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**Datasheet for the decision
of 18 June 2009**

Case Number: T 1007/05 - 3.5.04

Application Number: 99124155.5

Publication Number: 0989732

IPC: H04N 1/00

Language of the proceedings: EN

Title of invention:
Electronic mail system

Patentee:
Panasonic Corporation

Opponent:
Canon Inc.

Headword:
-

Relevant legal provisions:
RPBA Art. 13(1)

Relevant legal provisions (EPC 1973):
EPC Art. 56, 84, 111(1)

Keyword:
"Inventive step (no)"
"Claims - clarity (no)"
"Decision re appeals - remittal (no)"

Decisions cited:
T 0085/93, T 1002/92, T 0624/04

Catchword:
Request for remittal not allowed after debate on relevant substantive issues (see point 6).



Case Number: T 1007/05 - 3.5.04

DECISION
of the Technical Board of Appeal 3.5.04
of 18 June 2009

Appellant: Canon Inc.
(Opponent) 30-2, Shimomaruko 3-chome
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Respondent: Panasonic Corporation
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 10 June 2005
rejecting the opposition filed against European
patent No. 0989732 pursuant to Article 102(2)
EPC 1973.

Composition of the Board:

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

Summary of Facts and Submissions

I. This is an appeal by the opponent against the decision by the opposition division rejecting the opposition against European patent 0989732, which derives from European patent application 99124155.5, a divisional application of European patent application 96105799.9.

II. The opposition was based on the grounds of opposition under Article 100(a) EPC 1973 (novelty and inventive step) as well as Article 100(b) and (c) EPC 1973.

III. The granted claims comprise independent claim 1 and dependent claims 2 to 10, claim 1 reading as follows:

"A electronic mail apparatus connected to a network which sends image data of a paper document to an addressed destination comprising: a scanner (6) for scanning a paper document and converting the paper document into corresponding image data; compression means (8) for compressing the image data; first data converting means (5) for converting the compressed image data into an electronic-mail format; electronic-mail transmitting means (9) for transmitting the compressed image data converted into the electronic-mail format to a destination address via the network; electronic-mail receiving means (9) for receiving image data in an electronic-mail format from a sender via the network; second data converting means (10) for converting the received image data into image data of a facsimile format; expansion means (8A) for expanding compressed image data of the facsimile format and printing means (11) for printing the image data of the facsimile format, further comprising means (9X) for

analyzing a character sequence in a given position of character code data in a received electronic mail, and means for implementing a process in response to a result of said analyzing."

IV. The reasons for the appealed decision stated *inter alia* in paragraph 36 that the opponents acknowledged that D16 (EP 0 679 012 A) did not disclose communication of facsimile files in an electronic mail format between the terminal and the facsimile apparatus. They conceded that all transport of files and control data took place at LAN level using LAN drivers and protocols. In paragraphs 25 and 26 it was stated that the opposition division did not share the opponent's view that there was no technical synergy between the transmission side of the claimed apparatus and the reception side. According to the opposition division, the claims could not be interpreted in complete isolation from the description. Although the claimed apparatus might not be "integrated", that did not mean that there was no implicit synergy. The transmission side was arranged to convert compressed image data into electronic mail format, while the reception side was arranged to receive electronic mail containing compressed image data in electronic mail format and to convert this into facsimile format data. The implied synergy between the elements of the claimed apparatus resided in its conception as a transceiver capable *inter alia* of communicating with another apparatus of similar specification regardless of the configuration of its architecture.

V. In a statement of grounds of appeal the appellant requested that the patent be revoked in its entirety.

The appellant also filed copies of *inter alia* the following documents:

D19: "Computer Networks", A.S. Tanenbaum, third edition, 1996, pages 7 to 44 and 643 to 663, and

D20: RFC 1314, "A File Format for the Exchange of Images in the Internet", A. Katz and D. Cohen, April 1992, 23 pages.

The appellant subsequently provided a statement by the publisher of D19 that it had been published on 6 March 1996, which was before the filing date of 12 April 1996.

The appellant argued in the statement of grounds of appeal that during the opposition oral proceedings there appeared to be a misconception of the way in which data was transmitted over computer networks. Document D19 was being introduced to correct this misconception. Turning to D20, in the decision under appeal the opposed patent had been understood as relating to a transceiver type of device which could send and receive image data of a facsimile format in e-mails to and from a similar type of transceiver device. This new interpretation of the claims, raised by the opposition division for the first time during the oral proceedings, had prompted further searching which had led to D20, which was being filed to show that such a transceiver device was already well known. The appellant argued that the claimed subject-matter lacked inventive step in view of D20 combined with other documents. In particular the appellant argued that the subject-matter of claim 1 as granted differed from the disclosure of D20 in that D20 did not disclose means

for analyzing a character sequence in a given position of character code data in a received electronic mail, and means for implementing a process in response to a result of said analyzing. The appellant also provided arguments concerning objections under Article 100(b) and (c) EPC 1973.

