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

Case Number: T 1009/05 - 3.5.04

Application Number: 99124156.3

Publication Number: 0989733

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. 84, 111(1)

Keyword:
"Admissibility of new requests (yes)"
"Claims - clarity (no)"

Decisions cited:
-

Catchword:
Request for remittal after debate on relevant issues (not allowed, see point 4).



Case Number: T 1009/05 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 18 June 2009

Appellant: Canon Inc.
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Respondent: Panasonic Corporation
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Representative: Grünecker, Kinkeldey
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
10 June 2005 concerning maintenance of European
patent No. 0989733 in amended form.

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 interlocutory decision of the opposition division that European patent 0989733, which derives from European patent application 99124156.3, a divisional application of European patent application 96105799.9, and the invention to which it related met the requirements of the EPC.
- II. The opposition was based on the grounds of opposition under Article 100(a), (b) and (c) EPC 1973.
- III. The interlocutory decision was based on claim 1 filed with the letter dated 18 March 2005 and claims 2 to 11, the description and the figures as granted. Claim 1 filed with the letter dated 18 March 2005 reads 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 (9) for detecting a transmission failure by determining that the received electronic mail is transmitted by said electronic mail apparatus, and means (10) for printing information representative of the transmission failure."

- IV. Regarding the amendment made in opposition proceedings (namely the last feature of claim 1 starting with "further comprising means (9) for detecting a transmission failure ..."), the opposition division considered that "the amendment not only overcame the opponents' objection that its earlier absence had represented added matter but it also served to clarify to some small extent the intended scope of the claim." The proprietor had cited the following parts of the application as filed as providing support for the amendment: claim 20, page 33, lines 5 to 20, of the description and figure 33. The opposition division agreed that these passages formed fair support (see points 56 and 57 of the decision under appeal).
- V. A notice of appeal was received from the opponent.
- VI. In a subsequently filed statement of grounds of appeal the appellant (opponent) requested that the patent be revoked in its entirety and provided arguments concerning objections under Article 100(a), (b) and (c) EPC 1973.

- VII. In a letter dated 30 March 2006 the respondent (patentee) requested that the appeal be rejected as unsubstantiated and that the patent be maintained in amended form as upheld in the appealed decision. The respondent also provided arguments concerning objections under Article 100(a), (b) and (c) EPC 1973.
- VIII. 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.
- IX. 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.
- X. With a letter dated 15 May 2009 the respondent filed amended claims according to seven auxiliary requests. In the letter the respondent requested that the patent be maintained as granted or in amended form according to the auxiliary requests.
- XI. In a letter dated 15 May 2009 the appellant provided arguments concerning objections under Article 100(a) and (c) EPC 1973. The appellant also argued essentially that claims which set out the detection of transmission errors by checking whether the sender address of received e-mails was the same as that of the apparatus itself were unclear, Article 84 EPC 1973, since cases where no transmission error had occurred, for instance copying an e-mail to oneself, also fulfilled this criterion. As the claim as granted covered solely

- transmission failures, the amended claim maintained by the opposition division contravened Article 123(3) EPC.
- XII. 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.
- XIII. The respondent, at the beginning of the oral proceedings, requested maintenance of the patent on the basis of a new main request and a new auxiliary request I. In reaction to the debate the respondent later filed a new main request and a new auxiliary request I. The appellant objected to their admission into the proceedings as late filed.
- XIV. The appellant's final request was that the decision under appeal be set aside and that the European patent be completely revoked.
- XV. The respondent's final requests were as follows.

Main request: that the patent be maintained on the basis of the claims of the last main request submitted during the oral proceedings.

First auxiliary request: that the patent be maintained on the basis of the claims of the last auxiliary request I submitted during the oral proceedings.

Second auxiliary request: remittal of the case to the first instance.

XVI. The claims according to the main request 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 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) for transmitting the compressed image data converted into character code data of the electronic-mail format to the 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; printing means (11) for printing the expansion resultant image data of the facsimile format, further comprising means (1) for detecting that transmission of a **received electronic mail** fails by determining that the sender address of the **received electronic mail** agrees with a given address assigned [*sic*] to said electronic mail apparatus, and said printing means (11) is printing information representative of a

transmission failure, in cases where transmission of the received electronic mail fails." (Emphasis added by the board).

