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**Datasheet for the decision
of 21 January 2011**

Case Number: T 1146/06 - 3.5.04

Application Number: 95300493.4

Publication Number: 0665675

IPC: H04N 1/60

Language of the proceedings: EN

Title of invention:

Printing system

Patentee:

Hewlett-Packard Company

Opponent:

Spandern, Uwe

Headword:

-

Relevant legal provisions:

RPBA Art. 12

RPBA Art. 15

Relevant legal provisions (EPC 1973):

EPC Art. 54(1)(2)

EPC Art. 108

Keyword:

"Admissibility of appeal - grounds - substantiation (yes)"

"Late-submitted material - document cited on appeal admitted
(yes)"

"Novelty (no)"

Decisions cited:

G 0009/91, G 0010/91, T 1007/95, T 0708/95, T 0611/90,
T 0389/95, T 0169/89, J 0010/07, T 1029/05, T 1082/05,
T 1557/05

Catchword:

see sections 3.5 to 3.7



Case Number: T 1146/06 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 21 January 2011

Appellant: Spandern, Uwe
(Opponent) Auf dem Dannenkamp 19
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Representative: Schaich, Axel
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Respondent: Hewlett-Packard Company
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
24 May 2006 concerning maintenance of European
patent No. 0665675 in amended form.

Composition of the Board:

Chairman: F. Edlinger
Members: A. Dumont
T. Karamanli

Summary of Facts and Submissions

- I. The opponent appealed against the decision of the opposition division to maintain European patent No. 0 665 675 in amended form.
- II. The opposition had been filed based on the grounds of lack of novelty and inventive step (Article 100(a) together with Articles 54(1) and 56 EPC 1973).
- III. In the decision under appeal the opposition division found *inter alia* that the subject-matter of amended claim 1 was new over the disclosure of the prior-art document D1, and that it involved an inventive step over a combination of D1 with either D3 or D4.
- IV. With the statement of grounds of appeal the appellant (opponent) filed a new prior-art document:

D5: JP 4-160981 A

and a complete English translation.

Apart from its request, the appellant submitted that D5 disclosed a system having all the features of claim 1 as maintained by the opposition division and that thus the subject-matter of claim 1 lacked novelty over D5.

Furthermore, on page 11 of the statement of grounds of appeal, the appellant submitted that, as was apparent from the discussion on novelty over D5, the features ("printing two printing objects of different object types on one and the same page" and "controlling two different print quality characteristics based on the

determined type of object to be printed") identified by the opposition division as being not disclosed in D1 were disclosed in D5 and concluded that thus the subject-matter of claim 1 was at least obvious for a skilled person from a combination of the disclosure of D1 and D5.

V. In a letter of 21 November 2006 the respondent (patentee) raised questions concerning the admissibility of the appeal and the admissibility of D5, argued that no admissible appeal had been filed and requested a preliminary decision on these points before the appeal could be considered on its merits.

VI. In an annex to the summons to oral proceedings, the board addressed the question of admissibility of the appeal in view of the established case law noting that, in the present case, the legal framework appeared to remain the same, but the factual framework appeared to have changed. Regarding the question of admissibility of D5, the board observed that D5 appeared relevant on a *prima facie* reading of page 8 of the translation of D5 in view of the technical problem underlying the patent in suit (paragraph [0006]). The board also referred to section 9 of the annex to the summons to oral proceedings before the opposition division and raised the question whether the warning by the opposition division, in discouraging the opponent from presenting new arguments based on new prior art in the oral proceedings, played a role in the filing of D5 only at the appeal stage. The board informed the parties that novelty and inventive step over D5 as the closest prior art might be discussed in the oral

proceedings and expressly invited the respondent to comment on D5 in advance of the oral proceedings.

- VII. In a letter received at the EPO on 13 January 2011 the respondent announced that the patentee would not be represented at the oral proceedings and submitted that D5 did not provide an explicit and unambiguous disclosure which could be said to read onto the claims of the patent in suit. D5 should thus be disregarded as being late filed and insufficiently relevant. The respondent maintained the earlier objections but did not present any further observations.
- VIII. Oral proceedings before the board took place on 21 January 2011. Nobody was present on behalf of the respondent.
- IX. The appellant requested that the decision under appeal be set aside and that European patent No. 0 665 675 be revoked.
- X. The chairman noted in the oral proceedings that the respondent had requested in writing a preliminary decision on the admissibility of the appeal, and, in the event that the board decided that the appeal was admissible, a preliminary decision as to the admissibility of D5.
- XI. Claim 1 as maintained by the opposition division reads as follows:

"A printing system for printing objects of different object types on the same page of a document, said system comprising:

means for determining the object types to be printed on a single page;

a printer control device (44) including a user interface (60-99) comprising an option for independently controlling two or more different print quality characteristics (81, 90) based on the determined type (41-43) of object to be printed; and wherein the user interface (60-99) includes an option (61) for selecting between automatic and manual control of the two or more print quality characteristics."

