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

**Case Number:** T 1014/05 - 3.5.04

**Application Number:** 99124161.3

**Publication Number:** 0984613

**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. 76(1), 111(1)

**Keyword:**  
"Extension beyond content of earlier application (yes)"  
"Admissibility of first to third auxiliary requests (no)"

**Decisions cited:**  
-

**Catchword:**  
Request for remittal not allowed after debate on relevant substantive issues (see point 5).



Case Number: T 1014/05 - 3.5.04

**DECISION**  
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:** Decision of the Opposition Division of the  
European Patent Office posted 10 June 2005  
rejecting the opposition filed against European  
patent No. 0984613 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 0984613, which derives from European patent application 99124161.3, a divisional application of European patent application 96105799.9 (hereinafter referred to as the "parent application").

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 13, 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; 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, wherein the first data converting means (5) converts the compressed image data together with **information of a source address of an e-mail transmission source other than the electronic mail apparatus** into an electronic-mail format, and the electronic-mail transmitting means (9) transmits the image data converted into the electronic-mail format to a destination address including the information of the source address, and for, in cases where a transmission failure occurs, informing the e-mail transmission source of the transmission failure." (Emphasis added by the board).

IV. In the appealed decision the opposition division found *inter alia* that the reference in granted claim 1 to a source address other than that of the apparatus (see point III above) did not cause the subject-matter of the granted patent to extend beyond the content of the parent application, Article 100(c) EPC 1973. In its reasoning the opposition division stated that the passages referred to by the patentee (page 35, lines 2 to 6, and page 42, lines 12 to 13, of the parent application as originally filed) showed that a source address corresponding to a user ID was substituted for the address which a sending apparatus would otherwise employ, namely its own. The purpose of this was to allow the user (source address) to be informed directly of a transmission failure.

V. In a statement of grounds of appeal the appellant requested that the decision be set aside and the patent revoked. The appellant also raised objections of lack of inventive step, insufficient disclosure and extension beyond the subject-matter of the parent

application. In particular the appellant argued that the feature "informing the e-mail transmission source of the transmission failure" had no basis in the parent application as originally filed, the fifth embodiment merely setting out that the e-mail source address was the address of the e-mail computer 9A and was therefore the same as that of the claimed apparatus. There was no disclosure or suggestion in the eighth or tenth embodiments that, in the event of a transmission failure, the failure notification sent from the network would be sent to the user source address.

VI. In a letter dated 20 March 2006 the respondent (patentee) requested that the appeal be rejected as unsubstantiated and that the patent be maintained as granted. The respondent also provided arguments concerning the objections of inventive step, insufficient disclosure and extension beyond the subject-matter of the parent application. In particular the respondent argued that in the fifth embodiment of the invention the e-mail computer 9a was the e-mail transmission source, this providing a basis for the feature in claim 1 "and for, in cases where a transmission failure occurs, informing the e-mail transmission source of the transmission failure". Moreover the eighth embodiment made a distinction between a sender ID, a destination mail address and a source address.

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 the expression in granted claim 1 "a source address of an e-mail transmission source other than the electronic mail apparatus" contradicted the statement in the original parent application that "The source address agrees with an address assigned to an e-mail computer 9A connected to the LAN controller 9"; see page 22, lines 6 to 7, and the corresponding passage in column 12, lines 16 to 18, of the published parent application. This led to doubt as to whether *inter alia* the feature in claim 1 "and for, in cases where a transmission failure occurs, informing the e-mail transmission source of the transmission failure" had a basis in the parent application as originally filed.

IX. In a letter dated 15 May 2009 the appellant provided arguments concerning inventive step and objections under Article 100(c) EPC 1973. In particular the appellant argued that the expression in granted claim 1 "a source address of an e-mail transmission source other than the electronic mail apparatus" contradicted the sole relevant statement in the original parent application that "The source address agrees with an address assigned to an e-mail computer 9A connected to the LAN controller 9". Hence granted claim 1 contained added subject-matter. The appellant also drew attention to the final passage of the description as originally filed which stated that "At least two of the first embodiment to the twentieth embodiment may be combined into an electronic mail system", arguing that this

passage did not provide a clear and unambiguous indication that the fifth embodiment was to be supplemented by the provision of "receiving components" or a printer. Hence there was no basis for the combination of features set out in granted claim 1 in the description (or drawings) of the parent application as originally filed. Also claims 1, 2 and 5 of the parent application as originally filed did not provide a basis for the combination of features set out in granted claim 1.