XVII. The claims according to the first auxiliary request comprise independent claim 1 and dependent claims 2 to 9, 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 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) for transmitting the compressed image data converted into character code data of the electronic-mail format to the 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; printing means (11) for printing the expansion resultant image data of the facsimile format, further comprising means (1) for detecting that transmission of a **received electronic mail** fails by determining that

the sender address of the **received electronic mail** agrees with a given address assigned [*sic*] to said electronic mail apparatus, and said printing means (11) is printing information representative of a transmission failure, in cases where transmission of the received electronic mail fails; wherein said means for receiving information of an electronic mail destination address, said scanner (6), said compression means (8), said expansion means (8A), said first and second data converting means (5, 10), said electronic mail transmitting and receiving means (9), a facsimile modem (18) and said printing means (11) are electrically interconnected via an internal bus structure." (Emphasis added by the board).

XVIII. The appellant's arguments in the oral proceedings concerning the respondent's final requests may be summarized as follows. The amendments according to the main and first auxiliary requests were late filed because they related to issues that the respondent had known about ever since the first instance proceedings. The amendments also changed the meaning of the expression in claim 1 "received electronic mail" from that according to granted claim 1. Claim 1 upon which the interlocutory decision was based did not comply with Article 123(3) EPC because it covered cases where no transmission error had occurred. Hence admitting the main and first auxiliary requests would be contrary to the principle of a prohibition of *reformatio in peius*, this principle requiring the respondent to defend the patent in the form in which it was maintained. If the expression "received electronic mail" were understood as that received internally by the e-mail computer from the LAN controller then every mail would fail before it

left the electronic mail apparatus, since every received e-mail would be classed as a transmission failure. If however the expression "received electronic mail" were understood as being an electronic mail received by the e-mail computer from the e-mail network then the question arose as to whether a transmission failure had occurred at all; the expression "received electronic mail" had to have a consistent meaning throughout claim 1. Moreover, although the basis for the sender address seemed to be the twentieth embodiment, not all features of the twentieth embodiment, for instance the CPU, were set out in claim 1. Furthermore the twentieth embodiment related to incoming e-mails, whilst it was now being applied to outgoing e-mails. As to the second auxiliary request, the appellant stated that he was against remitting the case to the first instance.

XIX. The respondent's arguments in the oral proceedings concerning his final requests may be summarized as follows. The amendments according to the main and first auxiliary requests were intended to overcome objections which had only been raised at the oral proceedings. The expression "received electronic mail" had the same meaning in claim 1 according to the main and first auxiliary requests as it had in granted claim 1. Claim 1 of both requests used the original expression and was thus clear. The two uses of the expression in claim 1 "received electronic mail" would be read together by the skilled person with the same meaning, thus avoiding an internal inconsistency in the claim. According to the twentieth embodiment (see page 63 and figure 33 of the application as filed), if a received e-mail could not be delivered it would be "bounced

back" by the recipient e-mail computer. A "received electronic mail" was received by the e-mail computer from the LAN controller, but the decision as to whether a transmission failure had occurred was taken by the CPU of the claimed electronic mail apparatus after having compared the sender address of the said received electronic mail with a given address assigned to the electronic mail apparatus. As to the second auxiliary request, the clarity problem in the claims had only been raised three weeks before the oral proceedings. This warranted remittal of the case to the first instance.

- XX. 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 auxiliary requests*

The appellant objected to the admission into the proceedings of these requests, filed in the oral proceedings, on the basis that they were late filed and contrary to the prohibition of *reformatio in peius*.

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.

The main and first auxiliary requests 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 patent as maintained by the opposition division and as amended according to the main request and auxiliary request I filed at the beginning of the oral proceedings in the light of the discussion in the previous case T 1007/05. 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 unrelated 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 to the question of *reformatio in peius*, in the present case, in which only the opponent appealed against the interlocutory decision by the opposition division, the prohibition of *reformatio in peius* (see G 9/92 and G 4/93, both in OJ EPO 1994, 875) means that the patentee is primarily restricted in appeal proceedings to defending the patent in the form in which it was maintained by the opposition division. Hence the patentee would be prevented from returning to the granted claims (as the appellant had demanded). In the present case the board takes the view that the amendments according to the main and first auxiliary requests take the claims forming the basis of the interlocutory decision as a starting point and are aimed at overcoming objections raised in the appellant's letter dated 15 May 2009 and in the debate at the oral proceedings. Thus the amendments are seen as appropriate and necessary to defend the result obtained before the opposition division. Consequently the board decided to admit the main and first auxiliary requests into the proceedings.