XII. The appellant's arguments may be summarised as follows:

As to the admissibility of the appeal, the case law cited by the respondent does not fit the present appeal.

Although the statement of grounds does not refer to the arguments given in the decision of the first instance regarding novelty and inventive step in the light of D1, D3 and D4, it includes further arguments with regard to novelty and inventive step in the light of D5, D1 and D3. The appellant not only relies on the new evidence D5, but also clearly refers to "the features which were considered in the previous decision of the Opposition Division not to be disclosed by document D1", while refraining from repeating the arguments already discussed in the opposition proceedings. Thus the statement of grounds of appeal clearly shows that the appellant does not accept the decision of the opposition division with regard to novelty and inventive step. The statement of grounds of appeal thus also challenges the decision on its merits.

The statement of grounds of appeal is also still within the same legal and factual framework as the opposition proceedings (as considered necessary in decisions G 9/91 and G 10/91) since the fresh reasons presented in the statement of grounds of appeal are still within the same original ground for opposition as considered necessary in decisions T 1007/95, T 708/95 and T 611/90 and T 389/95.

The appeal is therefore admissible.

D5 was submitted at the earliest possible point in time, after it had been found by an additional search triggered by the opposition division arriving at a conclusion adverse to the appellant on the basis of the prior art already on file. It also might have been found earlier, were it not for the opposition division's pressure to discourage the opponent from presenting new evidence and arguments in the opposition proceedings. Furthermore, D5 is *prima facie* much more relevant than documents D1, D3 and D4, so that it cannot be ignored and there must be room for some change in the factual framework. D5 should thus be considered.

D5 discloses a system having all the features of claim 1 as maintained by the opposition division (see also point IV above).

XIII. The respondent's arguments may be summarised as follows:

The appellant's statement of grounds of appeal does not fulfil the requirements for an admissible appeal against the decision by the opposition division. That

decision is not mentioned in any substantive way in the statement of grounds. The impression is thus that the opponent accepts in full the decision. However, it is a well-established principle in European patent law (see for example T 169/89 and T 1007/95) that for an appeal to be admissible it must in some way challenge the decision which is the subject of the appeal. In the present case, there is no challenge and, instead, the opponent sets out a new factual framework and in effect a brand new opposition for consideration in these appeal proceedings. Therefore no admissible appeal has been filed.

D5 was filed long after the normal period in which the document should have been filed and the opponent provided no reason in the statement of grounds of appeal as to why D5 was cited so late. Given the length of both D5 and also of the appellant's submissions seeking to argue in favour of its relevance, it is not immediately apparent whether it is of any relevance. It would take a substantial effort on the part of the patentee and of the board to determine whether or not it is *prima facie* relevant. D5 should thus not be admitted into the proceedings.

Reasons for the Decision

1. Introductory note

The present decision was taken after the entry into force of the revised European Patent Convention (EPC) on 13 December 2007. At that time, the contested European patent had already been granted. The board has

therefore applied the transitional provisions in accordance with Article 7(1), second sentence, of the Revision Act of 29 November 2000 and the decisions of the Administrative Council of 28 June 2001 (Special edition No. 1, OJ EPO 2007, 197) and 7 December 2006 (Special edition No. 1, OJ EPO 2007, 89). Articles and Rules of the revised EPC and of the EPC valid until that time are cited in accordance with the Citation Practice (see the 14th edition of the European Patent Convention, page 6).

2. Procedural matters

2.1 The absence of the respondent at the oral proceedings

As announced in advance, the duly summoned respondent 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) of the Rules of Procedure of the Boards of Appeal of the European Patent Office (RPBA, OJ EPO 2007, 536), the board relied for its decision only on the respondent'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 respondent was not a reason for delaying a decision (Article 15(3) RPBA).

