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**Datasheet for the decision
of 25 September 2007**

Case Number: T 1279/04 - 3.4.03

Application Number: 96303159.6

Publication Number: 0741339

IPC: G03G 15/02

Language of the proceedings: EN

Title of invention:

Modular charging device for imaging system

Applicant:

Xerox Corporation

Opponent:

Eastman Kodak Company

Headword:

-

Relevant legal provisions:

EPC Art. 52(1), 56, 69

Keyword:

"Inventive step (no)"

"Claim interpretation under Article 69(1) EPC"

Decisions cited:

-

Catchword:

Reasons 3.



Case Number: T 1279/04 - 3.4.03

DECISION
of the Technical Board of Appeal 3.4.03
of 25 September 2007

Appellant:
(Patent Proprietor)

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 18 June 2004
revoking European patent No. 0741339 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: R. G. O'Connell
Members: R. Bekkering
U. Tronser

Summary of Facts and Submissions

I. This is an appeal against the revocation of EP 0 741 339 for lack of novelty over

D8: US-A-5 206 784

The appellant proprietor requested that the decision under appeal be set aside and the patent maintained as granted (main request) or according to first, second or third auxiliary requests.

II. The respondent opponent requested dismissal of the appeal.

III. In a submission the respondent opponent referred *inter alia* to the following further prior art document cited in the opposition procedure:

D1: US-A-4 695 723

IV. Oral proceedings were held before the board in the absence as forewarned of the appellant proprietor.

V. Claim 1 of the main request reads as follows:

"1. A modular charging device for use in a printing or imaging system, comprising a plurality of individual substantially alike charging units (6) attached to a bracket (4), said bracket comprising means for attaching the bracket to a charging subsystem of a printing or imaging apparatus, and means for interconnecting electrical components of the plurality of individual charging units (6)."

VI. In the first auxiliary request, dependent claim 2 of the main request which reads:

"2. *The device of claim 1, wherein each charging unit (6) is selected from the group consisting of corotron, scorotron, dicorotron, bias member, and roller charger.*"

has been amended to read (additions bold, deletions struck through):

"2. *The device of claim 1, wherein each charging unit (6) is **a corona discharge device** selected from the group consisting of corotron, scorotron, dicorotron, ~~bias member~~, and roller charger.*"

VII. Claim 1 of the second auxiliary request corresponds to that of the main request with the following addition:

"...comprising a plurality of individual substantially alike charging units (6) **either disposed linearly; or disposed as two or more rows of individual charging units each row comprising two or more individual charging units disposed linearly; the said charging units being** attached to a bracket (4)..."

VIII. Claim 1 of the third auxiliary request corresponds to that of the main request with the following addition:

"...comprising a plurality of individual substantially alike charging units (6) attached to a bracket (4), **wherein each charging unit (6) comprises a housing (1), an electrode (2), a voltage controller (3) and**

electrical interconnects (5), said bracket comprising...".

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

2.1 The respondent opponent argued that the specification in claim 1 that the charging units were "substantially alike" introduced subject-matter extending beyond the content of the application as filed (Articles 100(c), 123(2) EPC). Nowhere in the application as originally filed were the charging units disclosed as being substantially alike, let alone as being identical. Figures 1 and 2 showed a plurality of charging units from which, however, it could at the most be derived that the exterior housings were alike, but nothing concerning the internal build-up, such as the number of corona wires, grids etc...

In the board's view the qualifier "substantially alike" in claim 1 merely requires a general correspondence in a basic characteristic of the charging units. Such a general correspondence is given in the application, for instance in terms of the unit's external appearance or functional principle.

Hence, the subject-matter of claim 1 is not considered to extend beyond the content of the application as filed.

2.2 Novelty, inventive step

Document D1 discloses a charging device for use in a printing or imaging system such as an electrophotographic copying apparatus (figures 1, 3 and corresponding description). In the embodiment of figure 4c the charging device consists of a plurality of charging units, each being of the corona-discharge type with its own corona emitting electrode (66), grid (64) and shield (68).

The appellant proprietor argued that document D1 failed to show a plurality of substantially alike charging units. Figure 4c showed parts differing in the number of grid wires and the size of the shields.

In the board's judgment, however, since the charging units in the figure 4c embodiment of document D1 are all individual charging units of the same corona-discharge type and only slightly differ in respect of the number of wires making up the grid and, consequently, the size of the shield, they are to be considered "substantially alike" as per claim 1. Moreover, by virtue of these individual charging units, the overall charging device qualifies as a "modular" one.

Claim 1 further requires the charging units to be attached to a bracket, the bracket comprising means for attaching the bracket to a charging subsystem of the printing or imaging apparatus, and means for interconnecting electrical components of the plurality of individual charging units.

The respondent opponent argued that since in document D1 the charging units were held in position at some distance from the charge receiving element, a supporting bracket was necessarily present. Moreover, since the bracket was not further specified in the contested patent, it had to be construed broadly as nothing more than means for maintaining the charging units in position. Hence, the bracket was implicit in document D1.

In the board's opinion, however, a number of mounting constructions for the charging units in document D1 are conceivable, such as a direct attachment (by bolting, welding etc..) to the charging subsystem without an intervening bracket, so that the provision of a bracket cannot be held to be implicit in document D1. Neither is the provision of means on the bracket for interconnecting electrical components directly and unambiguously derivable from document D1.

