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**Datasheet for the decision
of 26 October 2010**

Case Number: T 0314/06 - 3.5.04

Application Number: 03101619.9

Publication Number: 1341371

IPC: H04N 1/60

Language of the proceedings: EN

Title of invention:

Method and system for calibrating a printing device

Applicant:

Agfa Graphics N.V.

Headword:

-

Relevant legal provisions:

RPBA Art. 15(3)(5)(6)

Relevant legal provisions (EPC 1973):

EPC Art. 76(1)

EPC R. 71(2)

Keyword:

"Subject-matter extending beyond the content of the earlier application as filed (yes)"

Decisions cited:

G 0001/06, T 0211/95

Catchword:

see points 6 to 8 of the Reasons



Case Number: T 0314/06 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 26 October 2010

Appellant: Agfa Graphics N.V.
Septestraat 27
B-2640 Mortsel (BE)

Representative: Goedeweck, Rudi
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 8 September 2005
refusing European patent application
No. 03101619.9 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: F. Edlinger
Members: M. Paci
T. Karamanli

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 03 101 619.9, published as EP 1 341 371 A2.
- II. The decision under appeal was based on the ground that the present application, a divisional application from earlier European patent application No. 00 203 076.3 (published as EP 1 083 739 A2), by the definitions given in claims 1 and 4 of the present application as filed, contained subject-matter extending beyond the content of the earlier application as filed, in violation of Article 76(1), second sentence, EPC 1973.
- III. In an official communication accompanying the summons to oral proceedings the board informed the appellant of its preliminary non-binding opinion that claims 1 and 4 did not comply with Article 76(1), second sentence, EPC 1973.
- IV. With a letter dated 13 October 2010 the appellant informed the board that it would not attend the oral proceedings.
- V. Independent claim 1 reads as follows:
- "A method for calibrating a printing device comprising the step of mapping a first value for addressing said printing device to a second value for addressing said printing device; **characterised in that** said first value is for printing a 100% patch of a wedge (10, 11, 12, 13) on a receiving substrate by applying an amount of marking particles to said receiving substrate, and in

that said second value is smaller than a value for addressing said printing device for applying a maximum possible amount of said marking particles."

Claims 2 to 7 have no bearing on the present decision.

- VI. The appellant's final request filed with the statement of grounds of appeal is that the decision under appeal be overruled.
- VII. Oral proceedings were held by the board on 26 October 2010 in the absence of the duly summoned appellant. At the end of the oral proceedings the board announced its decision.
- VIII. The decision under appeal is, as requested by the appellant, a decision according to the state of the file, which refers to two previous communications for the reasons for the decision. These reasons regarding claim 1 can be summarised as follows.

According to the examining division's interpretation of Article 76(1), second sentence, EPC 1973, in order to comply with this requirement the claims of a divisional application should be derivable **from the claims of the earlier application as filed**, not merely from the description of the earlier application as filed. There must be some evidence that the applicant saw the subject-matter later set out in the claims of the divisional application as an invention for which he wished patent protection. According to the examining division, this interpretation is arrived at when due account is taken of the legal security of third parties and of the purposes and consequences of Articles 80

(date of filing) and 69 (extent of the protection) EPC 1973.

Since the subject-matter of claim 1 of the present application is not derivable on its own from the corresponding claims in the earlier application as filed but only in combination with the subject-matter of claim 1, the requirements of Article 76(1), second sentence, EPC 1973 are not met.

IX. The appellant argued essentially as follows:

(a) The examining division's interpretation of Article 76(1), second sentence, EPC 1973 according to which the claims of the (divisional) application as filed must be derivable from the claims of the earlier application as filed, is incorrect. Article 76(1), second sentence, EPC 1973 only requires that the divisional application does not contain subject-matter extending beyond the content of the earlier application as filed. Hence the subject-matter claimed in a divisional application as filed may also be derivable from the description, not merely from the claims, of the earlier application as filed.

(b) In the present case, the subject-matter of claim 1 of the divisional application is disclosed in paragraphs [0088] to [0091] of the earlier application. Moreover, the subject-matter of claim 1 is part of the subject-matter of claim 7 of the earlier application as filed.

The description of the earlier application as filed included four embodiments, related to different aspects of calibration, of which only the subject-matter of the first embodiment was claimed in the earlier application and the subject-matter of the third embodiment is claimed in the divisional application. The identification of the third embodiment as a separate invention was made explicit in the earlier application by including the words "some of these disclosed embodiments may be the subject of a divisional application of the present patent application" in the summary of the invention (see paragraph [0045] of the earlier application).