- VI. In a letter dated 10 April 2006 the respondent (patentee) requested that the appeal be rejected as unsubstantiated and that the patent be maintained as granted. The respondent also requested that *inter alia* D19 and D20 not be admitted into the proceedings and provided arguments as to why the subject-matter of claim 1 as granted showed inventive step in the light of D20 combined with other documents. The respondent also provided arguments concerning objections under Article 100(b) and (c) EPC 1973.
- VII. In a letter dated 7 October 2008 the respondent informed the EPO of a change of name, requested that the EPO register the new name and filed a corresponding extract from the Japanese commercial register.
- VIII. In an annex to a summons to oral proceedings according to Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal of the EPO; see OJ EPO 2007, 536) the board gave its preliminary opinion on the appeal. In particular it stated that D19 appeared to have been filed in response to the findings of the opposition division and not to have been cited as evidence of specific pieces of prior art, but as providing relevant background technical information. It also seemed that D20 had been filed in response to paragraph 26 of the appealed decision concerning the construction of claim

1 as setting out a transceiver capable of communicating with another transceiver of the same specification. Furthermore aspects of D20 and other documents had been presented as evidence in support of facts which substantially related to generally known facsimile and electronic-mail formats and transport protocols. Hence it was likely that *inter alia* D19 and D20 would be admitted into the proceedings. The board also stated that, assuming D20 were admitted, the inventive step of the claimed subject-matter in the light of D20 combined with other documents might be discussed. The board also commented on the general background, at the filing date, of transmitting and receiving electronic mail containing a mixture of text, drawings, facsimile and voice. In particular the board noted that it appeared from the available documents that the MIME (Multipurpose Internet Mail Extensions) standard, which was used in several embodiments (see paragraphs [0047], [0057], [0084] and [0099] of the published patent), had proposed a solution to include images in an electronic mail (RFC 1341, 1992 and updated in RFC 1521, 1993). This standard specifically included a content type "Gif" or "Jpeg" as image formats.

- IX. With a letter dated 15 May 2009 the respondent filed amended claims according to ten auxiliary requests. In the letter the respondent requested that the patent be maintained as granted or in amended form according to the auxiliary requests. The respondent also argued that, following decision T 85/93 (OJ EPO 1998, 183), *inter alia* D19 and D20 should have been filed before the opposition division at an early stage in the proceedings as they provided technical background or alleged proof of common general knowledge. The

respondent, referring to decision T 1002/92 (OJ EPO 1995, 605), reiterated the request that *inter alia* D19 and D20 not be admitted into the appeal proceedings because late filed documents should only very exceptionally be admitted if the material was *prima facie* highly relevant, which was not the case for documents providing technical background.

- X. In a letter dated 15 May 2009 the appellant argued that the claimed subject-matter lacked inventive step in view of D20 and SMTP (Simple Mail Transfer Protocol). The subject-matter of claim 1 as granted only differed from the disclosure of D20 in means for analyzing a character sequence in a given position of character code data in a received electronic mail, and means for implementing a process in response to a result of said analyzing. These difference features however merely set out a basic response functionality integral to SMTP.

- XI. Oral proceedings were held from 16 to 18 June 2009, the common parties having agreed to jointly held oral proceedings concerning three patents granted on divisional applications from the same parent application. The respondent submitted amended claims according to a main request and auxiliary requests I and II, the appellant objecting to the admission of these requests into the proceedings as late filed.

- XII. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

- XIII. The respondent, at the beginning of the oral proceedings, confirmed the requests submitted with the letter dated 15 May 2009. In reaction to the debate the

respondent submitted several amendments to his requests. After filing a single new request intended to replace all previous requests, which was not admitted by the board, the respondent reverted to previous requests which had already been discussed. Thus the respondent's final requests were as follows:

main request: to maintain the patent on the basis of the main request comprising claims 1 to 10 filed in the oral proceedings;

first auxiliary request: to maintain the patent on the basis of auxiliary request I comprising claims 1 to 10 filed in the oral proceedings;

second auxiliary request: to maintain the patent on the basis of auxiliary request II comprising claims 1 to 8 filed in the oral proceedings and

third auxiliary request: to remit the case to the first instance, in particular because the representative had not had a sufficient opportunity to contact the patentee in view of the newly found relevance of the late filed documents.

