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D E C I S I O N
of 11 October 2005

Case Number: T 0830/02 - 3.5.01

Application Number: 93115466.0

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IPC: G06K 7/10

Language of the proceedings: EN

Title of invention:
Scanning module

Applicant:
SYMBOL TECHNOLOGIES INC.

Opponent:

-

Headword:
Slim line module/SYMBOL TECH.

Relevant legal provisions:
EPC Art. 84, 123(2)
EPC R. 29(1), (3)

Keyword:
"Added subject-matter (after amendment - no)"
"Essential features present in the independent claim (yes)"

Decisions cited:
T 0032/84

Catchword:

-



Case Number: T 0830/02 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 11 October 2005

Appellant: SYMBOL TECHNOLOGIES INC.
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Representative: Wagner, Karl H.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 March 2002
refusing European application No. 93115466.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Wibergh
Members: K. Bumés
G. Weiss

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 93115466.0.
- II. According to the decision appealed, claim 1 of the main and auxiliary requests before the examining division contravened Article 84 EPC because they did not comprise all features which had to be regarded as essential according to the original disclosure. Furthermore, since the claim wording encompassed a module having two circuits on one and the same circuit board, it covered a non-disclosed intermediate generalization, contrary to Article 123(2) EPC.
- III. The grounds of appeal were filed by letter dated 24 July 2002. The appellant requested grant of a patent based on the claims according to the main or auxiliary request on file.
- IV. By communication of 5 April 2005, the Board expressed its opinion that claim 1 contravened Article 123(2) EPC. To overcome this objection it appeared that the following features should be included in the claim:
- a first circuit board forming an outer side of the scanning module,
 - first circuit means mounted on the first circuit board,
 - a second circuit board forming another outer side of the scanning module, and
 - second circuit means mounted on the second circuit board

Furthermore, the Board stated that it did not intend to grant a patent since the decision appealed was silent on the issues of novelty and inventive step. An option was however remittal of the case to the examining division for further prosecution.

V. By letter dated 15 September 2005, the appellant filed amended claims according to a main and an auxiliary request and requested that the case be remitted to the examining division for further prosecution.

VI. Claim 1 according to the main request reads:

"1. A scanning module (400) for reading optically encoded indicia having portions of differing light reflectivity, said module comprising:
a base(410);
an emitter (600') for emitting a beam of light;
means (359) for directing the beam of light toward the optically encoded indicia;
support means (300) for mounting the directing means (359) for oscillating movement;
means (309, 333) for producing a reciprocal motion of the directing means (359) on said support means (300) such that the beam of light scans across a surface on which said indicia appears;
detector means (358) for receiving light reflected back from the surface and for producing electrical signals corresponding to the differing light reflectivity of the optically encoded indicia;
a first circuit board (416) forming an outer side of the scanning module (400);

first circuit means mounted on said first circuit board (416);
a second circuit board (418) forming another outer side of said scanning module (400);
second circuit means mounted on said second circuit board (418);
wherein said first and second circuit means operate to produce signals to drive the emitter (600'), to produce signals to drive the means (309, 333) for producing a reciprocal motion and to process the electrical signals produced by the detector means (358)."

Reasons for the Decision

1. The examining division objected under Article 123(2) EPC to claim 1 covering a module comprising first and second circuit means mounted on a single circuit board. Since claim 1 according to the present main request is limited to a module comprising a first circuit board on which first circuit means are mounted and a second circuit board on which second circuit means are mounted, an embodiment which has been clearly disclosed, this objection has been overcome.
2. Furthermore, the examining division objected under Article 84 EPC to the omission in claim 1 of features, regarded as essential, contained in original claim 1. This claim included a number of features not contained in present claim 1, such as
 - the first circuit board being mounted orthogonal to the base
 - at one end of the base;

- the second circuit board being mounted orthogonal to the first circuit board and
- parallel to the base;
- electrical connection means connecting the first and second circuit means to each other.

2.1 The Board does not uphold the division's objection. According to T 32/82 (OJ 1984,354), essential features are "all features which are necessary to obtain the desired effect or, differently expressed which are necessary to solve the technical problem with which the application is concerned". The technical problem in this case can only be the one given in the description (since the decision under appeal mentions no prior art documents), which is the problem of miniaturization. It appears that the feature that two circuit boards form outer sides of the scanning module is already likely to solve, at least to some degree, this rather general problem. Therefore, it is not certain that the other features omitted from claim 1 - and in particular the one mentioned explicitly in the decision under appeal, namely the two circuit boards being mounted orthogonally to each other - are *essential* for the solution to the problem mentioned (and not merely "helps to achieve the object", to quote the decision under appeal). Whether or not further limitations are required is a matter to be decided when the invention is examined for novelty and inventive step.

2.2 The examining division raised no objection under Article 123(2) EPC with respect to these omissions, apparently because they regarded original claim 10 as providing sufficient (formal) support for them. The Board agrees that this article is complied with.

3. The Board thus holds that claim 1 of the main request includes all features necessary to solve the technical problem mentioned in the description (Article 84 with Rule 29(1), (3) EPC) and contains no subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC).

4. Since the appellant's request for remittal to the examining division on the basis of claim 1 of the main request can be granted, there is no need to consider the auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

M. Kiehl

S. Wibergh