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**Datasheet for the decision
of 21 December 2010**

Case Number: T 1905/07 - 3.5.04

Application Number: 05253309.8

Publication Number: 1601180

IPC: H04N 1/03

Language of the proceedings: EN

Title of invention:
Image reading device

Applicant:
Brother Kogyo Kabushiki Kaisha

Opponent:
-

Headword:
-

Relevant legal provisions:
RPBA Art. 11

Relevant legal provisions (EPC 1973):
EPC Art. 113(1)
EPC R. 67

Keyword:
"Right to be heard - opportunity to comment (no)"
"Remittal to the examining division (yes)"
"Reimbursement of appeal fee (yes)"

Decisions cited:
-

Catchword:
-



Case Number: T 1905/07 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 21 December 2010

Appellant: Brother Kogyo Kabushiki Kaisha
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 27 June 2007
refusing European patent application
No. 05253309.8 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: F. Edlinger
Members: A. Dumont
B. Müller

Summary of Facts and Submissions

I. The appeal is directed against the decision by the examining division to refuse European patent application No. 05 253 309.8, published as EP 1 601 180 A1.

II. In a first communication dated 12 June 2006, the examining division raised objections under Articles 54 and 56 EPC 1973, *inter alia* in view of the prior art documents:

D1: EP 1 220 527 A2 and

D4: US 5,764,384 A.

The examining division expressly identified D1 as the most relevant state of the art, which rendered the subject-matter of the independent claims then on file not new. The division also considered that the subject-matter of *inter alia* dependent claims 12 and 13 could be found in D4 and that applying these features to the apparatus of D1 was obvious. The division further required the applicant to acknowledge D1 and D4 in the description in order to comply with Rule 27(1)(b) EPC 1973.

III. In the reply to the first communication the appellant filed amended pages of the description, acknowledging D1 and D4, and a set of amended claims.

IV. In an annex to the summons to attend oral proceedings on 10 May 2007, the examining division found that the subject-matter of amended claim 1 was not inventive in view of D1 and further noted that all the objections

concerning novelty and inventive step set out in the previous communication were maintained for the dependent claims.

- V. With a reply dated 5 April 2007 the applicant filed claims according to a main request and proposed adding further features according to two auxiliary requests. Amended claim 1 according to the main request was declared to be based at least partly on a combination of original claims 1, 12 and 13. The applicant argued that the subject-matter of the amended claims was not obvious in view of a combination of D4 with D1. He offered to discuss the application by telephone in order to either avoid the need for oral proceedings or at least help facilitate those oral proceedings.
- VI. In an email dated 8 May 2007 sent in reaction to a telephone call made by the first examiner on the same day, the applicant informally submitted a proposal for claim 1 and explained the general concept of the invention and the amendments in claim 1.
- VII. According to the minutes of a telephone conversation on 9 May 2007 which were notified by a communication dated 27 June 2007, *inter alia* novelty with respect to the disclosure of D1 was discussed. The first examiner further explained that rotating by 180 degrees the arrangement according to figures 1 and 2 of D4 would lead to an arrangement very similar to that of claim 1 (as filed with letter dated 5 April 2007), except for the provision of a rotatable upper cover. This difference was only an obvious design option requiring no inventiveness. The representative announced that he did not expect to come to the oral proceedings but

would file new submissions to be considered during the proceedings. The first examiner reminded him that, in order to be considered by the division, those submissions should be sent using the official fax number before the opening of the oral proceedings.

VIII. In a further letter dated 9 May 2007 and filed by hand at the EPO in Munich on the same day, the applicant referred to the email of 8 May 2007 and the "discussions with the Examiner on 8 May 2007". He formally filed claim 1 according to a main request and according to first to third auxiliary requests and referred to the former first and second auxiliary requests as new fourth and fifth auxiliary requests. He argued why the teaching of D1 would not suggest a combination leading to the invention with all its advantages. He further stressed that the examining division was not required to reach a decision at the end of the oral proceedings.

IX. The examining division held oral proceedings on 10 May 2007. Nobody appeared for the applicant. According to the minutes of these proceedings, the examining division had checked whether new requests had arrived prior to the oral proceedings and had found none. The examining division decided during these oral proceedings that the main request and the first and second auxiliary requests filed with the letter of 5 April 2007 were not allowable. The patent application was accordingly refused.

X. In the written decision the examining division mentioned that "[t]he submissions filed by hand (thus not via the official fax number) with letter dated

09.05.2007 reached the Examining Division four days after the Oral Proceedings. Therefore, these late filed submissions were not considered."

- XI. With the statement of grounds of appeal, the appellant submitted *inter alia* a copy of the email dated 8 May 2007 and referred to in the examination proceedings.
- XII. In a communication pursuant to Rule 100(2) EPC, the board expressed the preliminary opinion that fundamental deficiencies might be apparent in the proceedings before the examining division, in particular a violation of the right to be heard regarding the reasoning based on D4 in the decision under appeal, which could justify a remittal to the examining division and the reimbursement of the appeal fee.
- XIII. In a letter dated 25 March 2008, the appellant asked, as a main request, that the case be remitted to the department of first instance and that the appeal fee be reimbursed.
- XIV. Claim 1 according to the main request as refused reads as follows:

"An image reading device configured to read an image formed on a document being fed, comprising:
a main body (15);
an upper cover (19) covering the top of the main body (15), the upper cover (19) being rotatable about a supporting point on the main body (15) so as to be openable and closable with respect to the main body

(15), a feeding path for the document being defined between the upper cover (19) and the main body (15); an image reading unit (11) supported on the main body (15) and configured to read the image formed on the document;

a document holder (21) provided on the upper cover (19) and placed to face the image reading unit (11) so as to hold the document being fed between the image reading unit (11) and the document holder (21); **characterized in that:**

the document holder (21) is formed on a lower face of the upper cover (19) and is not moveable with respect to the upper cover (19); the image reading device further comprising:

a supporting mechanism (13) which supports the image reading unit (11) configured to be movable toward the document holder (21); and

a biasing unit (17) configured to bias the image reading unit (11) toward the document holder (21)."

XV. The reasoning relating to D4 in section 3 of the first communication of the examining division dated 12 June 2006 may be summarised as follows:

An upper cover covering the top of a main body and being openable and closable with respect to the main body is known from D4 (see column 3, lines 1 to 5). It would be obvious for the skilled person to combine this feature with those of the apparatus according to D1.

XVI. The reasoning based on D4 during the telephone conversation on 9 May 2007 may be summarised as follows, according to the minutes of the conversation:

When rotating the arrangement according to figures 1 and 2 of D4 by 180 degrees, an arrangement very similar to that of claim 1 of the present application is obtained. As a difference, instead of being rotatable, the upper cover of D4 is moved in parallel away from the main body. This is only an obvious design option requiring no inventiveness.

XVII. The argumentation for lack of inventive step in the decision under appeal for claim 1 of the main request may be summarised as follows:

D4 represents the closest prior art and discloses an image reading device according to claim 1 comprising an upper cover when the device in figure 1 of D4 is rotated by 180 degrees. The claimed device differs in that:

- the upper cover is rotatable about a supporting point on the main body;
- the document holder is not moveable with respect to the upper cover;
- a supporting mechanism supports the image reading unit and is configured to be movable toward the document holder; and
- a biasing unit is configured to bias the image reading unit toward the document holder.

The subject-matter of claim 1 including these differences resulted from choices between several straightforward possibilities.

XVIII. The appellant's arguments relating to D4 may be summarised as follows:

It was the appellant's understanding that D4 was used by the examining division as evidence only for claims 12 to 15 as originally filed, in particular for the movement of the upper cover with respect to the main body, and that D4 would be used in combination with D1 for assessing inventive step. However the decision was based on D4 alone.

Starting from D4 and formulating the technical problem of reducing the size of the upper cover, there is no suggestion or motivation in the prior art to arrive at the solution according to the present invention, even when looking at the figures of D4 upside down (for which the examining division provided no justification).

Reasons for the Decision

1. The appeal is admissible.
2. The right to be heard (Article 113(1) EPC 1973)
 - 2.1 Claim 1 of the main request filed in response to the summons to oral proceedings, on which the decision under appeal was based, combines in particular features of claims 1, 12 and 13 as originally filed. D1 was expressly considered by the examining division to represent the most relevant state of the art, both in the first communication (see section 2.1 thereof) and in the summons to oral proceedings. D4 was considered relevant for additional features of the dependent claims 12 and 13. An inspection of the file up to the telephone conversation on 9 May 2007 shows that the

then applicant could expect a reasoning based on a combination of D1 with D4 substantially similar to that raised in the first communication, and had grounds to understand that D4 taken alone did not call inventive step into question.

2.2 However, the reasoning in the decision is based solely on D4, after the first examiner had outlined a new line of argumentation based on D4 alone for the first time in the telephone conversation on 9 May 2007.

2.3 The board is of the opinion that such an oral communication could in principle have allowed the then applicant to exercise the right to present comments enshrined in Article 113(1) EPC 1973, either orally (for instance in the oral proceedings foreseen on the next day) or in writing. However, it has to be borne in mind that presenting new grounds in a telephone conversation should not be equated with presenting the same grounds in formal oral proceedings or in a formal written communication. Firstly, mere verbal communication by telephone is more prone to misunderstandings, in particular when, as is the case here, no minutes of the essentials of the conversation were available to the representative before oral proceedings took place. Secondly, a party also has a right to be heard by the organ which takes the decision, i.e. the examining division in the present case. A telephone conversation with only one of the examiners of that division does not safeguard this right in the same way as oral proceedings. Therefore caution is required when there is insufficient time for the party to present comments on new grounds presented only in a telephone conversation. Whether or not a party's

fundamental right to be heard was infringed depends on the particular circumstances of the case.

2.4 Concerning the objections raised by the first examiner in the telephone conversation the day before the oral proceedings, the board relies on the account given in the minutes which has not been contested by the appellant.

2.5 The minutes indicate that the first examiner addressed during the telephone conversation one difference (the upper cover being rotatable about a supporting point) between the device of D4, when the arrangement according to figures 1 and 2 was rotated upside down, and the subject-matter of claim 1. He omitted to address the other differences identified in the decision under appeal (the document holder not being moveable with respect to the upper cover; and the supporting mechanism for the image reading unit being movable toward the document holder, with the biasing unit biasing the image reading unit toward the document holder).

These further differences contribute to reducing the size of the upper cover, which was identified as the problem to be solved (see for instance paragraphs [0004] to [0006] in the present application as published, and the argumentation by the then applicant in the letter of 5 April 2007). They are therefore clearly essential for the assessment of inventive step and they needed to be dealt with in order to provide a complete reasoning.

As a result, the first examiner provided during the telephone conversation a new line of argumentation

based on facts derived from D4 alone which did not deal with a number of features of claim 1, which were essential for the assessment of inventive step. The reasoning was thus deficient in essential aspects and it did not allow the then applicant to present comments on the essential reasoning later set out in the decision under appeal.

2.6 In the letter of 9 May 2007 filed in direct reaction to the telephone conversation, the applicant concentrated on D1 and did not hold D4 so relevant as to call for a separate argumentation. The appellant further mentioned in the statement of grounds of appeal that his understanding then was that D4 would be relevant in combination with D1.

2.7 The board notes that the applicant deliberately chose not to attend the oral proceedings on 10 May 2007. He also repeatedly expressed in writing the wish to avoid the need for oral proceedings. Procedural economy and legal certainty for third parties require that an applicant should not be allowed in this way to prevent an examining division from carrying out the examination in an efficient manner, for instance by delaying the decision or postponing the oral proceedings (see also Rule 71(2) EPC 1973). The same applies to the last-minute filing of amendments. However, the circumstances of the present case are exceptional, because the examining division changed essential facts of the case on which it relied in the decision one day before oral proceedings and, more importantly, this reasoning was deficient.

2.8 From the above, the board is convinced that not all the essentials of the line of argumentation followed in the decision under appeal were communicated to the applicant before that decision was taken. As a result, the decision was based on grounds on which the applicant had no opportunity to present comments, contrary to Article 113(1) EPC 1973. This deficiency amounts to a substantial procedural violation.

3. The decision under appeal (see page 1, last paragraph) mentions that the new requests filed on 9 May 2007 by the applicant reached the Office one day before the oral proceedings but reached the examining division four days after the oral proceedings, so that the decision in the oral proceedings was based on superseded previous requests. The division therefore did not decide upon the application in the text submitted to it or agreed by the applicant. Whether or not in this respect the decision under appeal was contrary to Article 113(2) EPC 1973 can remain an open question. Likewise, what the consequences are of the examining division noticing the mistake and deciding not to grant interlocutory revision pursuant to Article 109(1) EPC 1973 need not be decided in the present case.

4. Remittal

4.1 According to Article 11 of the Rules of Procedure of the Boards of Appeal (OJ EPO 2007, 536), the board shall remit the case to the first instance if fundamental deficiencies are apparent in the first instance proceedings. The foregoing procedural violation constitutes such a fundamental deficiency.

4.2 As a result, since the board sees no special reason for doing otherwise, it allows the appellant's request that the case be remitted to the department of first instance.

5. Reimbursement of the appeal fee

Where a substantial procedural violation has occurred as a consequence of a denial of the right to be heard, as in the present case (see point 2.8 above), and where the need for appeal proceedings has arisen from such a violation, the board, in principle, considers reimbursement of the appeal fee in accordance with Rule 67 EPC 1973 to be equitable. In the present case, this board sees no exceptional situation requiring a departure from that principle.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance.
3. The appeal fee is reimbursed.

The Registrar

The Chairman

L. Fernández Gómez

F. Edlinger