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**Datasheet for the decision
of 30 March 2007**

Case Number: T 0367/04 - 3.5.04

Application Number: 94120449.7

Publication Number: 0661881

IPC: H04N 7/173

Language of the proceedings: EN

Title of invention:

Image-information storage regenerating device

Applicant:

SHARP KABUSHIKI KAISHA, et al

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 108

EPC R. 65(1), 86(3)

Keyword:

"Form of appeal - admissible (no)"

Decisions cited:

T 0729/90, T 0162/97

Catchword:

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Case Number: T 0367/04 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 30 March 2007

Appellant: SHARP KABUSHIKI KAISHA, et al.
22-22 Nagaike-cho
Abeno-ku
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Osaka-fu 545-0013 (JP)

Representative: Müller, Frithjof E.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 10 October 2003
refusing European application No. 94120449.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: F. Edlinger
Members: C. Kunzelmann
T. Karamanli

Summary of Facts and Submissions

- I. On 9 December 2003 the appellants (applicants) filed a notice of appeal against the decision of the examining division posted on 10 October 2003 to refuse European patent application No. 94 120 449.7 and paid the appeal fee on the same day. A statement of grounds of appeal was filed on 19 February 2004.
- II. The reasons given in the contested decision which was taken according to the state of the file can be summarised as follows.

The amendments filed with letters dated 6 August 2002 and 21 February 2003 were not admitted under Rule 86(3) EPC because the applicants had had enough opportunities to amend the application, since they had filed 7 and 8 sets of amended claims respectively, and oral proceedings had been held in which the examining division expressed the intention to grant a patent on the basis of the auxiliary request. The examining division saw no reason to start again with the examination of the application at such a late stage of the proceedings. The application had to be refused under Article 97(1) EPC because there was no approval of the text in which the examining division intended to grant the patent according to its communication under Rule 51(4) EPC dated 5 February 2002 and, therefore, there was no text of the application which had been agreed by the applicants and allowed by the examining division.

- III. The examining division did not rectify the decision under appeal, but remitted the appeal to the board of appeal in accordance with Article 109 EPC.
- IV. The appellants requested that the decision be set aside, and that a European patent be granted based on claims 1 to 4 as filed on 21 February 2003 (main request), or claims 1 to 4 as filed with the statement of grounds of appeal (auxiliary request).
As an auxiliary measure, the appellants requested that an official communication be issued and that oral proceedings be held.
- V. The appellants' statement setting out the grounds of appeal essentially related to the following issues.

The subject-matter of independent claims 1 and 4 of the main request and of the auxiliary request was new within the meaning of Article 54 EPC and involved an inventive step within the meaning of Article 56 EPC. "Constitutional" and functional differences existed between the subject-matter of the invention as claimed and the cited prior art documents. These differences provided advantages over the prior art.

- VI. With a communication dated 12 January 2007 and annexed to a summons to oral proceedings, the board gave its non-binding preliminary opinion on the admissibility of the appeal only. The board informed the appellants that the statement of grounds of appeal seemed to be insufficient to meet the requirements of Article 108, third sentence, EPC, because it comprised neither any allegation that the contested decision was incorrect nor any legal or factual reasons why the contested

decision should be set aside. In the board's view the appellants' submissions on novelty and inventive step with regard to the subject-matter of the claims of the main request and the auxiliary request had no apparent relation to the reasons of the contested decision. There were few exceptional circumstances under which it had been accepted according to the established case law that new claims filed with a view to overcome the objections on which the decision under appeal was based already rendered the appeal admissible (reference was made to "Case Law of the Boards of Appeal", 4th edition 2001, VII.D.7.5.1 and VII.D.7.5.2(d)). None of these exceptions seemed to be applicable to the present case.

VII. In a letter of 29 March 2007 the appellants announced that they would not attend the oral proceedings and requested that a decision be rendered according to the "status" of the file. No observations were made on the communication of the board.

VIII. In accordance with Rule 71(2) EPC, oral proceedings were held on 30 March 2007 in the absence of the appellants.

Reasons for the Decision

1. The appeal complies with Articles 106 and 107 and also with Article 108, first and second sentence, and Rule 64 EPC. Its admissibility therefore depends solely on whether the appellants' letter received within four months from the date of notification of the contested decision contains a "statement setting out the grounds

- of appeal" within the meaning of Article 108, third sentence, EPC.
2. It is established case law of the boards of appeal (see references in above cited "Case Law of the Boards of Appeal", VII.D.7.5.1) that, for the statement setting out the grounds of appeal according to Article 108, third sentence, EPC to be sufficient for the admissibility of an appeal, the appellant's arguments must be clearly and concisely presented to enable the board to understand why the decision is alleged to be incorrect, and on what facts the appellant bases his arguments, without first having to make investigations of its own. Moreover an appeal must deal with the reasons given for the decision under appeal.
 3. In the present case the appellants did not state explicitly that the decision under appeal was incorrect, but the fact that they maintained as main request the amended claims which had been refused by the examining division is interpreted by the board as an implicit allegation that the contested decision was wrong.
 4. Furthermore the statement setting out the grounds of appeal does not deal with the reasons given for the decision under appeal (see paragraph V *supra*). Rather, the statement contains only detailed submissions as to why the subject-matter of the main and auxiliary requests is novel and involves an inventive step. Consequently the statement of grounds of appeal does not enable the board to understand immediately why the contested decision is alleged to be incorrect.

5. It is therefore necessary to consider whether the fact alone that the appellant filed new amended claims as an auxiliary request renders the appeal admissible. In these circumstances the new amended claims have to overcome the objections of the first instance department (see for example T 729/90), and the causal link between the amended claims and the reasons given in the decision under appeal must be either explicitly explained or be immediately recognisable (see for example T 162/97). In the particular circumstances of the present case, where the examining division did not consent to amendments pursuant to Rule 86(3) EPC, it is not immediately recognisable that the mere filing of the new request overcomes the objections on which the decision under appeal was based. Moreover the appellants did not explain in their statement of grounds why they considered the reasoning in the decision under appeal to no longer apply in view of the amendments.

6. For these reasons the statement of grounds of appeal does not fulfil the requirements of Article 108, third sentence EPC. Thus the board has to reject the appeal as inadmissible in accordance with Rule 65(1) EPC.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

D. Sauter

F. Edlinger