- X. With a letter dated 18 May 2009 the respondent filed amended claims according to eight auxiliary requests. In the letter the respondent requested that the appeal be rejected as unsubstantiated and that the patent be maintained as granted or in amended form according to the auxiliary requests. The respondent did not comment on the issue of extension beyond the content of the parent application as originally filed.
  
- 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.
  
- XII. The respondent, at the beginning of the oral proceedings, submitted amended claims according to a new main request and new auxiliary requests I and II and made an auxiliary request III for remittal of the case to the first instance. In reaction to the debate the respondent submitted amended claims according to a new main request and new auxiliary requests I, II and

- III. The appellant objected to the admission of these requests into the proceedings as late filed.
- XIII. The appellant's final requests were that the decision under appeal be set aside and that the European patent be completely revoked.
- XIV. The respondent's final requests were as follows.

Main request: to maintain the patent on the basis of the last main request submitted in the oral proceedings;

alternatively, as first to third auxiliary requests: to maintain the patent on the basis of the latest-filed auxiliary requests I, II and III and

alternatively, as a fourth auxiliary request: to remit the case to the first instance.

- XV. The claims according to the main request comprise independent claim 1 and dependent claims 2 to 12, 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) 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, wherein the first data converting means (5) converts the compressed image data together with **information of a source address of an e-mail transmission source other than the electronic mail apparatus** into an electronic-mail format, and the electronic-mail transmitting means (9) transmits the image data converted into the electronic-mail format to a destination address including the information of the source address, and for, in cases where a transmission failure occurs, informing the e-mail transmission source of the transmission failure." (Emphasis added by the board.)

XVI. The claims according to the first auxiliary request comprise independent claim 1 and dependent claims 2 to 12, 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) 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, wherein the first data converting means (5) converts the compressed image data together with information of a source address of an e-mail computer into an electronic-mail format, and the electronic-mail transmitting means (9) transmits the image data converted into the electronic-mail format to a destination address including the information of the source address, and for, in cases where a transmission failure occurs, informing the e-mail computer of the transmission failure."

XVII. The claims according to the second 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; 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, inputting means on an operation panel (7A) for inputting the information of a source address of an e-mail computer (9a), wherein the first data converting means (5) converts the compressed image data together with information of the source address of the e-mail computer (9a) into an electronic-mail format, and the electronic-mail transmitting means (9) transmits the image data converted into the electronic-mail format to a destination address including the information of the source address, and for, in cases where a transmission

failure occurs, informing the e-mail computer (9A) of the transmission failure."

XVIII. The claims according to the third auxiliary request comprise independent claim 1 and dependent claims 2 to 9, 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) 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, inputting means on an operation panel (7A) for inputting the information of a source address of an e-mail computer (9a), wherein the first data converting means (5)

converts the compressed image data together with information of the source address of the e-mail computer (9a) into an electronic-mail format, and electronic-mail transmitting means (9) transmits the image data converted into the electronic-mail format to a destination address including the information of the source address, and for, in cases where a transmission failure occurs, informing the e-mail computer (9A) of the transmission failure; wherein 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), said facsimile modem (18) and said printing means (11) are electrically interconnected via an internal bus structure."

XIX. The appellant's arguments in the oral proceedings concerning the respondent's final requests may be summarized as follows. The respondent's main and first, second and third auxiliary requests were all late filed and should not be admitted. Regarding the main request, the combination of features set out in claim 1, in particular the expression "a source address of an e-mail transmission source other than the electronic mail apparatus", was not directly and unambiguously derivable from the parent application as filed. Moreover, although claim 1 was based on the fifth embodiment, the feature set out on page 22, lines 3 to 5, of the parent application as originally filed, namely that "Information of the address of an e-mail transmission source can be inputted into the electronic mail system by operating the source button on the operation panel 7A", had been omitted from claim 1, thus also adding subject-matter, since claim 1 would

now cover the use of a fixed sender address. Moreover the fifth embodiment lacked any receiver components or a printer. The fifth and tenth embodiments involved user input of the source address, which bore no relation to the eighth embodiment. The last sentence of the description, which stated that "At least two of the first embodiment to the twentieth embodiment may be combined into an electronic mail system", was not a direct and unambiguous disclosure of any of the embodiments in combination. Furthermore the expression in claim 1 "a source address of an e-mail transmission source other than the electronic mail apparatus" contradicted the statement in the original parent application that "The source address agrees with an address assigned to an e-mail computer 9A connected to the LAN controller 9". Hence claim 1 contained added subject-matter. Even at a first glance, the claims according to the first, second and third auxiliary requests were all open to the same objections as those according to the main request, in particular because the "e-mail computer" set out in claim 1 could be any computer.