XIV. The claims according to the main request comprise independent claim 1 and dependent claims 2 to 10, claim 1 reading as follows:

"An electronic mail apparatus connected to a network which sends image data of a paper document to an addressed destination comprising: a scanner (6) for scanning a paper document and converting the paper document into corresponding image data; compression

means (8) for compressing the image data into compression-resultant image data of a facsimile format; first data converting means (5) for converting the compression resultant image data of the facsimile format into character code data of an electronic mail format; means for receiving information of an electronic mail destination address; electronic-mail transmitting means (9) transmitting the compressed image data converted into character code data of the electronic-mail format to a destination address via the network; electronic mail receiving means (9) for receiving image data in an electronic mail format from a sender via the network; second data converting means (10) for converting the received image data into image data of a facsimile format expansion means (8A) for expanding compressed image data of the facsimile format into expansion resultant image data of the facsimile format; and printing means (11) for printing the expansion resultant image data of the facsimile format, further comprising means (9X) for analyzing a character sequence in a given position of character code data in a received electronic mail, and means for implementing a process in response to a result of said analyzing."

XV. The claims according to the first auxiliary request comprise independent claim 1 and dependent claims 2 to 10, claim 1 reading as follows:

"An electronic mail apparatus connected to a network which sends image data of a paper document to an addressed destination comprising: a scanner (6) for scanning a paper document and converting the paper document into corresponding image data; compression means (8) for compressing the image data into

compression-resultant image data of a facsimile format; first data converting means (5) for converting the compression resultant image data of the facsimile format into character code data of an electronic mail format **in conformity with Multipurpose Internet Mail Extensions**; means for receiving information of an electronic mail destination address; electronic-mail transmitting means (9) transmitting the compressed image data converted into character code data of the electronic-mail format to a destination address via the network; electronic mail receiving means (9) for receiving image data in an electronic mail format from a sender via the network; second data converting means (10) for converting the received image data into image data of a facsimile format expansion means (BA) for expanding compressed image data of the facsimile format into expansion resultant image data of the facsimile format; and printing means (11) for printing the expansion resultant image data of the facsimile format, further comprising means (9X) for analyzing a character sequence in a given position of character code data in a received electronic mail, and means for implementing a process in response to a result of said analyzing." (Emphasis added by the board).

XVI. The claims according to the second auxiliary request comprise independent claim 1 and dependent claims 2 to 8, claim 1 reading as follows:

"An electronic mail apparatus connected to a network which sends image data of a paper document to an addressed destination comprising: a scanner (6) for scanning a paper document and converting the paper document into corresponding image data; compression

means (8) for compressing the image data into compression-resultant image data of a facsimile format; first data converting means (5) for converting the compression resultant image data of the facsimile format into character code data of an electronic mail format; means for receiving information of an electronic mail destination address; electronic-mail transmitting means (9) transmitting the compressed image data converted into character code data of the electronic-mail format to a destination address via the network; electronic mail receiving means (9) for receiving image data in the electronic mail format from a sender via the network; second data converting means (10) for converting the received image data into image data of a facsimile format expansion means (8A) for expanding compressed image data of the facsimile format into expansion resultant image data of the facsimile format; and printing means (11) for printing the expansion resultant image data of the facsimile format, further comprising means (9X) for analyzing a character sequence in a given position of character code data in the received electronic mail, means for implementing a process for deciding whether or not a requirement for facsimile transmission is present in response to a result of said analyzing, a facsimile modem (18) for transmitting the received image data of the facsimile format by facsimile, **wherein the printing means (11) is adapted** to print the expansion-resultant image data of the facsimile format, when the means for implementing the process for deciding whether or not there is a requirement for facsimile transmission has decided that there is no requirement for facsimile transmission, and **wherein the facsimile modem (18) is adapted** to transmit the received image data of facsimile format, when the

means for implementing the process for deciding whether or not there is a requirement for facsimile transmission has decided that there is a requirement for facsimile transmission." (Emphasis added by the board).

XVII. The appellant's arguments in the oral proceedings concerning the respondent's final requests may be summarized as follows. The respondent had filed ten auxiliary requests with the letter dated 15 May 2009. It was too late to file further auxiliary requests in the oral proceedings. The appellant also argued that allowing the respondent to reintroduce the main and first auxiliary requests after having previously withdrawn them was overly generous to the respondent.

