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**D E C I S I O N**  
**of 28 April 2004**

**Case Number:** T 0820/02 - 3.5.1

**Application Number:** 01101680.5

**Publication Number:** 1100273

**IPC:** H04N 7/50, H03M 7/42, H04N 7/30

**Language of the proceedings:** EN

**Title of invention:**  
Image decoding method using variable length codes

**Applicant:**  
MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.

**Opponent:**  
-

**Headword:**  
Image decoding/MATSUSHITA

**Relevant legal provisions:**  
EPC Art. 76(1), 109(1), 111(1)

**Keyword:**  
"Extension beyond the content of the earlier application - no"  
"Remittal to the first instance - yes"

**Decisions cited:**  
G 0010/93

**Catchword:**  
-



Case Number: T 0820/02 - 3.5.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.1  
of 28 April 2004

**Appellant:** MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.  
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**Representative:** Balsters, Robert  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 12 February 2002  
refusing European application No. 01101680.5  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** S. V. Steinbrener  
**Members:** R. R. K. Zimmermann  
E. Lachacinski

## Summary of Facts and Submissions

- I. European patent application 01 101 680.5 (EP-A-1 100 273) concerns an image compression method using run-level and variable length coding. It was filed on 6 November 1997 as a divisional application of the earlier application 97 911 464.2 (EP-A-0 873 018).
- II. In a communication, the examining division informed the applicant that it was not able to determine the passages of the earlier application on which the claims of the divisional application were based.

Therefore, the applicant was requested to indicate which parts of the parent application document was to form the basis of the present set of claims.

In addition, the examining division objected lack of inventive step, citing two prior art documents from the European search report and indicating that "all essential features of claim 1 appear(ed) to be disclosed" in a first one of these documents and the features relating to the claimed code transformation of run and level values were to be "considered as obvious alternatives" in view of a particular drawing of the second document.

- III. In response to the communication, the applicant filed following claims:

"1. An image decoding method for extracting a variable length code from a compression-coded data, obtaining an event corresponding to said variable length code using a variable length code table wherein a reference event

consisting of (Last, Run, Level) is assigned to each reference variable length code, and deriving an output transform coefficient from said event, the method further comprising;

judging whether said variable length code includes a control code, a first mode code, a second mode code or a third mode code (S903, S905, S907),

obtaining an event corresponding to said variable length code by using said variable length code table in the case when said variable length code is judged to include none of said control code, said first mode code, said second mode code and said third mode code (S904),

obtaining an event corresponding to said variable length code by using said variable length code table and then obtaining a transformed event by transforming the Level value of said event corresponding to said variable length code using a predetermined function in the case when said variable length code is judged to include said control code and said second mode code (S906),

obtaining an event corresponding to said variable length code by using said variable length code table and then obtaining a transformed event by transforming the Run value of said event corresponding to said variable length code using a predetermined function in the case when said variable length code is judged to include said control code and said third mode code (S908),

obtaining an event by subjecting said variable length code to fixed length decoding in the case when said variable length code is judged to include said control code and said first mode code (S909).

2. The image decoding method according to claim 1, wherein the control code is "0000011", the first mode code is "11", the second mode code is "0", and the third mode code is "10".

3. The image decoding method according to claim 1, wherein the predetermined function for transforming the Level value is defined as:  
the transformed Level value = sign(the resultant Level value) x [abs(the resultant Level value) + a predetermined Offset value].

4. The image decoding method according to claim 1, wherein the predetermined function for transforming the Run value is defined as:  
the transformed Run value = the resultant Run value + (a predetermined Offset value + 1)."

These claims differed from the previous claim version only in that reference numerals were added and some typographical errors corrected. Concerning the invitation to indicate wherefrom in the earlier application the claims had been derived, the applicant referred to embodiment 3 and Figure 9 of the earlier application.

IV. Without any further communication, the examining division refused the application by a written decision posted on 12 February 2002. The only reason given for the refusal was that claims 1 to 4 did not comply with Article 76(1) EPC.

In respect of claims 2 to 4, the decision did not give any explicit reasoning for alleged non-compliance with the EPC.