3. *The allowability of the respondent's main and first auxiliary requests*

Claim 1 according to both requests sets out components for scanning a paper document and for converting the scanned data into an electronic mail format which is passed to transmitting means (embodied by a LAN controller 9) which transmits an e-mail to an electronic mail destination address via the network. Components are also set out for receiving an e-mail from the e-mail network (receiving means, also embodied by the LAN controller 9) and for converting the data in

the e-mail into a form which can be printed on a printer (see for instance figure 24). Claim 1 according to both the respondent's main and first auxiliary requests further comprises the passage "means (1) for detecting that transmission of a **received electronic mail** fails by determining that the sender address of the **received electronic mail** agrees with a given address assigned [*sic*] to said electronic mail apparatus" (emphasis added by the board). In the light of the description and figures of the patent it is possible to interpret the first of the two highlighted instances of the expression "received electronic mail" as being an electronic mail received internally by the e-mail computer 9A from the LAN controller 9, claim 1 specifying transmitting means (9) and referring to "transmission of a received electronic mail" and the description providing support for this interpretation by referring to "image data of the e-mail format" being transferred from the storage unit 4 to the LAN controller 9; see, for instance, figures 1 and 24; paragraphs [0047] and [0146] of the published patent. However it is also possible to interpret the second of the two highlighted instances of the expression "received electronic mail" as being an electronic mail received externally by the receiving means (9) from the e-mail network 9B (via the e-mail computer 9A); see figures 24, 25 and 33 and paragraphs [0194] to [0198] of the published patent. In fact the electronic-mail transmitting and receiving means are embodied by the LAN controller 9, which serves as a relay station and communicates with the network via the e-mail computer 9A, which is not part of the claimed apparatus. Comparing the address with a given address assigned to the electronic-mail apparatus (or system, see

paragraph [0196] of the published patent) does not make clear either which transmission has failed or why an electronic mail which was received via the network (i.e. transmission to the receiving means did not fail) is determined to be a failure for the mere fact that the sender address agrees with a given address assigned to the electronic-mail apparatus. The passages referred to by the respondent and the opposition division in the decision under appeal (page 63, erroneously referred to as page 33 in the decision under appeal, which corresponds to paragraphs [0194] to [0198] of the published patent, and figure 33) do not support a clear understanding of claim 1 either. This leads to a lack of clarity of claim 1 of the main request.

The additional features of claim 1 of the first auxiliary request, essentially an interconnection via an internal bus structure of the different means, set out that the transmitting and receiving means (9) are electrically connected to the bus structure. This helps to clarify that the transmitting and receiving means (9) in claim 1 refer to the LAN controller 9 in the embodiments, not to the e-mail computer 9A (see figure 24). However, since the board has already construed claim 1 of the main request in this way, these additional features do not change the reasoning set out above.

Hence claim 1 according to both requests does not clearly set out the subject-matter for which protection is sought and thus does not comply with Article 84 EPC 1973.

4. *The respondent's second auxiliary request (remittal)*
- 4.1 The respondent's second auxiliary request for remittal was only made after the debate on the clarity of the requests according to the respondent's main and first auxiliary requests had taken place.
- 4.2 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 second auxiliary request as actually meaning that the case should be remitted to the first instance in order to decide on the higher ranking requests.
- 4.3 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 (see Case Law of the Boards of Appeal, Fifth Edition, 2006, section VII.D.9.).

Since the board had already come to a conclusion on whether the claims according to the respondent's main

and first auxiliary requests satisfied Article 84 EPC 1973, which the board would consider in the case of any amendments, it was too late to remit the case to the first instance as remittal was neither necessary nor appropriate under the circumstances. Hence the board did not allow the respondent's second auxiliary request for remittal.

5. *Conclusion*

Since none of the respondent's main or first and second auxiliary requests is allowable, 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