Since MIME was mentioned in claim 1 according to the first auxiliary request, background documents relating to the MIME standard should be admitted into the proceedings. It would be unjust if the respondent could rely on MIME, but not the appellant.

As to the main request, D20 disclosed on page 4, last three lines, the scanning and printing of images. D20 also mentioned SMTP being used to move image files between hosts, implying sending and receiving; see page 2, lines 21 to 24, and the penultimate paragraph. The compression of image data into a facsimile format was also known from D20 which mentioned the TIFF image format, it being possible to use MH or MR encoding (the data encoding of CCITT Group 3 fax) or MMR encoding (the data encoding of CCITT Group 4 fax) within the TIFF framework; see the paragraph bridging pages 2 and 3. D20 thus disclosed all features of granted claim 1

apart from the means for analyzing a character sequence in a given position of character code data in a received electronic mail and means for implementing a process in response to a result of said analyzing. These steps had no technical relationship with the remaining features of the claim and concerned steps to be taken when receiving any e-mail. It was common general knowledge at the priority date that e-mails according to the MIME standard contained ASCII, a character code; see D19, page 653, fifth to fourth line from the bottom. Embodiments 14 and 20 of the invention disclosed analyzing a character sequence in the subject part of a received electronic mail. It was usual in the handling of e-mails to analyze character codes in the header fields for instance to deliver them to appropriate mailboxes. If a message could not be delivered, an error report was returned to the sender. This was inherent in SMTP. The skilled person implementing the standard set out in D20 would do so in the light of common general knowledge, for instance D19.

As to the first auxiliary request, the expression (highlighted in point XV above) inserted into claim 1 "in conformity with Multipurpose Internet Mail Extensions" made the claim unclear, Article 84 EPC 1973, since it was unclear which part of MIME was intended and what this meant for the definition of the claimed subject-matter, given that standards may change with time. Moreover, whilst the transmitting part of the apparatus had been restricted by the reference to MIME, there was no corresponding amendment of the receiving part of the apparatus.

As to the second auxiliary request, claim 1 had been substantially amended to remove any mention of controller means which, in a previously discussed version of claim 1, had controlled the facsimile transmitter and the printing means. It was now too late to admit this request and begin a debate on new issues.

XVIII. The respondent's arguments in the oral proceedings concerning his final requests may be summarized as follows. The main and first and second auxiliary requests concerned amendments aimed at overcoming objections raised by the appellant in the letter dated 15 May 2009 and in the oral proceedings. Admission of additional prior art documents, for instance D19 and D20, into the proceedings should only occur in exceptional cases in opposition appeal proceedings, since the boards of appeal were the final instance available to the patentee, if he lost, whilst the opponent, if he lost, could always resort to the national patent courts.

As to the main request, claim 1 was based on the first, fourth and ninth embodiments of the invention. D20 was merely a memo setting out unconnected ideas; it did not teach the building of a complete apparatus. D20 did not disclose in combination a scanner, converting image data into facsimile format, converting image data of the facsimile format into an electronic mail format, an electronic mail destination address, any form of receiving operation or a printer. Furthermore the combination of D20 with D19 resulted from an *ex post facto* analysis.

Regarding the first auxiliary request, the reference to MIME added in claim 1 merely excluded SMTP. The reference to MIME did not make the claim unclear because the standard had to be interpreted as it was defined at the filing date of the opposed patent.

Regarding the second auxiliary request, this was based on the fourteenth embodiment of the invention, the amendments removing previous inconsistencies. Although the controller had been removed, the functions it performed remained.

XIX. In the oral proceedings towards the end of the debate on the case the board gave its provisional opinion that none of the respondent's requests was both admissible and allowable.

XX. In response to the provisional opinion the respondent raised an objection in respect of a procedural defect under Rule 106 EPC, a written statement of the objection being attached to the minutes of the oral proceedings. The respondent's objection was essentially that his right to be heard on inventive step in view of the combination of documents D19 and D20 had not been respected. These documents had not been the subject of first instance proceedings. Moreover, up until the appellant's letter dated 15 May 2009, D19 and D20 had only ever been regarded as background art in the appeal proceedings. Given the high relevance of D19 and D20 to inventive step, the board should have remitted the case to the first instance.

XXI. The appellant had no comments on the respondent's objection.

XXII. After deliberation the board dismissed the objection.

XXIII. At the end of the oral proceedings, after having heard the parties regarding the other two patents granted on divisional applications from the same parent application, the board announced its decision.

