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**D E C I S I O N**  
**of 27 April 2006**

**Case Number:** T 0343/02 - 3.5.01

**Application Number:** 93918513.8

**Publication Number:** 0605717

**IPC:** H04N 1/10, H04N 1/32

**Language of the proceedings:** EN

**Title of invention:**  
Automatically initiated scanning system

**Patentee:**  
Soque Holdings, Ltd.

**Opponents:**  
Dov and Ophira Rosolio Aharonson

**Headword:**  
Scanning system/SOQUE HOLDINGS

**Relevant legal provisions:**  
EPC Art. 54(2)(3)(4), 100(a)(c), 111(1)  
EPC R. 23a  
RPBA 10b(1)

**Keyword:**  
"Late-filed document - admitted (yes)"  
"Remittal for further prosecution (yes)"

**Decisions cited:**  
G 0010/91, T 0831/01

**Catchword:**  
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Case Number: T 0343/02 - 3.5.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.01  
of 27 April 2006

**Appellants:** Dov and Ophira Rosolio Aharonson  
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**Representative:** Allsop, John Rowland  
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**Respondent:** Soque Holdings, Ltd.  
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**Representative:** Zeitler - Volpert - Kandlbinder  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 17 January 2002  
rejecting the opposition filed against European  
patent No. 0605717 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** S. Steinbrener  
**Members:** K. Bumés  
E. Lachacinski

## Summary of Facts and Submissions

I. The appeal lies from the Opposition Division's decision to reject the opposition against European patent No. 0 605 717.

II. In an interlocutory decision T 343/02 dated 20 January 2003, the Board has found the appeal to be admissible despite a slight underpayment of the appeal fee resulting from a deduction of bank charges, since the deduction was due to unexpected circumstances.

III. The Opposition Division has rejected the objections raised by the opponents pursuant to Article 100(a) and (c) EPC, viz. lack of novelty over

D4: EP-A-0 556 067 (prior art under Article 54(3) EPC) and an extension beyond the content of the application as filed and published (WO-A-94/03994).

IV. The appellant joint opponents request that the decision under appeal be set aside and the patent be revoked.

V. The respondent patentee requests that the appeal be dismissed. The respondent thus defends claim 1 as granted:

"1. A system comprising  
a scanning input device (14),  
a computer (10), and  
means (12) for connecting the input device (14) to  
the computer and to establish a communication between  
them,  
wherein said scanning input device comprises

detector means (22) for detecting the placement of a document (16) by a user,  
scanning means for generating image data representing the image of the document, and  
means, responsive to the detector means, for drawing the document into scanning relationship with said scanning means so that said scanning means generates said image data, wherein said placement alone is sufficient to initiate said drawing, and  
said computer comprises  
means for displaying (26), automatically and immediately in response to said placement and receipt of said image data, a visual representation of said image data."

VI. The Board issued a communication comparing the scanning system of claim 1 with that of D4 on a preliminary basis and pointed out a critical issue for discussion. The appellants replied by requesting oral proceedings, and the Board summoned the parties.

VII. In preparation for the oral proceedings, the appellants have cited a document which is to be regarded as prior art pursuant to Article 54(2) EPC:

D5: EP-A-0 411 698.

VIII. The appellants' arguments are summarised as follows.

Regarding D4, this document anticipates the claimed scanning system despite different language. In particular, the feature that the image data is displayed "automatically and immediately" when a document is placed in the scanning input device is implied by the master mode described in D4 which uses a

"spool" directory storing the scanned data for an application to retrieve it (column 6, lines 32 to 54). Using a spool directory as a buffer between a quick image data source and a slow retrieving application was synonymous with outputting the image data automatically and immediately to a display device (such as monitor H2 in Figure 1 of D4).

D5 is cited because it forms the basis of a prior art objection to an application in the appellants' name which covers the same subject-matter as the opposed patent. The appellants' application has been refused and that refusal has been confirmed by the Board (in a different composition) in parallel appeal proceedings T 831/01 (not published in OJ EPO). Therefore, it would be judicially untenable to maintain the opposed patent.

D5 is introduced at a late stage because for a long time the appellants did not expect their own application to fail with respect to this prior art in the parallel appeal proceedings and did not become aware of a possible refusal based on D5 until receiving the Board's provisional opinion in that case.