Hence the subject-matter of claim 1 is new over D1.

In the board's judgement, however, the use of brackets is notorious for mounting purposes. Accordingly, the use of a bracket for attaching the charging units of figure 4c of document D1 would be obvious to the skilled person, as would be the provision on the bracket of means for interconnecting electrical components, locally connecting electrical components being common in the assembly of complex apparatuses such as the photocopiers at issue.

In view of the above, the subject-matter of claim 1 of the main request is not to be considered as involving an inventive step in the sense of Article 56 EPC.

3. *First auxiliary request*

The amendments according to the first auxiliary request only concern dependent claim 2 and involve the specification that the charging unit is a corona discharge device and the deletion of "bias member" from the list of instances of a charging unit.

The appellant proprietor justified the amendment by arguing that the opposition division erred in not giving the term "charging unit" in claim 1 a narrow interpretation using the description so as to distinguish it from the (biasing) grids shown in documents D1 and D2. The correct approach the opposition division should have adopted was to consider the directions given in Article 69 EPC and the corresponding protocol making clear that the description and the drawings should be used to interpret the claims.

The respondent opponent argued that the amendment was not occasioned by grounds for opposition and, therefore, failed to comply with Rule 57a EPC.

This latter argument conflates the issues of permissibility of a claim amendment and allowability of that claim (or any claim whose interpretation it may affect). On its proper interpretation the phrase *occasioned by* in Rule 57a EPC means constituting a plausible attempt, even if ultimately unsuccessful, to

address a ground for opposition - here lack of novelty in particular over document D8. This amendment meets that criterion and is therefore permissible.

In the decision under appeal the opposition division did not err when it applied a standard canon of construction in recognising the repercussive broadening effect on the interpretation of the term *charging unit* in claim 1 of the presence of the term "biasing member" in the list of instances of a *charging unit* in dependent claim 2. This canon does not however have a converse so that there is no repercussive limiting effect on claim 1 resulting from the deletion of the instance "biasing member" in claim 2.

At any rate, the board agrees with the respondent opponent that the amendment to the dependent claim 2 does in no way alter the finding of lack of inventive step of the subject-matter of claim 1 of the main request over document D1.

On the issue of claim interpretation, the board does not share the appellant proprietor's view that for the purposes of assessing novelty in opposition proceedings, claims should be interpreted in accordance with Article 69(1) EPC and the Protocol on its interpretation.

Article 69(1) EPC and the Protocol on its interpretation relate to the *extent of protection* conferred by the patent or patent application, primarily of concern in infringement proceedings.

They serve to **determine** a *fair* protection - *inter alia* by reference to the description and drawings - in the context of an actual alleged infringer in circumstances where the claim wording is set in stone

In accordance with Article 69(1) EPC and the Protocol on its interpretation, this fair protection is a balance struck between a strict literal definitional approach to the claims - legally certain but potentially unfair to the proprietor, because of the inherent problems of claim drafting without a crystal ball - and a loose guidelines approach - potentially unfair, because of its uncertainty, to the alleged infringer.

By contrast, in examination and opposition proceedings the value of future **legal certainty** is paramount. In this forum the function of the claims is to **define** the matter for which protection is sought (Article 84 EPC, first sentence - which also applies to opposition). There is no case for anything other than a strict definitional approach given that in this procedural stage the claim may and should be amended to ensure legally certain patentability, in particular novelty and inventive step over any known prior art.

Amendment rather than protracted argument should be the answer to genuine difficulties of interpretation in all aspects of the examination and opposition procedure, it being acknowledged that amendments to a patent as granted shall be occasioned by grounds for opposition.

There is, however, no conflict between the above view of the board and the appellant proprietor's contention

that (in those contracting states where revocation and infringement proceedings are consolidated) the scope of the claims as assessed for validity in revocation proceedings and for extent of protection in infringement proceedings must be identical.

Hence claim 1 of the first auxiliary request lacks an inventive step for the same reason as claim 1 of the main request.

4. *Second auxiliary request*

With respect to claim 1 of the main request, claim 1 according to the second auxiliary request includes, as one alternative, the additional feature that the charging units are disposed linearly.

In document D1 (see figure 4c in conjunction with figure 3) the charging units are disposed linearly. The above additional feature, therefore, cannot support the presence of an inventive step.

Hence claim 1 of the second auxiliary request also lacks an inventive step.

5. *Third auxiliary request*

Claim 1 according to the third auxiliary request corresponds to that of the main request with the additional feature that each charging unit comprises a housing, an electrode, a voltage controller and electrical interconnects.

In document D1 each corona charging unit (see figures 3, 4c) comprises a shield housing (68), a corona emitting electrode (66), a voltage controller (ie grid 64 (see figure 4c) and voltage controller 46 (see figure 3)) and electrical interconnects (see eg interconnects to the AC power supply 36).

The above additional feature is thus known from document D1 and, therefore, cannot support the presence of an inventive step either.

It follows that the subject-matter of claim 1 of the third auxiliary request also lacks an inventive step.

Order

For these reasons it is decided that:

The appeal is dismissed.

Registrar

Chair

S. Sánchez Chiquero

R. G. O'Connell