2.2 The respondent's request for issue of a preliminary decision

The respondent requested a "preliminary decision" on the admissibility of the appeal, and, in the event that

the board decided that the appeal was admissible, a preliminary decision as to the admissibility of D5. In the present case, an interlocutory decision on these matters would not have accelerated or simplified the proceedings as a whole. Therefore the board took a decision dealing *inter alia* with these matters and terminating the appeal proceedings.

3. Admissibility of the appeal.

3.1 As far as the admissibility of the present appeal is concerned, the provisions of EPC 1973 are to be applied since all the time limits for complying with the conditions for filing an appeal had expired before the revised EPC entered into force (see also J 10/07, OJ EPO 2008, 567, Reasons, point 1).

3.2 The appeal complies with Articles 106 and 107 as well as with the first and second sentences of Article 108 and with Rule 64 EPC 1973. This is also not disputed by the respondent.

3.3 However, the respondent submitted that the appeal was inadmissible because the appellant did not challenge the decision under appeal, but set out a new factual framework and in fact a new opposition for consideration in the present appeal proceedings.

The admissibility of the present appeal therefore depends solely on whether the statement setting out the grounds of appeal complies with Article 108, third sentence, EPC 1973.

- 3.4 It is an established general principle that the statement of grounds of appeal should specify the legal or factual reasons on which the case for setting aside the decision is based. The arguments must be clearly and concisely presented to enable the board to understand immediately why the decision is alleged to be incorrect, and on what facts the appellant bases his arguments, without first having to make investigations of its own (see Case Law of the Boards of Appeal of the European Patent Office, Sixth Edition, July 2010, section VII.E.7.6.1).
- 3.5 In the present case, the statement of grounds of appeal does not address in detail all the issues of the reasoning of the decision under appeal and the evidence on which that decision relies. Instead, it develops new arguments mainly based on document D5 filed for the first time on appeal. However, the arguments are based on the same grounds of opposition as those on which the opposition and the decision under appeal were based, namely lack of novelty and of inventive step. According to the established jurisprudence of the boards of appeal, an appeal based on a fresh case may be admissible when the grounds for opposition have remained the same (e.g. T 611/90, OJ EPO 1993, 50, Reasons, point 2; T 389/95, Reasons, point 1; T 708/95, Reasons, point 1.2; T 1029/05, Reasons, point 1.10; T 1082/05, Reasons, point 1.1 or T 1557/05, Reasons, point 1.2).
- 3.6 Moreover, as far as inventive step is concerned, the appellant referred to features set out in the decision under appeal which were considered by the opposition division not to be disclosed in D1 (see point IV above),

and submitted that these features were disclosed in D5, as shown by the submissions on novelty over D5, and that consequently, the subject-matter of claim 1 was at least obvious for a skilled person from a combination of the disclosures of D1 and D5 (see page 11 of the statement of grounds of appeal). From these submissions it is clear for the board that the appellant went into the reasons of the decision under appeal and developed arguments based on new evidence filed in reaction to the reasons of the decision of the opposition division. Therefore it is the board's view that the statement of grounds of appeal in the present case relates to the reasons of the appealed decision.

- 3.7 In view of the circumstances of the present case the board considers that decisions T 169/89 and T 1007/95 (OJ EPO 1999, 733), cited by the respondent, are not relevant for the present case, since the factual situation was not the same.

In decision T 169/89 opposition was filed against the patent as granted on the grounds of insufficient disclosure (Article 100(b) EPC 1973) and lack of novelty and of inventive step (Article 100(a) EPC 1973). The opposition division revoked the patent on the ground of insufficient disclosure. The appellant (patent proprietor) lodged an appeal and filed a statement of grounds of appeal in which the objection of insufficient disclosure was not dealt with in detail. In case T 169/89 the board took the view that the appeal was inadmissible because the statement did not specify the legal and factual reasons why the decision should be set aside (see Reasons, points 4 and 5). In the present case, however, the statement of grounds of

appeal indicated that the decision of the opposition division regarding at least inventive step could not be confirmed in view of D5 (see point 3.6 above).

