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**Datasheet for the decision
of 22 March 2007**

Case Number: T 0774/03 - 3.5.04

Application Number: 97117969.2

Publication Number: 0837592

IPC: H04N 1/00

Language of the proceedings: EN

Title of invention:

Facsimile device with efficient relay capability for file data

Applicant:

MURATA KIKAI KABUSHIKI KAISHA

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 54

Keyword:

"Novelty (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0774/03 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 22 March 2007

Appellant:

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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 3 March 2003
refusing European application No. 97117969.2
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: F. Edlinger
Members: A. Teale
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the decision by the examining division to refuse European patent application no. 97 117 969.2 because the subject-matter of all claims lacked novelty, Articles 52(1) and 54(1,2) EPC, having regard to the following document:
- D2: US 5 428 458 A.
- II. The applicant appealed, requesting that the decision be cancelled and that a patent be granted. With a subsequently filed statement of grounds of appeal dated 14 July 2003 the appellant submitted a set of amended claims 1 to 4, claims 2 to 4 being dependent on claim 1.
- III. In an annex to a summons to oral proceedings the board questioned whether the subject-matter of claim 1 was novel with respect to D2.
- IV. In the oral proceedings held on 22 March 2007 the appellant submitted an amended claim 1 and requested that the decision under appeal be set aside and that a patent be granted on the basis of the claim 1 received during the oral proceedings and claims 2 and 3 filed with the letter of 14 July 2003.
- V. Claim 1 reads as follows:
- "Facsimile device (200) having the function to receive file data and/or facsimile data via a communication line in form of a telephone line and to relay this data to another specified facsimile device (301, 302) received through a network control unit (NCU 17)

connectable to the telephone line of the facsimile device (200), comprising

- means for checking whether or not the relay function is specified (S 15),
- means for checking whether or not the received data is file data or facsimile data according to a control signal of a pre-message protocol (S 30), and when the received data is facsimile data relaying the received data (S 35) directly to the specified facsimile device (301),
- means for, when the received data is file data and the specified facsimile device (301) has a transfer function for file data (S 17), directly transmitting (S 18) the received file data to the specified facsimile device (301), and
- means for, when the specified facsimile device (302) does not have the transfer function for file data, converting (S 21) the received file data to facsimile data and then transmitting it to the specified facsimile device (302)."

VI. In the oral proceedings the appellant argued essentially that due to the amendments to claim 1 the most relevant parts in D2 to the invention were now those relating to receiving faxes via the telephone line, whereas in the appealed decision they had been those parts relating to file data from the computer passing via the external device and being transmitted along the telephone line. There was no mention in D2 of receiving file data via the telephone line or of an incoming fax being passed from the telephone line to the computer. In contrast the claimed facsimile device could receive file data and/or facsimile data via the telephone line.

VII. At the end of the oral proceedings the board announced its decision.

Reasons for the Decision

1. The appeal is admissible.
2. *The amendments*

Editorial amendments aside, the amendments to claim 1, with respect to claim 1 on which the appealed decision was based, mean that the term "communication network" has been restricted to "communication line in form of a telephone line" and that claim 1 now also sets out that data is "received through a network control unit (NCU 17) connectable to the telephone line of the facsimile device (200)", "means for checking whether or not the relay function is specified (S 15)" and "means for checking whether or not the received data is file data or facsimile data according to a control signal of a pre-message protocol (S 30), and when the received data is facsimile data relaying the received data (S 35) directly to the specified facsimile device (301)". These amendments have a basis in the original application on page 6, lines 6 to 8 and last five lines, page 9, lines 1 to 3, page 10, lines 1 to 9, and in figure 3, steps S17 and S18, and figure 4, step S34.

The amendments consequently comply with Article 123(2) EPC.

3. *The prior art D2*

D2 concerns a multi-function image communicating apparatus. It can read-in documents, accept file data from a computer, receive facsimile data via a telephone line, print images and transmit images as file data or facsimile data via the same telephone line. The link between the computer and the apparatus is a SCSI, RS232C or Centronics computer interface; see column 7, lines 31 to 34. The appealed decision was based on regarding this link as the communication network in claim 1. The amendments to claim 1 exclude this possibility, since it is now stated that the file data and/or facsimile data is received "via a communication line in form of a telephone line". In D2 facsimile data received along the telephone line are printed out on the printer; see column 10, lines 21 to 52. D2 does not mention receiving file data via the telephone line.

The present application describes the Network Control Unit (NCU) set out in claim 1 as "a part that controls the communication functions ... that connects the device to the external phone lines"; see page 6, lines 6 to 8. In the board's view the same functions are provided in D2 by the facsimile unit 4; see figure 1 and column 8, line 44, to column 9, line 60.

D2 starts from background art where a document produced by the computer can be expressed in a page description language (PDL) such as LIPS or PostScript; see column 1, lines 22 to 28. The document can either be printed on the printer or transmitted via the telephone line to a fax machine; see column 1, lines 18 to 21. In the latter case the apparatus of the invention in D2 is

relaying file data received from the computer to the fax machine; see column 1, lines 59 to 66. It follows from this that D2 discloses means for checking whether or not the relay function is specified. There is however no mention in D2 of received facsimile data being relayed to another fax machine.

If the document from the computer is to be transmitted then the apparatus checks in the pre-message phase "B" of the CCITT T30 call protocol to see whether the called fax machine can receive file data in LIPS or PostScript format; see column 12, line 30, to column 14, line 12, and figure 10. If it can then the document is transmitted in this format. If not, then the file data is converted into facsimile format (D2 uses the term "develop") by the formater before transmission; see column 7, lines 42 to 44, and figure 10, step S102.

4. *Novelty*

The subject-matter of claim 1 consequently differs from the disclosure of D2 in that the facsimile device has the function to receive file data and/or facsimile data via a communication line in form of a telephone line, the means for checking are for checking the data received via said communication line, and means to relay this data to another specified facsimile device depending on the result of the checking specified in claim 1.

The subject-matter of claim 1 is consequently new, Articles 52(1) and 54(1,2) EPC.

5. *Remittal*

Since claim 1 has been substantially amended on appeal and since the examining division found the subject-matter of all claims then on file to lack novelty, the amendments made before the board raise issues, such as inventive step, which have not been decided on by the first instance. The board consequently exercises its discretion under Article 111(1) EPC to remit the case to the first instance so that the appellant may have the benefit of two legal instances.

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:

D. Sauter

F. Edlinger