V. The applicant lodged an appeal against the refusal decision. The notice of appeal, including a debit order in respect of the appeal fee, was received by the European Patent Office on 16 April 2002, the written statement setting out the grounds of appeal on 10 June 2002.

VI. With the appeal grounds, the appellant filed a claim 1 amended by

introducing after the words "image decoding method" a reference "(Fig. 9)" to the drawings,

amending the second paragraph of claim 1 to read:  
"judging whether said variable length code includes a control code (S903),"

amending the third paragraph of claim 1 to read:  
"obtaining an event corresponding to said variable length code by using said variable length code table in the case when said variable length code is judged not to include said control code (S904),"

and by adapting the three last paragraphs in respect of the definition of the first, second and third mode codes. Claims 2 to 4 remained unchanged.

VII. The appellant adhered to the view that with the new set of claims the divisional application was fully supported by the earlier application, therein in particular by Figure 9, step S904.

VIII. Accordingly the appellant requested that the decision under appeal be cancelled and, as an auxiliary request, oral proceedings should be held if the Board intended to maintain the decision of the examining division.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Moreover, the appeal is allowable on the basis of the appellant's request to reverse the impugned decision since the present set of claims complies with the requirements of Article 76(1) EPC (see points 3 ff. below).

Furthermore, the case is to be remitted to the examining division for further prosecution (see point 9 below).

3. Legal basis for the refusal is the first half of the second sentence of Article 76(1) EPC. According to this provision, a European divisional application "may be filed only in respect of subject-matter which does not

- extend beyond the content of the earlier application as filed".
4. It is sufficient to consider points 7 to 10 of the decision under appeal which are the only parts of the decision which contain some sort of reasoning for the alleged non-compliance with Article 76(1) EPC.
  5. The examining division based its objection on the allegation that the third paragraph of claim 1 (refused version) could not be identified in the earlier application, in particular in Figure 9 which was - according to the applicant - to form the basis for the claim. In accordance with step S903 it was determined whether or not "no control code" was included, however it was not judged whether the variable length code included "none of said control code, said first mode code, said second mode code and said third mode code." In particular, nothing was said in claim 1 that if no control code was received it was not necessary to judge if any of the first, second and third mode codes was received, since these possibilities were excluded when no control code was received. More generally speaking, the division held that the claim did not specify the sequence in which the codes (control code, first mode code, second mode code and third mode code) were determined in Figure 9.
  6. In the Board's view these objections have clearly been overcome by the amendments to claim 1 filed with the statement of grounds. In accordance with Figure 9 and the passages of the description relating to corresponding embodiment 3 of the earlier application, it is first judged whether the variable length code



includes a control code (second paragraph of present claim 1; cf. step S903 and column 19, lines 44 to 46 of the earlier application (A-publication)), and then the sequence of different possibilities resulting from this judgement is clearly set out in the following four paragraphs of the claim (cf. steps S904 to S909 and column 19, line 44 to column 20, line 3 of the earlier application).

7. In summary, claim 1 as amended is fully supported by the embodiment of Figures 8 and 9 of the earlier application and does thus not infringe Article 76(1) EPC.
  
8. Finally, regarding the dependent claims 2 to 4, the divisional application has a clear basis in column 18, lines 15 to 20 and 26 to 30, column 18, line 37 to column 19, line 18, and column 19, lines 54 to 58, in particular in connection with column 10, lines 45 to 54 and column 14, line 47 to column 15, line 13 of the earlier application.

It follows that under these circumstances the examining division should have rectified its decision under Article 109(1) EPC.

9. Exercising its discretion given under Article 111(1), second sentence, EPC, the Board decides to remit the case to the examining division for further prosecution.

Remittal to the examining division is appropriate in the present case since the examining division did not decide on patentability requirements. Although the issue of inventive step was addressed *obiter* in the

communication, the opinion given by the examining division was provisional in character and appears, *prima facie*, inconclusive in respect of features concerning the code transformation.

To proceed with the case, the Board would first have to carry out a full examination of the application, which is the task of the examining division (see decision G 10/93 - Scope of examination in *ex parte* appeal / SIEMENS, OJ EPO 1995, 172, section 4 of the Reasons).

## **Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener