

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen  
(D) [ ] No distribution

**Datasheet for the decision  
of 10 May 2011**

**Case Number:** T 1707/07 - 3.5.04

**Application Number:** 02007148.6

**Publication Number:** 1246453

**IPC:** H04N 5/217

**Language of the proceedings:** EN

**Title of invention:**

Signal processing apparatus and method, and image sensing apparatus

**Applicant:**

CANON KABUSHIKI KAISHA

**Opponent:**

-

**Headword:**

-

**Relevant legal provisions:**

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

**Relevant legal provisions (EPC 1973):**

EPC Art. 108, 113(1), 113(2)

EPC R. 65(1), 71(2), 86(3)

**Keyword:**

"Form of appeal - grounds - substantiation (no)"

**Decisions cited:**

G 0007/93, T 0162/97, J 0022/86, J 0010/07

**Catchword:**

-



Case Number: T 1707/07 - 3.5.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.04  
of 10 May 2011

**Appellant:**

CANON KABUSHIKI KAISHA  
3-30-2 Shimomaruko  
Ohta-ku  
Tokyo 146 (JP)

**Representative:**

TBK  
Bavariaring 4-6  
D-80336 München (DE)

**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 4 May 2007  
refusing European patent application  
No. 02007148.6 pursuant to Article 97(1) EPC  
1973.

**Composition of the Board:**

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

## **Summary of Facts and Submissions**

- I. The appeal is directed against the decision to refuse European patent application No. 02 007 148.6 posted on 4 May 2007.
  
- II. In the communication annexed to the summons to attend oral proceedings dated 30 January 2006 the examining division raised objections of added subject-matter and lack of inventive step with regard to the claims of the sole request then on file.
  
- III. With a letter of 17 August 2006 the applicant filed a new request which replaced the former request.
  
- IV. In oral proceedings before the examining division on 19 September 2006, the chairman informed the applicant that the main request then on file was not regarded as acceptable, mainly because of lack of inventive step and lack of clarity. The applicant filed an auxiliary request, which was amended in the course of the oral proceedings. The chairman announced at the end of the oral proceedings that the examining division intended to propose the grant of a patent on the basis of the amended auxiliary request as filed in the oral proceedings, after being provided with a clean version thereof. He also added that, after closing the oral proceedings, the examining division would not allow any further substantive amendments. With the notification of the minutes the applicant was given a period of two months to file a clean version of the claims of the auxiliary request.

V. With a letter dated 12 December 2006 the applicant filed a set of "new claims 1 to 9 replacing the hitherto valid claims ... upon which the further prosecution of the application" should be based (page 1, second paragraph of the letter), and "requested to admit the new claims to the proceedings, and to hold out the prospect of grant of a patent on the basis of the new claims 1 to 9" (page 4, last paragraph of the letter).

VI. The examining division then refused the patent application, on the grounds that there was no text of the application which had been agreed by the applicant and allowed by the examining division (Article 113(2) EPC 1973). The reasons for refusing consent to the amendments and why the examining division considered that this required no further communication are given in sections 9 and 10 of the decision under appeal and may be summarised as follows.

The claims filed with the letter dated 12 December 2006 are an amended version of the main request and not a clean version of the amended auxiliary request filed in oral proceedings. These amendments do not include the features of the amended auxiliary request, which were regarded in the oral proceedings as inventive (see the amended auxiliary request, page 2/4, lines 12 to 20), nor the features overcoming the clarity objections (see the amended auxiliary request, page 2/4, lines 12 to 20). Thus they reintroduce deficiencies previously pointed out to and removed by the applicant. The examining division, using its power of discretion under Rule 86(3) EPC 1973, does not allow the set of amended claims and considers it inappropriate to send a further

communication, given that the applicant had already been informed about the refusal of consent.

- VII. With the statement of grounds of appeal the appellant filed amended claims according to a main request and an auxiliary request, as well as amended description pages and an amended Figure 1. He submitted that the claims of the main request were allowable under Rule 86(3) EPC 1973 since they overcame the deficiencies pointed out e.g. in the summons to oral proceedings before the examining division. The appellant indicated the basis for the amended and, in his view, clarified claims of the main and auxiliary requests in the initial disclosure and provided reasons as to why their subject-matter involved an inventive step over the prior art cited in the first-instance proceedings.
- VIII. In a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal of the European Patent Office (RPBA, OJ EPO 2007, 536) annexed to the summons to oral proceedings, the board raised the question of the admissibility of the appeal. It noted that it could not see that the appellant addressed the decision under appeal by providing reasons as to why the refusal was wrong. In particular, no reason was given as to why, in the given circumstances of the present case, the division had not exercised its discretion under Rule 86(3) EPC 1973 in accordance with the right principles. The board further noted that it could also not see that the amendments to the claims filed with the statement of grounds of appeal overcame the reasons for the refusal.

IX. In a reply dated 7 April 2011 the appellant filed a clean version of the claims acknowledged as allowable by the examining division and withdrew the request for oral proceedings and instead requested a decision on the file as it currently stood. The appellant provided the following further explanations.

The appellant had expected appealable reasons why the main request could not be allowed in the framework of the final decision of the examining division. Besides, the auxiliary request already acknowledged as being allowable had never been withdrawn. Thus, an official communication under Rule 51(4) EPC 1973 indicating the intended grant on the basis of that auxiliary request had been expected, together with the reasons indicating the non-allowability of the main request.

However, unexpectedly, neither an official communication under Rule 51(4) EPC 1973 nor a decision showing any reasons for refusing the main request was issued. This explained why the applicant had tried to reach an allowable claim version, by filing new claims closer to what he deemed allowable. The appellant expressed doubts as to the correctness of the examining division's course of action and as to whether this constituted a substantial procedural violation.

X. The board held oral proceedings on 10 May 2011 in the absence of the duly summoned appellant who, during a phone conversation on the same day, had informed the registrar of the board before oral proceedings started that nobody would attend oral proceedings on its behalf.

## Reasons for the Decision

1. The present decision was taken after the entry into force of the revised European Patent Convention (EPC). At that time, the present application was already pending. 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. 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, 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).
3. 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 on 13 December 2007 (see also J 10/07, OJ EPO 2008, 567, Reasons, point 1).

4. Article 108, third sentence, EPC 1973 provides that a statement setting out the grounds of appeal shall be filed within four months of notification of the decision. It is an established general principle that the statement 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).

The examination of whether the requirements of Article 108, third sentence, EPC 1973 are met has to be made on the basis of the statement of grounds of appeal and of the reasons given in the contested decision (see for example J 22/86, OJ EPO 1987, 280, Reasons, point 2; T 162/97, reasons, point 1.1.2), taking into account any amendments made to the claims.

5. In the present case the examining division exercised its discretion as provided for in Rule 86(3) EPC 1973 and did not consent to the amendments to the claims as filed with the letter dated 12 December 2006. Since these claims were declared by the applicant to replace the hitherto valid claims (see point V above), the application was refused, for the reason that there was no text of the application which had been agreed by the applicant, as required by Article 113(2) EPC 1973, and



which had obtained the examining division's consent under Rule 86(3) EPC 1973.

6. In decision G 7/93 (OJ EPO 1994, 775, Reasons, point 2.6) the Enlarged Board of Appeal stated that if an examining division has exercised its discretion under Rule 86(3) EPC 1973 against an applicant in a particular case and the applicant files an appeal against the way in which such discretion was exercised, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the first-instance department, in order to decide whether or not it would have exercised such discretion in the same way as the first-instance department. The Enlarged Board of Appeal added that if a first-instance department is required under the EPC to exercise its discretion in certain circumstances, such a department should have a certain degree of freedom when exercising that discretion, without interference from the boards of appeal and that a board of appeal should only overrule the way in which a first-instance department has exercised its discretion if it comes to the conclusion either that the first-instance department in its decision has not exercised its discretion in accordance with the right principles, or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion.

7. The appellant explained in the statement of grounds of appeal that the claims according to the main request filed with that statement were allowable within the meaning of Rule 86(3) EPC 1973 since they overcame the deficiencies pointed out e.g. in the summons to oral

proceedings before the examining division. The appellant also explained that the claims according to the main and auxiliary requests filed with that statement were clarified and why the subject-matter of the claims of these requests involved an inventive step over the prior art.

8. The statement of grounds of appeal thus only deals with the deficiencies pointed out by the examining division in the first-instance proceedings (including the oral proceedings) but which, according to the appealed decision, were not the reasons for refusing the application. The statement does not address the issues of the reasoning of the decision under appeal since no reason is given as to why, in the given circumstances of the present case, the examining division did not exercise its discretion under Rule 86(3) EPC 1973 in accordance with the right principles or exercised its discretion in an unreasonable way, and thus exceeded the proper limits of its discretion.
9. The appellant also does not argue that the examining division was wrong in concluding that, as a consequence of the exercise of its discretion under Rule 86(3) EPC 1973, there remained no text of the claims submitted or agreed by the applicant (Article 113(2) EPC 1973).
10. As a result, the appellant does not provide in the statement of grounds of appeal any reasons as to why the refusal decision was alleged to be incorrect.
11. Furthermore, the claims according to the two requests filed with the statement of grounds of appeal do not correspond to the claims according to the amended

auxiliary request found in principle acceptable by the examining division. On the contrary, it is immediately apparent that claim 1 of these requests does not include the features of claim 1 of the amended auxiliary request (in particular the "optical black processor"; see annex to the minutes of the oral proceedings, page 2/4, lines 12 to 17) which are identified in the decision under appeal as essential for overcoming objections against the former main request, the omission of which is given as a reason for refusing to consent to the amendments under Rule 86(3) EPC 1973.

12. As a result, the mere fact of filing amended claims with the statement of grounds of appeal does not overcome the reasons for the refusal in the present case.
  
13. In conclusion, the appellant's case for setting aside the decision under appeal does not address the reasons given in the decision under appeal. From the submissions made in the statement of grounds of appeal it is thus not clear to the board why the decision under appeal is alleged to be incorrect. Nor is there anything in the reasoning of the appealed decision that strikes the board as so flawed as to justify a review.
  
14. In the reply to the board's communication under Article 15(1) RPBA dated 7 April 2011 and, therefore, after expiry of the time limit for filing the statement of grounds according to Article 108, third sentence, EPC 1973, the appellant does not argue as to why the statement of grounds of appeal sets out in a sufficiently clear manner why the decision under appeal

is incorrect. Nor does the appellant provide any arguments as to why the amended claims filed with the statement overcome the reasons for the refusal in the present case. Instead, the appellant submits for the first time legal and factual reasons as to why the decision under appeal based on Rule 86(3) EPC 1973 should be set aside.

15. In view of Article 113(1) EPC 1973, an appellant's arguments as to why the statement of grounds of appeal was not deficient have to be considered by the board even if they are provided after expiry of the time limit for filing the statement of grounds of appeal according to Article 108, third sentence, EPC 1973. However, if a statement of grounds of appeal does not comply with the requirements of Article 108, third sentence, EPC 1973, any deficiency has to be remedied within the period of four months specified in the afore-mentioned provision. Therefore, the board does not consider new legal and factual reasons as to why the decision under appeal should be set aside if they are filed after expiry of the period specified in Article 108, third sentence, EPC 1973. As a result, the appellant's submissions filed with the reply dated 7 April 2011 are not relevant for deciding on the admissibility of the present appeal. The same applies to the clean version of the claims acknowledged as allowable by the examining division which was filed with the afore-mentioned reply.

16. It follows from the above that the present statement of grounds of appeal does not fulfil the requirements of Article 108, third sentence, EPC 1973. Thus the board

must reject the appeal as inadmissible pursuant to  
Rule 65(1) EPC 1973.

**Order**

**For these reasons it is decided that:**

The appeal is rejected as inadmissible.

The Registrar

The Chairman

D. Meyfarth

F. Edlinger