- (c) In the opposition case against European patent EP 0 822 454 B1, the opposition division concluded that the requirements of Article 123(2) EPC 1973 were satisfied in that case because the subject-matter of the amended claims had been shown to have a clear basis in the application as filed.
- (d) If in the course of the examination of a European patent application, an objection under Rule 86(4) EPC 1973 is raised, e.g. because the subject-matter of an amended claim only appears in the description of the application as filed, the applicant may continue to pursue such subject-matter in the form of a divisional application under Article 76 EPC 1973. Consequently, the subject-matter claimed in the divisional application must not necessarily be claimed in the earlier application as filed.

- (e) In the Guidelines for Examination (June 2005), C-VI, 9.1.6 relating to double patenting, it is explained that in general the earlier application and the divisional application may not claim the same subject-matter but that, as a general rule, one application may claim its own subject-matter in combination with that of the other application. The example provided in the Guidelines is that "if the parent and divisional applications claim separate and distinct elements A and B respectively which function in combination, one of the two applications may also include a claim for A plus B." This is exactly the description of the present case.
- (f) As to the legal certainty of third parties, as stated in decision T 441/92 (Reasons, point 4.7): "Interested members of the public are put on notice by the EPC that, after a European patent application has been filed, the content of that application cannot thereafter be extended, but that, nevertheless, while the application is pending, the protection sought by the claims may be extended beyond that sought in the claims as originally filed. The public are informed as to the content of the application as filed when the application is published (see Article 93(2) EPC)."
- (g) In a similar situation in decision T 211/95 (Reasons, points 4.3.3 and 4.4), the board held that it was clear to the person skilled in the art that the earlier application contained two different teachings, the two teachings each pertaining to a different problem, and realised by

different, independent technical features. Thus, the claimed invention of the earlier application solved a first problem (Reasons, point 4.1) and the claimed invention of the divisional application solved a second problem (Reasons, point 4.2), different from the first one. The two teachings were technically unconnected and could each be claimed separately. The skilled person would clearly see that the set of features according to the subject-matter claimed in the parent application was not essential to the subject-matter claimed in the divisional application.

In the present case, the invention of claim 1 of the present divisional application solves the problem of (see paragraph [0088] of the earlier application) "a printing device that is not stable due to the fact that the maximum amount of marking particles, that the device applies to the receiving substrate, changes over time for one or more colorants", whereas the invention of claim 1 of the earlier application pertains to a calibration method that incorporates characteristics of the human visual system and wherein the quantities that are used to calibrate the different colorants of the printing device are optimally chosen (paragraph [0053] and claim 1 of the earlier application). Hence the two inventions in the earlier application are based on two unconnected teachings and solved by different, independent technical features. For the reasons underlying T 211/95, the two inventions should be allowed to be claimed separately.

Reasons for the Decision

1. The appeal is admissible.
2. As announced in advance, the duly summoned appellant did not attend the oral proceedings. According to Rule 71(2) EPC 1973, the proceedings could however continue without him. In accordance with Article 15(3) RPBA (Rules of Procedure of the Boards of Appeal of the European Patent Office, OJ EPO 2007, 536), the board relied for its decision only on the appellant's written submissions. The board was in a position to decide at the conclusion of the oral proceedings, since the case was ready for decision (Article 15(5) and (6) RPBA), and the voluntary absence of the appellant was not a reason for delaying a decision (Article 15(3) RPBA).

Article 76(1) EPC 1973

3. Since the present divisional application was filed before the revised EPC entered into force on 13 December 2007 the applicable legal text is Article 76 EPC 1973 (see Special edition No. 1, OJ EPO 2007, pages 196-198).
4. According to Article 76(1), second sentence, EPC 1973 a European divisional application "*may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed*". Reference to the earlier application as filed will be made in the following by reference to the identical wording in the version published as EP 1 083 739 A2.

5. According to the established jurisprudence of the boards of appeal it is a necessary and sufficient condition for a divisional application to comply with Article 76(1), second sentence, EPC 1973 that anything disclosed in the divisional application must be **directly and unambiguously derivable** from what is disclosed in the earlier application as filed (see G 1/06, OJ EPO 2008, 307, Order of the decision).

6. In the present decision according to the state of the file, the examining division argued that in order to comply with Article 76(1), second sentence, EPC 1973 the claims of a divisional application should be derivable **from the claims of the earlier application**, not merely from the description of the earlier application as filed. The examining division based its reasoning in particular on considerations regarding the legal security of third parties.

7. The board does not agree with the examining division's interpretation of Article 76(1), second sentence, EPC 1973. The Enlarged Board of Appeal explained in decision G 1/06 (loc. cit., see in particular points 5.3 and 9.2 of the Reasons) why the legal security of third parties is sufficiently protected when Article 76(1), second sentence, EPC 1973 is interpreted as referring to the whole technical content of the earlier application as filed, rather than only to the claimed subject-matter of the earlier application as filed.