- XX. The respondent's arguments in the oral proceedings concerning his final requests may be summarized as follows. The claims were based on the fifth embodiment; see page 21, line 24, to page 22, line 5, of the application as originally filed or paragraph [0058], lines 38 to 49, of the application as published. According to this embodiment, the user entered a source address on a keyboard and, in the event that the transmission of an e-mail from the electronic mail system to the destination failed, a responsive e-mail representing the transmission failure was received by

the e-mail computer 9A (see page 22, lines 7 to 11, of the application as originally filed or paragraph [0058], lines 51 to 55, of the published application). The source address was that of the e-mail computer; see the eighth embodiment (page 34, line 26, to page 35, line 6, of the application as originally filed or paragraph [0092] of the published application). Figure 17, which related to the eighth embodiment, showed the source address "toyoda@mei.co.jp". The source address could also be prestored; see the tenth embodiment (page 42, lines 2 to 13, of the application as originally filed or paragraph [0114], lines 38 to 52, of the published application). The last sentence of the description disclosed combining all the embodiments. There was only one e-mail transmission source, namely e-mail computer 9A. The source address was the location to which a transmission failure report was to be sent. The amended claims according to the first to third auxiliary requests overcame the objection against the expression "a source address of an e-mail transmission source other than the electronic mail apparatus" by instead setting out an e-mail computer. The claimed e-mail apparatus did not include an e-mail computer; this was merely the e-mail source.

XXI. At the end of the oral proceedings the board announced its decision.

## **Reasons for the Decision**

### *1. The admissibility of the appeal*

The appeal is admissible.

2. *The admissibility of the respondent's main request*
- 2.1 The appellant objected to the admission into the proceedings of this request, filed in the oral proceedings, as late filed.
- 2.2 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.
- 2.3 The main request was filed in response to objections at least some of which were newly raised in the oral proceedings by the appellant and the board. 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 this request concerned amendments, such as the addition of the expressions "character code data" and "expansion resultant image data", which solved different problems that arose from the debate in the jointly held oral proceedings (see point XI above) and 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.

2.4 Hence the respondent's main request was admitted into the proceedings.

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

3.1 *The original disclosure in the parent application*

3.1.1 Broadly speaking, the invention relates to the sending and receiving of e-mails containing compressed image data, paper documents being scanned in before sending and received images being printed out. The description sets out twenty embodiments, some embodiments building on the features of previous embodiments, in the manner of a set of claims. The parties have referred mainly to the fifth, eighth and tenth embodiments regarding the basis for the claimed subject-matter.

3.1.2 According to the respondent, the fifth embodiment provides the relevant original disclosure. The fifth embodiment builds on the first embodiment (see page 21, lines 16 to 18, of the parent application as originally filed or column 11, lines 55 to 58, of the parent application as published). The board agrees. Hence one must first turn to the first embodiment.

3.1.3 Figure 1 shows an electronic mail system according to the first embodiment including a CPU, a ROM, a RAM, a storage unit, a format converter, a scanner, an operation panel, a data compressor and a LAN controller,

all electrically connected via a bus line. The LAN controller is connected via a LAN to an e-mail computer, which in turn is connected to an e-mail network such as the internet. In operation (see figure 2 and the corresponding passages in the description) a document sheet is placed in the scanner and information of a desired destination is entered via the operation panel. On entering the address of the e-mail destination via a keyboard on the operation panel and pressing the start button on the operation panel the document is scanned and the resulting data is compressed, stored, converted into image data of the e-mail format and stored. The image data of the e-mail format is then transferred from the storage unit to the LAN controller and then from the LAN controller to the e-mail computer. The e-mail computer then transmits the image data of the e-mail format via the e-mail network to the destination.