Reasons for the Decision

1. *Admissibility of the appeal*

The appeal is admissible.

2. *The admissibility of the respondent's main and first and second auxiliary requests*

The appellant objected to the admission into the proceedings of these requests, when they were filed initially in the oral proceedings, as late filed. When the respondent sought to reintroduce the main and first auxiliary requests after having previously withdrawn them the appellant argued that allowing re-introduction would be overly generous to the respondent.

Under Article 13(1) RPBA any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. The discretion shall be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. Under Article 13(3) RPBA, amendments sought to be made after oral proceedings

have been arranged shall not be admitted if they raise issues which the board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

As for the initial filing of the main and first auxiliary requests in the oral proceedings the board notes that they were filed in response to objections at least some of which were newly raised at the beginning of the oral proceedings by the appellant and the board against the amended claims filed by the proprietor with the letter dated 15 May 2009. Equal treatment of the parties and fairness require that the other party be given an opportunity to react to new objections which, in the present case, could hardly have been made earlier than in the oral proceedings. Moreover these requests concerned amendments which caused the proceedings to converge, the amendments not giving rise to any new objections. In the board's opinion such amendments had to be expected as a reaction to the new objections and did not unnecessarily increase the complexity of the subject-matter under consideration.

As for the desired reintroduction of the main and first auxiliary requests that had previously been withdrawn, in the particular circumstances of this case, in which the board indicated that it was not inclined to admit the latest sole main request (which subsequently became the second auxiliary request, see below), the board regarded it as reasonable that the respondent be allowed to reintroduce the previously discussed main and first auxiliary requests as this further amendment of the respondent's case was procedurally economical in not prolonging the oral proceedings.

Based on the above criteria the board exercised its discretion under Article 13(1) RPBA in admitting and later reintroducing the main and first auxiliary requests into the proceedings.

The board however decided not to admit the second auxiliary request into the proceedings, since this amendment was only made after having admitted and extensively discussed several previous requests and modifications. Moreover the amendments in claim 1 involved the deletion of the controller which raised new issues concerning whether the adaption of the printing means and facsimile modem set out in the claim (see the highlighted passages in point XVI above) to carry out functions previously carried out by the controller had added subject-matter, contrary to Article 123(2) EPC. In other words, the amendments would have caused the proceedings to diverge, opening a debate on the new issues and further increasing the complexity of the oral proceedings, contrary to the principle of procedural economy. On this basis the board exercised its discretion under Article 13(1) RPBA in not admitting the second auxiliary request into the proceedings.

3. *The admissibility of documents D19 and D20*

Under Article 12(1)(a) RPBA appeal proceedings shall be based on *inter alia* the statement of grounds of appeal. Following Article 12(2) RPBA, the statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under

appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on. Moreover, according to Article 12(4) RPBA, without prejudice to the power of the board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under (1) shall be taken into account by the board if and to the extent it relates to the case under appeal and meets the requirements in (2). Essentially these measures were introduced with Article 10a and Article 10b of a previous version of the RPBA (see OJ EPO 2003, 61) and were aimed at achieving the goal of more efficient and shorter appeal proceedings and included a more defined and controlled initial phase of proceedings (see point I.A.3 of document CA/133/02 dated 12 November 2002, cited in decision T 0624/04 (reasons, point 1.9), not published in OJ EPO).

In the present case D19 and D20 were both filed with the statement of grounds of appeal, relate to the case under appeal and meet the requirements of Article 12(2) RPBA. For the reasons given below the board also considers that, in the present case, this board does not deviate from the essential considerations underlying decisions T 85/93 and T 1002/92 (*supra*). Consequently the board admits both documents into the proceedings, Article 12(4) RPBA.

4. *The allowability of the respondent's main request*

4.1 *General technical background (Document D19)*

The reference work D19 gives an overview of electronic mail systems at the priority date. In view of the sufficiently detailed information given in D19 the board finds it unnecessary to introduce further evidence cited by the appellant, such as the standard RFC 1521. E-mail systems using the message format defined in RFC 822 over the internet were widespread at the priority date; see D19, section 7.4 "Electronic mail". Such systems typically consisted of two subsystems: the user agents, which allowed people to read and send e-mail, and the message transfer agents, which moved the messages from the source to the destination; see page 645, first paragraph. According to page 646, lines 17 to 23, a key idea in such e-mail systems was the distinction between the envelope and its contents. The envelope encapsulated the message. It contained all the information needed for transporting the message, such as the destination address, priority and security level, all of which were distinct from the message itself. The message transport agents used the envelope for routing. The message inside the envelope contained two parts: the header and the body. The header contained control information for the user agents, whilst the body was entirely for the human recipient. According to figure 7-42 on page 651, the header contained fields relating to message transport such as "To:", which gave the e-mail address of the primary recipient, and also contained fields used by the user agents or human recipients such as "Subject:", which gave a short summary of the message for a one-

line display. The header fields each consisted of a single line of ASCII text containing the field name, a colon and, for most fields, a value.