8. Hence the relevant question in the present case is not, as argued by the examining division, whether the

subject-matter of claims 1 and 4 of the present application could be derived from the claims of the earlier application as filed, but, as argued by the appellant, whether the subject-matter of claims 1 and 4 was **directly and unambiguously derivable** from the **whole technical content** of the earlier application as filed.

9. Disclosure of the earlier application as filed

9.1 Disclosure of the claims

Independent claim 1 of the earlier application as filed reads as follows:

"A method for calibrating a printing device, comprising the steps of:

- printing by said printing device a first wedge (10, 11, 12, 13);
- printing by said printing device a second wedge (10, 11, 12, 13), different from said first wedge (10, 11, 12, 13);
- determining for at least one patch (21) of said first wedge (10, 11, 12, 13) a first magnitude of a first quantity, wherein said first quantity is selected from the group of a psychophysical quantity and a psychovisual quantity;
- using said first magnitude in calibrating said printing device; characterised in that the method further comprises the steps of:
 - determining for at least one patch of said second wedge (10, 11, 12, 13) a second magnitude of a second quantity, wherein said second quantity is different from said first quantity;

- using said second magnitude in calibrating said printing device."

Independent claim 9 of the earlier application as filed is directed at a system having features essentially corresponding to the steps of the above method of claim 1.

Hence both independent claims 1 and 9 of the earlier application relate to a calibration using a first quantity selected from the group of a psychophysical quantity and a psychovisual quantity, and a second quantity different from said first quantity.

The features of the method of claim 1 according to the present divisional application are found only in claim 7, dependent on claim 1, of the earlier application as filed.

Accordingly, it can be concluded from the above that the claims of the earlier application disclose the features of claim 1 of the present divisional application only in combination with the features of claim 1 of earlier application, i.e. as a further refinement of the invention claimed in claim 1 of the earlier application.

The above conclusion is not disputed by the appellant.

However, the disclosure of the remaining parts of the earlier application as filed, i.e. the description and drawings, must also be considered.

9.2 Disclosure of the description and drawings of the earlier application as filed

"OBJECTS OF THE INVENTION" section

The section of the description entitled "OBJECTS OF THE INVENTION" (paragraphs [0030] and [0031]) defines the objects of the invention as follows:

- to provide a calibration method and a system therefor that take into account changes of characteristics of the printing system;
- to provide a calibration method and a system therefor that are robust with respect to printer instability.

"SUMMARY OF THE INVENTION" section

The section entitled "SUMMARY OF THE INVENTION" (paragraphs [0044] to [0068]) starts at paragraph [0044] by stating that "The above mentioned objects are realised by a method and a system in accordance with the present invention as claimed in the independent claims. The dependent claims set out preferred embodiments". In the remainder of the "SUMMARY OF THE INVENTION" section (paragraphs [0046] to [0068]), except paragraph [0045] discussed in the next paragraph below, the invention is presented as relating to a calibration method or system using a first quantity selected from the group of a psychophysical quantity and a psychovisual quantity, and a second quantity different from said first quantity, i.e. as relating to subject-matter corresponding to the method of claim 1 and to the system of claim 9 of the earlier application as filed. Importantly, the "SUMMARY OF THE INVENTION"

section does not disclose any of the main features of dependent claim 7 of the earlier application as filed, i.e. the mapping of a first value for printing a 100% patch to a second smaller value. In other words, the "SUMMARY OF THE INVENTION" section, paragraph [0045] excepted, consistently presents the invention as being what is claimed in independent claims 1 and 9, and does not present the features of claim 7 of the earlier application as filed as an independent invention.

There is however also paragraph [0045] in the "SUMMARY OF THE INVENTION" section which reads: "As will become apparent from the following description and drawings, some of the disclosed embodiments do not require all the features of the invention as claimed in the independent claims; some of these disclosed embodiments may be the subject of a divisional application of the present patent application."

Paragraph [0045], however, does not indicate which features of the invention are not required and for which embodiments. It is thus left open whether or not the expression "some of the disclosed embodiments" was meant to include the third embodiment. The board considers that the broad statement of paragraph [0045] does not by itself render any specific combination of features from the disclosed embodiments **directly and unambiguously derivable** as a separate invention.

"DETAILED DESCRIPTION OF THE INVENTION" section

This section (paragraphs [0070] to [0101]) discloses four embodiments of the invention. The embodiment comprising the features in claim 1 of the present

divisional application and in claim 7 of the earlier application as filed is the third embodiment.

The description of the third embodiment in paragraphs [0088] to [0091] of the earlier application as filed does not contain any statement making it unambiguously clear that the third embodiment was meant to be more than just an embodiment of the invention.