- 3.1.4 The fifth embodiment (see figures 9 and 10) adds to the first embodiment a source button on the operation panel, information of the address of an e-mail transmission source being entered into the electronic mail system by operating the source button. According to page 22, lines 6 to 11, of the parent application as originally filed and column 12, lines 16 to 22, of the parent application as published, "The source address agrees with an address assigned to an e-mail computer 9A connected to the LAN controller 9. Accordingly, in the event that the transmission of an e-mail from the electronic mail system to the destination has failed, a responsive e-mail representing the transmission failure can be received by the e-mail computer 9A." In operation (see figure 10) the user enters the e-mail destination address (step S41), then the source address

(step S42) and then presses the start button to start scanning the document for e-mail transmission. If a transmission failure occurs then an e-mail relating to the transmission failure is received at the source address assigned to the e-mail computer.

- 3.1.5 The eighth embodiment builds on the fourth embodiment, which in turn builds on the first, second and third embodiments. In contrast, the tenth embodiment builds on the ninth embodiment, which in turn builds on the fourth embodiment. Hence, before turning to the eighth and the tenth embodiments, it is necessary in both instances to first understand the fourth embodiment.
- 3.1.6 Turning to the fourth embodiment, the second embodiment essentially adds to the first embodiment the components required to receive an e-mail containing compressed image data, to convert the format of the image data, to expand the image data and to print out the image on a printer (see figures 3 and 4). The third embodiment (see figures 5 and 6) essentially adds a font memory storing font data for converting received character code data into image data, the font data being used to convert received e-mails having a MIME content type "text/plain" in the header, but not if the content type is "image/tiff". The fourth embodiment (see figures 7 and 8) adds a character recognition unit, the document sheet to be transmitted containing information in a predetermined area - termed a "zone" - giving the destination address of the e-mail. Subsequent to the "Start" button being pressed and the document sheet having been scanned, part of the image data is transferred to the character recognition unit which

generates information on the e-mail destination as a result of character recognition.

3.1.7 The eighth embodiment (see figures 16 and 17) essentially replaces the LAN controller of the previous embodiments by one which can analyze the received e-mail (see page 34, lines 7 to 16, of the parent application as originally filed and column 18, line 52, to column 19, line 3, of the parent application as published). Figure 17 gives an example of such a received e-mail having a header containing the content type "text/plain" and indicating a sender ID "toyoda", a corresponding "source address" toyoda@mei.co.jp" and a list of destination addresses, for example "kawa@aaa.bbb.co.jp". The CPU of the electronic mail system transfers the sender, source address and destination address information to the storage unit.

3.1.8 Turning to the tenth embodiment, the ninth embodiment (see figures 18, 19 and 20), on which the tenth embodiment is based, replaces the operation panel in the fourth embodiment (inherited from the first embodiment; see above) by one having *inter alia* a display, a key board, a start button and a destination list button. ID information of a sender can be inputted using the key board on the operation panel (step S82). Depressing the destination list button causes a destination list to be read out from the storage unit and shown by the display on the operation panel from which a destination can be selected (step S83). The tenth embodiment (see figures 21, 22 and 23) replaces the operation panel of the ninth embodiment by one having *inter alia* a display, a key board, a start button and a source button. In other words, the tenth

embodiment replaces the destination list button of the ninth embodiment by a source button (see page 40, lines 13 to 22, of the parent application as filed). Information of a source address can be shown by the display on the operation panel, and ID information of a sender can be entered using the source button. Information of the e-mail destination can be entered on the keyboard. The text of received e-mails is analyzed to extract sender ID information and source address information (step S74A) which are then stored (step S75A) in a correspondence relation. Turning to transmission, ID information of a sender is entered by depressing the source button (step S82A), information of a corresponding source address then being read out from the storage unit and displayed. Information of an e-mail destination is then entered by the operation panel (step S83A).

- 3.1.9 As a result of this analysis the board finds that the fifth embodiment is the only one relied upon by the respondent which relates to transmission failures. The board understands the fifth embodiment to mean that in the event that the transmission of an e-mail from the electronic mail system to the destination fails then an e-mail representing the transmission failure is sent to the source address. According to the fifth embodiment, "The source address agrees with an address assigned to an e-mail computer 9A connected to the LAN controller 9"; see page 22, lines 6 to 7, of the parent application as originally filed and column 12, lines 16 to 18, of the published parent application. This disclosure does not provide a basis for the expression in claim 1 "information of a source address of an e-mail transmission source other than the electronic

mail apparatus". As the e-mail computer 9A is presented as part of the electronic mail system in the parent application as filed (see figure 1 and point 3.1.3 above) and as the inputted address agrees with an address assigned to the e-mail computer the mere fact that an electronic mail apparatus is claimed which does not mention the e-mail computer does not necessarily mean that the electronic mail apparatus has another address. Apart from bus connection of the claimed components and the connection of the e-mail computer 9A via a LAN, the parent application as filed does not clearly delimit the claimed electronic mail apparatus from the disclosed system. The respondent's argument that the source address can be prestored does not mean that it has to be an address other than that of the electronic mail apparatus. Whereas the input of ID information via the keyboard and the display of a stored corresponding source address (tenth embodiment, see point 3.1.8 above) makes it possible to input several different source addresses and ID numbers, the board considers that this different embodiment does not directly and unambiguously disclose that the source address in embodiments which do not refer to such a correspondence relation between ID information of a sender and a source address is different from that of the electronic mail apparatus. In this respect the board concurs with the appellant that the final passage of the description as originally filed which states that "At least two of the first embodiment to the twentieth embodiment may be combined into an electronic mail system" does not provide a clear and unambiguous indication either.

3.1.10 For the sake of completeness, the board notes that the twentieth embodiment - which builds on the twelfth, seventh, sixth, fourth, third, second and first embodiments - also concerns transmission failures. However, in contrast to the fifth embodiment, the twentieth embodiment concerns the printing out of a transmission failure signal, rather than the sending of an e-mail when a transmission failure occurs. Hence the twentieth embodiment, in combination with the embodiments upon which it builds, also does not provide a basis for the expression in claim 1 "information of a source address of an e-mail transmission source other than the electronic mail apparatus".

3.1.11 Consequently the expression in claim 1 "information of a source address of an e-mail transmission source other than the electronic mail apparatus" in the claimed combination of features is not directly and unambiguously derivable from the parent application as originally filed, contrary to Article 76(1) EPC 1973.

4. *The admissibility of the respondent's first, second and third auxiliary requests*

The appellant also objected to the admission into the proceedings of these requests, filed in the oral proceedings, as late filed.

The amendments in these requests were only made after having admitted and extensively discussed several previous requests and modifications, although the amendments relating to the information of a source address could have been made in reply to the appellant's objections in the statement of grounds of

appeal. Even a *prima facie* examination of these requests revealed that the further amendments in claim 1 did not solve the problem indicated by the board, namely that the combination of features as claimed in claim 1 was not directly and unambiguously derivable from the parent application as filed, and introduced new problems which had been previously referred to by the appellant. For instance, the e-mail computer set out in claim 1 could be any computer that was informed of a transmission failure instead of the e-mail source. Moreover the board considered that the deletion of a feature from claim 1 ("transmission source other than the electronic mail apparatus") as granted without introducing features which were clearly disclosed in combination and limited the scope of the patent as maintained was not appropriate at this late stage of the proceedings. 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. Consequently the board exercised its discretion under Article 13(1) RPBA, in the particular circumstances of this case, not to admit the first, second and third auxiliary request into the proceedings.

5. *The respondent's fourth auxiliary request (remittal)*

5.1 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. As the respondent cannot reasonably have



meant remittal after a decision on the higher ranking requests, the board interprets the fourth auxiliary request as actually meaning that the case should be remitted to the first instance in order to decide on the higher ranking requests.

5.2 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 (see Case Law of the Boards of Appeal, Fifth Edition, 2006, section VII.D.9.).

5.3 In the present case the board had to decide on an appeal filed against the decision by the opposition division finding, *inter alia*, that the ground for opposition under Article 100(c) EPC 1973 (in conjunction with Article 76(1) EPC 1973) did not prejudice the maintenance of the patent unamended. The amendments made in accordance with the main request, which were admitted by the board, had no substantial influence on the meaning, in the given context, of the feature which was found to be contrary to Article 76(1) EPC 1973. The relevant issue of the main request thus clearly relates to the case under appeal which was discussed with the parties and which had to be decided by the board. As the board had already come to a conclusion on whether the claims according to the

respondent's main request satisfied Article 76(1) EPC 1973, and had decided not to admit the respondent's first, second and third auxiliary requests, the board found that remitting the case to the first instance was neither necessary nor appropriate under the circumstances.

Hence the board did not allow the respondent's fourth auxiliary request for remittal.

6. *Conclusion*

Since the respondent's main request is not allowable, the respondent's first, second and third auxiliary requests are not admitted into the proceedings and the respondent's fourth 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