Such e-mails complying with RFC 821 (transmission protocol) and RFC 822 (message format) in the early days of the internet had consisted exclusively of text messages written in English and expressed in the character code ASCII. To extend the e-mail system to deal with other alphabets, languages and non-textual messages such as audio and video "Multipurpose Internet Mail Extensions" (MIME) were proposed and later set out in RFC 1521; see page 653, "MIME". MIME continued to use the RFC 822 format, but added five new message headers to add structure to the message body and define encoding rules for non-ASCII messages. One of the new message headers was the "content type" field, figure 7-45 giving the initial list of types and subtypes (fifteen in total) specified in RFC 1521, examples of types/subtypes being "Text/Plain" and "Image/Jpeg". Additional types and subtypes were added later.

E-mail was delivered over the internet by having the source machine establish a TCP connection to port 25 of the destination machine; see page 658 "SMTP". Listening to this port was a program called an e-mail daemon using the Simple Mail Transfer Protocol (SMTP), defined in RFC 821, which accepted incoming connections and copied messages from them into the appropriate mailboxes. If a message could not be delivered, for instance because the recipient mailbox was not registered at that location (see D19, pages 647, lines 2 to 3, and 658, lines 13 to 8 from the bottom), an error report was returned to the sender. SMTP

defines the conversation between the source and destination machines involved in sending an e-mail message.

The opposed patent in certain embodiments refers to these mechanisms, in particular that of the MIME standard, for sending and receiving compressed images employing a content type "image/tiff" (see paragraphs [0047], [0057], [0084] and [0099]). No further details are disclosed about how MIME is used or which parts of MIME are particularly relevant for embodying the invention.

4.2 *Document D20*

D20 proposes a standard for a file format for the exchange of fax-like black and white images over the internet; see abstract. The images may originate from scanners and may be printed by laser printers; see page 2, first paragraph and page 4, last three lines. The file format is TIFF (Tagged Image File Format) which allows image data to be encoded using MMR (Modified Modified READ) (the data encoding of CCITT Group 4 fax) or MH (Modified Huffman) or MR (Modified READ) (the data encodings of CCITT Group 3 fax); see the paragraph bridging pages 2 and 3 and page 6, second and third paragraphs. The TIFF files can be communicated by SMTP to transfer them from one host to another.

The respondent has essentially questioned whether D20 is a sufficient disclosure by arguing that it is merely a memo setting out unconnected ideas. The board does not agree. D20 proposes a standard which, in the

telecommunications network field to which it belongs, would be sufficient for the skilled person to realize an apparatus to implement it.

Since however D20 does not provide a self-contained disclosure of an apparatus, the subject-matter of claim 1 is novel, Article 54(1,2) EPC 1973.

4.3 *Inventive step*

Although there is no direct and unambiguous disclosure of an apparatus comprising all the individual features referred to in the following in combination, the reference to the facsimile, printing and electronic mail functions are such that they need no further discussion in the context of deciding on inventive step. For example, even though it would be possible to conceive an apparatus where the data are not scanned (but supplied in electronic form) or not printed (but only displayed), the usual and thus straightforward choice of the person skilled in the art would have been the scanning and printing of documents. Equally, although D20 mentions the possibility of transferring files between hosts using FTP (see page 2, lines 21 to 24), the same passage also mentions SMTP, the board regarding SMTP at the filing date (in 1996) as the more usual choice for the skilled person for the reasons given in D19, page 644, lines 1 to 20. Moreover, although D20 could be understood as disclosing unidirectional transmission of images from transmitters to receivers, a more usual choice would be a full implementation of the standard by realizing transceivers capable of both transmitting and receiving images and thus bidirectional transmission of images

between transceivers, as hinted at by the references in D20 (see, for instance, the title) to the "exchange" of images. The board sees no synergistic link between any of these usual choices.

Hence the following subject-matter results from the skilled person making usual choices when implementing a system according to D20: an electronic mail apparatus connected to a network (see references to SMTP, for instance on page 2, lines 21 to 24) which sends image data of a paper document to an addressed destination comprising: a scanner (see page 2, line 8) for scanning a paper document and converting the paper document into corresponding image data; compression means (see compression methods MMR, MR and MH in the paragraph bridging pages 2 to 3) for compressing the image data into compression-resultant image data of a facsimile format; first data converting means for converting the compression resultant image data of the facsimile format into character code data of an electronic mail format (implicit in sending an image file by SMTP, ASCII character code data being implicit in an electronic mail format); means for receiving information of an electronic mail destination address (implicit to identify the destination); electronic-mail transmitting means transmitting the compressed image data converted into character code data of the electronic-mail format to a destination address via the network (implicit in SMTP); electronic mail receiving means for receiving image data in an electronic mail format from a sender via the network (again, implicit in SMTP); second data converting means for converting the received image data into image data of a facsimile format (again, implicit in sending an image file by

SMTP, ASCII character code data being implicit in an electronic mail format), expansion means for expanding compressed image data of the facsimile format into expansion resultant image data of the facsimile format (see compression methods MMR, MR and MH in the paragraph bridging pages 2 to 3); and printing means (see page 2, line 10) for printing the expansion resultant image data of the facsimile format.

The skilled person would have been aware that, as set out in D19 (see point 4.1 above), the electronic mail receiving means would, as an implicit feature of SMTP, have to be capable of recognising whether an incoming e-mail is deliverable and sending back an error report if it is not. To do this it would have been usual for the skilled person to provide means for analyzing the "To:" header field of incoming e-mails, this constituting analyzing a character sequence in a given position of character code data in a received electronic mail. As a result of this analysis, the electronic mail apparatus would have sent an error report back to the sender if the e-mail was not deliverable, thus implementing a process in response to a result of said analyzing. The board notes that the published patent description refers to the analysis of different header fields of incoming e-mails, such as the "Subject" part and the "From" part; see, for instance, paragraphs [0157] and [0194].

Starting from D20 and interpreting it in the light of common general knowledge, as reflected by D19, the skilled person would, by making usual design choices, have consequently arrived at the subject-matter of claim 1 without inventive step. The subject-matter of

claim 1 thus lacks inventive step, Article 56 EPC 1973, in view of D20 understood in the light of D19.

5. *The allowability of the respondent's first auxiliary request*

It is not clear, Article 84 EPC, which extensions, in other words content types and subtypes, are defined by the expression in claim 1 (highlighted in point XV above) "in conformity with Multipurpose Internet Mail Extensions", RFC 1521 (see D19, page 655, figure 7-45) defining fifteen types and subtypes but not referring to "image/tiff", mentioned in the description of the opposed patent (see paragraph [0057]). The board is also not convinced that the expression "an electronic mail format in conformity with Multipurpose Internet Mail Extensions" is sufficient to clearly define the matter for which protection is sought. This expression does not make clear which features of the standard are essential for the claimed invention, as argued by the appellant, and what exactly the meaning of these features is, since standards may change with time, as this particular case clearly shows; RFC 1341 was updated in RFC 1521, and new subtypes were added; see D19, page 653 and page 655, lines 1 and 2. Moreover, whilst the transmitting part of the apparatus has been restricted by the reference to MIME, there is no corresponding amendment of the receiving part of the apparatus, leading to doubt as to whether such a restriction is intended or not, Article 84 EPC 1973. As a consequence, claim 1 of the first auxiliary request does not comply with Article 84 EPC 1973.

6. *The respondent's third auxiliary request (remittal)*

6.1 Since the board first has to decide on the respondent's higher ranking requests, the question arises as to the basis upon which the case should be remitted to the first instance, as the first instance would be bound by the *ratio decidendi* of the board, Article 111(2) EPC 1973. Since the respondent cannot reasonably have meant remittal after a decision on the higher ranking requests, the board interprets the third auxiliary request as actually meaning that the case should be remitted to the first instance in order to decide on the higher ranking requests.

6.2 According to Article 111(1) EPC 1973, second sentence, the board of appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. The board consequently has a discretion as to whether to remit the case to the first instance or not. The relevant jurisprudence of the boards of appeal reflects this discretion, which is exercised according to the circumstances of the individual case. The board sees no legal basis for an absolute right to have an issue decided upon by two instances (see Case Law of the Boards of Appeal, Fifth Edition, 2006, section VII.D.9.).

6.3 In the present case the board had announced in the annex to the summons to oral proceedings the intention to introduce, *inter alia*, D19 and D20 into the proceedings. In the oral proceedings the board decided to introduce D19 and D20 after having heard the parties

on this issue. The parties then presented their submissions on novelty and inventive step relating to the initial requests and several amendments made by the respondent. Following the debate and a deliberation by the board, the board gave its provisional opinion and asked the parties to state their final requests before the chairman closed the debate. Only then did the respondent request remittal of the case as a third auxiliary request. Both the parties and the board had thus already concentrated the debate on the higher ranking requests with a view to deciding on them. Under these circumstances it would only be reasonable to remit a case which had been extensively discussed if exceptional circumstances justified this action, for instance if the introduction of documents into the proceedings had created an entirely new situation.

6.4 The board sees no such exceptional circumstances in the present case. The debate on appeal mainly concentrated on the evaluation of the common general knowledge concerning transmitting and receiving compressed image data in electronic mail. D19 was particularly relevant as a reference work giving detailed evidence in this respect, in particular concerning SMTP and MIME. These mechanisms are explicitly or implicitly referred to in the opposed patent without being explained in detail. The board considers that this common general knowledge is necessary both for carrying out the invention as well as for judging the inventive contribution over these standards. D20 is a proposal for a standard for exchanging fax-like images in an electronic mail format.

6.5 Before the first instance the main subject considered was the communication of facsimile files over LANs

(Local Area Networks), as distinguished from the transmission in an electronic mail format (such as over the internet). The introduction of D19 and D20 with the statement of grounds of appeal made clear that the technical transmission mechanisms for compressed images in an electronic mail format were commonly known (as evidenced by D19) and that transmitting and receiving compressed facsimile images in an electronic mail format had also been proposed as a standard (D20). The board thus considers that the introduction of D19 and D20 has not created an entirely new situation which could have justified a remittal to the first instance. Moreover, although D19 and D20 partly related to common general knowledge, the patent claims were formulated such that D19 and D20 were also highly relevant in the sense that their consideration could reasonably be expected to change the final result. Also in decisions T 85/93 and T 1002/92 the boards exercised their power of discretion and, in the former case, the board introduced a late filed document representing evidence of common general knowledge (see point 1.2 of T 85/93).

- 6.6 On this point the respondent has argued that, up until the appellant's letter dated 15 May 2009, which reached the respondent via the EPO around three weeks before the oral proceedings, D20 had only been regarded as background information. The combination of D20 and D19 had only been relied upon by the appellant in the same letter, and the respondent's representative had not been able to contact his client in time for the oral proceedings to discuss this new combination of documents. The appellant has argued that, to save time, the appellant's letter dated 15 May 2009 was sent directly to the respondent's representative.

6.7 In general the board sees no reason for a party to assume that a document filed as "background information" will not be relevant to the question of inventive step. It was moreover already clear in the statement of grounds of appeal (see paragraphs 14 to 17) that D20 was seen by the appellant as relevant to inventive step. Indeed D20 was used as a starting document in these paragraphs to argue lack of inventive step, albeit in combination with documents other than D19. Under these circumstances the board is not convinced that the arguments based on D20 in the light of common general knowledge at the priority date, as evinced by D19, in the appellant's letter of 15 May 2009 put the respondent's representative in a completely unexpected situation. Moreover it would seem unfair to the appellant to expect him to react to the ten new sets of amended claims filed with the respondent's letter of 15 May 2009, whilst regarding the same period of time as too short for the respondent to react to the combination of documents D20 and D19. As the case is now thirteen years old, the filing date lying in 1996, and the board has already considered D19 and D20 in connection with the main request, the board is not convinced that it would be reasonable to remit the case to the first instance to give the respondent the benefit of two instances regarding D19 and D20. Consequently the board has not allowed the respondent's third auxiliary request.

6.8 The respondent has argued (see point XX above) that in particular in not allowing the respondent's third auxiliary request the board has committed a fundamental violation of Article 113 EPC concerning the

respondent's right to be heard. The board dismissed the objection in the light of the reasons set out above, under points 6.1 - 6.7, and in particular because the combination of D20 and D19 was not unexpected and the appellant had had sufficient time to prepare himself to comment on this point in the period of around three weeks before the oral proceedings.

7. *Conclusion*

Since neither of the respondent's main and first auxiliary requests is allowable, the respondent's second auxiliary request is not admissible and the third auxiliary request for remittal is not allowed, the patent must be revoked, Article 101(3)(b) EPC. The appellant's requests are thus allowed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

L. Fernández Gómez

F. Edlinger