The third embodiment is also mentioned in paragraphs [0078] and [0079] where it is stated that the mapping of a first value for printing a 100% patch to a second smaller value, which is specific to the third embodiment, could preferably be applied as a first step before carrying out, as a second step, a calibration method according to claim 1 of the earlier application as filed. However, whereas the first step is described as optional (see last sentence of paragraph [0079]), there is, by way of contrast, no indication in these two paragraphs that the second step might be optional. Paragraphs [0083] and [0095], which also mention the third embodiment, do not provide such an indication either.

Thus, summarising, the disclosure of the description and drawings is consistent with the disclosure of the claims of the earlier application as filed in presenting the subject-matter of claim 1 of the present divisional application, not as a separate invention, but as features which must be taken **in combination with** the features of claim 1 of the earlier application as filed. Thus the subject-matter of present claim 1 is not directly and unambiguously derivable from the earlier application.

10. The appellant's arguments

The appellant's arguments have been summarised and listed as (a) to (g) in section IX *supra*.

The board does not dispute argument (a), as explained in section 8 *supra*.

As to argument (b), the board disagrees for the reasons set out in section 9 *supra*.

As to argument (c), as a matter of principle, the decision of an opposition division taken in a different case and based on different facts has no bearing on the present appeal proceedings. In any case, since the opposition division apparently argued along the same lines as the appellant in argument (a), which the board concurs with, argument (c) needs no further discussion.

Argument (d), relating to Rule 86(4) EPC 1973 and argument (e), relating to double patenting, have no bearing on the board's reasoning set out in sections 3 to 9 *supra*.

The board has stated under section 7 *supra* that it agrees with argument (f) concerning the legal certainty of third parties.

Regarding argument (g), based on decision T 211/95, the present board reaffirms that **the necessary and sufficient condition** established by the case law of the boards of appeal, in particular by the Enlarged Board of Appeal (see, for instance, G 1/06, loc. cit., Order

of the decision), for deciding whether a divisional application meets the requirement of Article 76(1), second sentence, EPC 1973 is that anything disclosed in the divisional application must be **directly and unambiguously derivable** from what is disclosed in the earlier application as filed. This strict criterion is the same as is applied for determining whether a claimed subject-matter is novel with respect to a prior art disclosure.

In decision T 211/95, the board reached the conclusion that the earlier application as filed contained two separate inventions, even though only one of them was claimed. In order to reach this conclusion, the board took into account the whole disclosure of the earlier application as filed, including the problems and teachings of the two inventions, and came to the conclusion that the two inventions were technically unconnected and could be claimed separately. The present board understands the board's reasoning in T 211/95 as being that the requirement of Article 76(1), second sentence, EPC 1973 was complied with because it was **implicit** from the whole disclosure of the earlier application as filed that there were **two separate inventions** which could be claimed **separately**. This is apparent from the repeated reference in T 211/95 to the "technical teachings" ("technische Lehren") contained in the earlier application, which were considered as pertaining to different problems and independent technical features for the solution of the problems. In other words, the board in T 211/95, based on the different facts of that case, held that the whole disclosure of the earlier application as filed contained at least implicitly two separate inventions.

In the present case, the board explained (see section 9 *supra*) why the whole disclosure of the earlier application as filed does not present the subject-matter of claim 1 of the present divisional application as a separate invention.

Moreover, the technical teachings in the present case, taking particular account of underlying problems and the direct and unambiguous disclosure of inventions solving these problems, do not change the board's conclusion for the following reasons.

The third embodiment deals with cases where the maximum amount of marking particles changes over time for one or more colorants (see paragraph [0088] of the earlier application). The earlier application in paragraph [0028] explains that a calibration method using densities and dot gain does not work in this case. By contrast, the calibration method of the third embodiment is said to compensate for this effect (see paragraph [0089]). The board understands this to mean that the changes over time are compensated by the calibration method of the invention including the maximum amount (100 % patch), whereas the mapping as now claimed is merely a possible solution to the setting of the 100 % patch which is applied to the calibration curve in the beginning (the standard state) **before** any changes occur which are then compensated by the calibration method of the invention. This has the effect that, for a specific change (chroma decreasing over time), even the 100 % patch may be compensated by the calibration method of the invention (by increasing the amount of colorants beyond the setting in the

beginning), and printing of the 100 % patch remains stable (see paragraph [0091], in particular lines 48 to 58). This understanding is confirmed by the last nine words of claim 7 of the earlier application ("when said printing device comes fresh from the factory").

11. Conclusion

For the above reasons, the board concludes that the present divisional application does not meet the requirement of Article 76(1), second sentence, EPC 1973. Hence, the appealed decision cannot be set aside.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

L. Fernández Gómez

F. Edlinger