In decision T 1007/95 (loc. cit.) opposition was filed against the patent as granted only on the ground of lack of inventive step (Articles 100(a) and 56 EPC 1973). The opposition division rejected the opposition on the ground that the claimed subject-matter involved an inventive step. In its statement of grounds of appeal, the appellant (opponent) based the appeal on the ground of lack of novelty (Article 100(a) and 54(1) EPC 1973), which, however, was not a ground for opposition in first instance proceedings and therefore a new ground for opposition. The board's decision is summarised in the Headnote as follows: "An appeal unconnected with the reasons given in the appealed decision (lack of inventive step) and directed only to a new ground for opposition (lack of novelty) based on a new document is contrary to the principles laid down in decisions G 9/91 and G 10/91, according to which an appeal should be within the same legal and factual framework as the opposition proceedings. It is tantamount to a new opposition and is thus inadmissible." In the present case, however, the objections (lack of novelty and lack of inventive step) raised by the appellant correspond to the grounds on which the opposition was based in the notice of opposition.

- 3.8 It follows from the above that the statement of grounds of appeal fulfils the requirements of Article 108, third sentence, EPC 1973. Thus the appeal is admissible.

4. Admissibility of D5

- 4.1 The respondent requested that document D5 should not be admitted into the appeal proceedings since it was filed long after the expiry of the period for filing an opposition and it would take a substantial effort on the part of the patentee and of the board to determine whether or not D5 is *prima facie* relevant.

According to Article 12(2) RPBA, the statement of grounds of appeal shall contain a party's complete case. Article 12(4) RPBA requires the board to take into account everything presented by the parties under Article 12(1) RPBA if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA. However, according to Article 12(4) RPBA, the board has the discretionary power to hold inadmissible facts, evidence and requests which could have been presented or were not admitted in the first instance proceedings.

The board is of the opinion that an opponent who files an appeal against the decision of the opposition division can only properly challenge that decision by setting out his complete case in the statement of grounds of appeal if in principle this also includes the filing of further evidence in support of a ground for opposition which was dealt with in the reasons of the appealed decision but which did not, however, succeed on the basis of the prior art on file. This view is consistent with the provisions of Article 12(4) RPBA, according to which evidence filed with the statement of grounds of appeal has to be taken into

account by the board, unless the board makes use of its discretionary power to hold this evidence inadmissible.

In the present case the appellant filed D5 with the statement of grounds of appeal and in reaction to the reasons of the decision under appeal, according to which the opposition division rejected the opposition because it arrived at a conclusion adverse to the appellant on the basis of the prior art then on file. The board found D5 *prima facie* relevant in that the statement of grounds of appeal made it clear that D5 related to the same technical problem and to the features which were identified by the opposition division as being not disclosed in D1. Moreover, nothing in the file indicates that D5 could have been filed earlier. Therefore, the board did not make use of its discretionary power pursuant to Article 12(4) RPBA and admitted D5 into appeal proceedings.

5. Novelty

5.1 In the following, references to text passages relate to the English translation of D5. The correctness of this translation was not questioned by the respondent.

5.2 The appellant's technical analysis of D5 as set out in the statement of grounds of appeal was not contested by the respondent. This analysis was complemented by arguments presented during the oral proceedings. The following points, which may be considered as a summary of this analysis, were decisive for the board's decision on novelty.

5.3 D5 (see e.g. claim 1) discloses a printing system (copying machine) for printing objects of different object types ("character" or "gradation image") on the same page of a document ("original picture image"), comprising:

means for determining the object types to be printed on a single page; this is achieved by automatic image area recognition and by dividing the image into "image areas" of different types, for instance a "character area" and a "gradation image area" (see page 1 and page 8, lines 7 to 20);

a printer control device including a user interface (a display screen of a console unit) comprising an option for independently controlling two or more different print quality characteristics ("processing parameters"; see page 25, lines 9 to 17 and page 27, lines 16 to 21; see also the buttons 123 to 128 in figure 24 and page 86, lines 5 to 14) based on the determined type of object to be printed (see figures 25(a) and 25(b) and page 87, lines 4 to 16).

The user interface allows the user to control manually and independently the two or more print quality characteristics, in order to override settings determined automatically (the "initially set parameter[s]"). It therefore includes an option for selecting between automatic and manual control of the two or more print quality characteristics (see for instance the sentence bridging pages 9 and 10; and page 27, lines 3 to 21).

5.4 In conclusion, D5 discloses a printing system comprising all the features of claim 1 of the patent as maintained by the opposition division. The subject-matter of claim 1 thus lacks novelty over D5 and is not patentable within the terms of Article 54(1),(2) EPC 1973.

6. As a result, the patent must be revoked (Article 101(3)(b) EPC).

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