The objection pursuant to Article 100(c) EPC has been withdrawn by the appellants at the oral proceedings before the Board.

- IX. With respect to D4, the respondent argues that the concept of spooling relates conventionally to the buffering of print data which a printer can retrieve at its own (slower) rate. The respondent has never heard about spooling image data for display. Therefore, displaying scanned data automatically and immediately

in response to a document being placed in the scanning input device constitutes a novel feature over D4.

As to D5, the respondent objects to its late introduction because that document emerged in the parallel appeal proceedings in February 2000, i.e. the appellants must have known it when they filed their opposition to the present patent (June 2000).

In any event, the respondent does not consent to discussing D5 with respect to inventive step before the Board since that would be a fresh ground for opposition (G 10/91, OJ EPO 1993, 420, Headnote 3).

- X. At the end of oral proceedings, the chairman pronounced the Board's decision.

## **Reasons for the Decision**

### *1. Comparison with the prior art according to D4*

It is common ground that D4 represents prior art under Article 54(3) and (4) EPC and, thus, can be used to challenge only the novelty of the claimed scanning system but not its inventive step (Article 56, second sentence EPC). The Board notes with respect to Rule 23a EPC that designation fees have been paid in relation to D4.

- 1.1 While D4 describes a document-triggered scanning operation (D4, column 6, lines 34 to 37 and lines 50 to 54), the decision under appeal (points 12 to 15) states that D4 fails to disclose the claim feature relating to

the *automatic and immediate display* of a visual representation of the scanned image data in response to the placement of a document and receipt of the image data.

- 1.2 The appellants argue that an automatic and immediate display of the scanned image is implied in the master mode of D4 according to which "the host receives the scanned data into a "spool" directory where it is stored for application to retrieve it" (D4, column 6, lines 32 to 54). Spooling is said to be an average engineer's professional way of describing how a data-producing application communicates with a data output function/application "automatically and immediately" under the operating system.
  
- 1.3 The Board notes that the spool concept in its broadest meaning relates to the technique of sending a file to a buffer for further processing at a lower rate and is known mainly in relation to printer functions (printer spoolers). A display means as a destination of spooled data files has not been shown by the appellants and is unknown to the respondent and to the Board. The appellants consider this distinction as merely linguistic or "splitting hairs" (grounds of appeal, point 20) but the Board is not convinced that the short general statement "spool directory where it [the scanned data] is stored for application to retrieve it" (D4, column 6, lines 52 to 54) teaches unambiguously and specifically that the scanned image should be retrieved, automatically and immediately upon scanning, by a displaying application, even though the scanning system of D4 admittedly starts the scanning process in an automatic manner (D4, column 6, lines 32 to 37),

comprises a monitor (Figure 1, reference sign H2; column 4, lines 40 to 45), and holds the image data in the spool buffer for retrieval by an (unspecified) application.

1.4 Therefore, the Board judges that the claimed scanning system is novel over the teaching of D4 in that the system comprises means for displaying, *automatically and immediately in response to said placement and receipt of said image data*, a visual representation of said image data.

2. *Late-filed document D5*

2.1 The Board accepts the appellants' explanation that they have not cited D5 (used against their application in the parallel appeal procedure T 831/01 relating to similar subject-matter) until they realised the imminent loss of their own application. So long as they considered D5 not to be detrimental to their own application, it was logical for them to regard D5 as immaterial to the opposed patent as well.

2.2 The Board does not consider D5 as a complex document (Article 10b(1) RPBA). D5 comprises only eight columns of text and relates to technology which can be compared with the claimed matter in a straightforward manner. D5 was cited for the first time eight weeks before the oral proceedings and was notified to the respondent at least six weeks before the oral proceedings. Moreover, the appellants focused only on a short passage of D5 (column 6, lines 5 to 50).



Hence, the Board judged that document D5 should be admitted into the proceedings.

3. *Remittal*

Since D5 appears to constitute relevant prior art, the Board exercises its discretion under Article 111(1) EPC to remit the case to the Opposition Division in order to give both parties an opportunity to take account of the additional document in two instances.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

P. Guidi

S. Steinbrener