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D E C I S I O N
of 25 February 2005

Case Number: T 1176/04 - 3.4.2

Application Number: 96108593.3

Publication Number: 0745880

IPC: G02B 26/10

Language of the proceedings: EN

Title of invention:

Optical element and a scanning optical apparatus using the same

Applicant:

Canon Kabushiki Kaisha

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 111

Keyword:

"Features objected to no longer present in claim 1 - remittal (yes) "

Decisions cited:

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Catchword:

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Case Number: T 1176/04 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 25 February 2005

Appellant: Canon Kabushiki Kaisha
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Tokyo (JP)

Representative: Leson, Thomas Johannes Alois, Dipl.-Ing.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 24 April 2004
refusing European application No. 96108593.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: M. A. Rayner
M. J. Vogel

Summary of Facts and Submissions

I. The applicant has appealed against the decision of the examining division refusing European patent application number 96 108 593.3 for lack of clarity in the sense of Article 84 EPC of claim 1 thereof. The application concerns elements in optical scanning. In the decision under appeal, while making several what it called comments about the independent claim before it, in the reasoning for its refusal, the examining division concentrated on two features. The division denoted these features as Fe1 and Fe2 and they are worded as follows:

Feature Fe1: "the calculated focal length in the sub scan direction is shorter than the focal length actually measured"

Feature Fe2: "the focal length is calculated by using the surface curvatures, the nominal refractive index of the plastic and the on-axis thickness"

The division considered these features so unclear as to render it not possible to determine whether an optical element would fall under the scope of the claim or not. Thus claim 1 lacks clarity contrary to Article 84 EPC and the clarity objections cannot be overcome even when considering the application as a whole. Therefore the application was refused.

II. The appellant requested grant of a patent according to a main or in the alternative a first to fourth auxiliary request filed with its letter dated September 7, 2004.

- III. In a communication to the appellant, the board of appeal observed that neither feature Fe1 nor feature Fe2 is contained in the independent claim of the main request of the appellant as there is no mention of focal length at all. The board therefore reached the preliminary view that the line of reasoning advanced by the examining division did not apply to independent claim 1 of the main request as presented to the board. While the board had seen comments made by the examining division, which could be understood as pertaining to substantive patentability, a comprehensively reasoned position in this respect in relation to independent claim 1 of the main request as presented to the board was also not available. The preliminary position of the board was thus that in order not to prejudice the possibility of examination by two instances, it was considering remitting the case back to the examining division for further prosecution, without making any further remark on the merits as this might influence the subsequent procedure.
- IV. In reply to the communication of the board, the appellant remarked that the board of appeal considered remitting the case back to the examining division for further prosecution on the basis of the documents according to the appellant's main and first to fourth auxiliary requests filed with its letter dated September 7, 2004. The appellant declared its consent to the case being remitted back to the Examining Division for further prosecution. The appellant requested oral proceedings as an auxiliary measure should the Board of Appeal not remit the case back to the Examining Division.

V. Claim 1 of the main request is worded as follows:

"A scanning optical apparatus comprising:

light source means (1);

deflector means (5) for deflecting a light beam emitted from said light source means (1) in a main scan direction of said scanning optical apparatus;

a first optical element (2, 4) for receiving said light beam emitted from said light source means and guiding said light beam on a deflection surface (5a) of said deflector means (5); and

a second optical element (6) for receiving the light beam deflected by said deflector means (5) to form a spot image on a scanned surface (8), wherein said second optical element (6) is formed by plastic molding,

characterized in that

said second optical element (6) is comprised of a plastic material having an internal refractive index distribution in a subscan direction,

wherein, in said subscan direction, the refractive index is smaller in the center of said second optical element (6) than at the circumference thereof, and in that a best image plane (81) with least wave front aberration is positioned over said scanned surface (8)."

The wording of the independent claims of the auxiliary requests is not given as it is not dealt with in this decision (see section 2 of the Reasons below).

Reasons for the Decision

1. The appeal complies with the provisions referred to in Rule 65(1) EPC and is therefore admissible.
2. Since features Fe1 and Fe2 which were considered not to be clear by the examining division are not present in the independent claim of the main request presented on appeal, the basis for refusing the application has been removed in respect of this claim. Since a complete examination of the application as presented has not been made by the first instance, the board is not itself able to examine the case without running the risk of the appellant being deprived of an instance with respect to matters not finally resolved before the first instance. Therefore the board considers it appropriate in the present case back to the first instance for further prosecution as consented to by the appellant.
3. As the board did not decide on the merits of the main request, it was not appropriate to consider the auxiliary requests. Moreover, since the request for oral proceedings was conditional on the case not being remitted, no oral proceedings before the board are necessary as the condition is not fulfilled.

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:

P. Martorana

A. G. Klein