword for the decision reads as follows:

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).

6. However, the facts of the present case differ in that the drawings originally filed consisted of the correct and full number of drawings with figures 1 to 39. These were the drawings referred to in the description and clearly showed correspondence to the filed description as far as they were readable. No error as to the identity of the drawings took place at any time. The decisive point is that the drawings and thus the contained figures were of such bad quality that the figures did not reveal the details they should have revealed in order to contribute to a proper disclosure of the invention.

7. As an example, Fig. 4 of the present case showed in the originally filed drawings the reference numbers 10, 100 and 224 which were the same as in the description (see paragraphs 73 and 82). However, the content of Fig. 4 could not be distinguished properly due to the bad quality of the drawing, and the same applies to a lesser degree *mutatis mutandis* also to the other figures in the drawings concerned. In such a case, Rule 56 EPC cannot remedy this error. This Rule is directed

to the question of the physical presence or absence of drawings belonging to the original application documents. It is not concerned with preventing a possibly insufficient disclosure of the invention resulting from the deficient visual quality of the figures reproduced in the originally filed drawings. The decision J2/12 for its part deals *inter alia* with the question as to the extent of the investigation that the Receiving Section could be expected to carry out in order to determine whether the filed drawings belong to the application documents or not - and, if not, the correct drawings would be "missing" ones and the appellant would be invited to file these missing drawings. The case at hand concerns a different problem.

8. It is the responsibility of the applicant to determine the scope of the disclosure by selecting a readable version of the application documents, including the figures reproduced in the drawings. The question of what exactly the figures in the drawings show with respect to the claimed invention is not part of the formal examination procedure before the Receiving Section (see decision J 4/09 of 28 July 2009, point 2 of the Reasons).

9. The appellant argued that, according to case J2/12 a drawing is a "missing drawing" if it can be established without having to apply technical knowledge that the drawings originally filed with the application were not the drawings referred to in the description. In that case the brief description of the drawings referred to something not shown in the filed drawings and furthermore, the detailed description referred to numbered and named features which were not to be found in the filed drawings. This was, according to the

appellant, also the situation in the present case. As to Fig. 4 as an example, according to the brief description of the drawings on page 3 of the application, the figure is supposed to show "a front view of a garment according to an embodiment of the present invention". Actually the filed Figure 4 did not show a garment, and in particular no back surface 104, no flexibility layer 200 and no C-shaped portion 220 as mentioned in the brief description for Figure 4. Thus, there was no correspondence between the description and the drawing at all, and the same was true *mutatis mutandis* to all the other drawings concerned.

10. In the Board's opinion however, this interpretation of Rule 56 (1) EPC is not supported by the findings of decision J 2/12. In that case no correspondence between the drawings and the description was found because what was shown in the drawings was clearly - and without having to apply technical knowledge - not what the description said about the figures and thus the correct drawings were missing in the sense of Rule 56 EPC. In the present case, the drawings were the correct ones and, if they had been filed with a better visual quality, they would have shown exactly what was said in the description. In such a case Rule 56 EPC is not applicable.

11. The situation at issue corresponds exactly to the provisions of Rule 58 EPC. This is why the Receiving Section correctly applied Rule 58 EPC and Rule 49(2) and (12) EPC and invited the appellant to remedy the deficiencies. In such a situation there is no reason to construe Rule 56 EPC in such a broad way so as to extend its application into the domain of Rule 58 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



C. Eickhoff

C. Vallet

Decision electronically authenticated