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**Datasheet for the decision  
of 28 March 2012**

**Case Number:** T 1188/08 - 3.5.06

**Application Number:** 98931770.6

**Publication Number:** 1002273

**IPC:** G06F 13/00, G06F 17/60

**Language of the proceedings:** EN

**Title of invention:**  
Electronic image processing system

**Applicant:**  
KDL Scan Designs LLC

**Headword:**  
Image processing system/KDL

**Relevant legal provisions:**  
EPC Art. 108  
EPC R. 101(1), 99(2)

**Keyword:**  
"Admissibility of the appeal (no)"

**Decisions cited:**  
T 0934/02, T 0220/83, T 0213/85, T 0095/10, T 0644/97,  
T 0382/96

**Catchword:**  
-



Case Number: T 1188/08 - 3.5.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.06  
of 28 March 2012

**Appellant:** KDL Scan Designs LLC  
(Applicant) 160 Greentree Drive, Suite 101  
Dover, DE 19904 (US)

**Representative:** Small, Gary James  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 8 February 2008  
refusing European patent application  
No. 98931770.6 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** D. H. Rees  
**Members:** S. Krischer  
C. Heath

## Summary of Facts and Submissions

- I. European patent application 98931770 entitled "Electronic Image Processing System" was refused due to a lack of inventive step by written decision of the examining division dated 8 February 2008.
- II. Against the above decision, the applicant filed a notice of appeal on 31 March 2008 and paid the corresponding appeal fee.
- III. The grounds of appeal were filed on 9 June 2008. In light of the subsequent reasons for the decision, it is convenient to go into further detail regarding the grounds of appeal. After an introductory paragraph, the grounds of appeal read as follows:

"The Examiner, in the Decision to Refuse, maintains his position that the present claims lack inventive step over the cited art. Applicant disagrees. In particular Applicant submits that the claims include novel and inventive subject matter."

The following paragraphs of the grounds of appeal are quoted verbatim by comparing them with a letter of 19 October 2007 that the appellant submitted to the examining division, whereby the words from the letter that do not appear in the grounds are ~~struck through~~, while the words which are in the grounds but not in the letter are underlined:

"In the Examination Report the Examiner maintains his position that the claim check number of D1 is  
"adapted for use in retrieving the image data via a

browser running on a computer." Applicant submits, however, that the Examiner is improperly giving insufficient weight to the term "adapted for" in light of the specification. In particular Applicant submits that it cannot be said that a ~~claim check number, which is simply a number, alone~~ 'claim check number' is adapted for retrieving anything. A claim check number is simply a number. Moreover In addition, Applicant submits that the Examiner is improperly giving insufficient weight to the term "via a browser" in light of the specification. In Section 5 of D1, it states it is impossible to view the post card without first entering the claim check number [at their website]. A number alone entered into a browser, without the benefit of a web form for receiving the number, is not adapted for retrieving image data. ~~Browsers simply do not work that way~~ This is not the way Browsers work. The number is instead provided to a form on a web page by a user and the form is submitted for processing by the server. Accordingly, in D1, the combination of the form and the claim check number are needed together to be "adapted for use in retrieving the image data via a browser." However, the combination of the form and the claim check number together cannot be equated to the identifier defined in claim 1 because the identifier defined in claim 1 is included in the generated message ("generating a message including the identifier"). Applicant strongly contends that it cannot be held that D1 teaches providing the web form in the message to the recipient needed for submitting the claim check number. Applicant submits that the Examiner must view the entire claim as a whole, not only its individual elements.

In addition, Applicant further submits that document D1 discloses entering the claim check number in order to view a post card and ~~the applicant submits that the entering of the claim check number to retrieve the post card that this~~ teaches away from the requirement of claim 1 that the identifier be adapted to retrieve the image data via a browser. Since the claim check number must be entered as disclosed in document D1 it cannot be adapted to retrieve the image data via a browser as claimed in claim 1.

The method of claim 1 includes the element: "generating a message including the identifier". ~~Document D1 does not disclose generating a message including the identifier. As discussed above, applicant assumes the claim check number described in document D1 is cited as anticipating the identifier as claimed in claim 1. , and applicant submits that this is not disclosed in document D1 . Document D1~~ While document D1 discloses sending an email to the recipient that informs the recipient that a "postcard is waiting for her in our post office". ~~Document D1, and further discloses the ability of the user to "overwrite our standard email message or add some text of your own". Document, applicant submits that document D1 does not, however, disclose including the claim check number in the message sent to the recipient. Therefore, document D1 does not render claim 1 obvious.~~

~~Alternatively~~ In addition, while it is possible may be argued that the "file's new URL" (the answer to question 4 of document D1) might be considered to

disclose the identifier from amended claim 1. ~~Amended~~ , applicant notes that amended claim 1, ~~however,~~ recites: "sending the message to the address for the at least one recipient." In document D1 the file's URL, which is provided to the user for use in creating the postcard, is not included in a message that is sent to the address for the recipient whereby the recipient can receive the message containing the identifier. Indeed, at no point would the recipient even be aware of the URL in document D1, since it is only provided to the user for creating the postcard and the recipient only sees the finished postcard. Therefore, applicant submits that, should the Examiner seek to rely on the URL in document D1, claim 1 and those depending from it would nevertheless involve inventive step.

System claims 7-14 include analogous features and therefore include inventive step for at least the same reasons.

The amendments made to the specification are offered to advance the prosecution of the application and without disclaimer of abandonment of any subject matter that has been excluded by the amendments. Applicant submits that the amended claims overcome the Examiner's objections and looks forward to grant of the Application."

The grounds of appeal conclude with a request to confirm receipt.

IV. In the annex to the summons for oral proceedings, the board expressed its provisional view that the appeal

was inadmissible as to an insufficient reasoning of the grounds of appeal.

V. In its reply dated 28 February 2012, the appellant sets out why in its view the appeal contained sufficient grounds to be considered admissible. These arguments can be summarised as follows:

- "[T]he statement of grounds explicitly and selectively set out arguments which were put forth during the first instance proceedings."
- The reasons set out in the grounds of appeal were the same as those before the examining division because the decision under appeal was based on the same incorrect premise as the first examination report and the annex to the summons to which the appellant had responded with its letter of 19 October 2007.
- There was no requirement to submit new claims when filing grounds of appeal.
- It should be considered sufficient for the grounds of appeal to contain the legal and factual reasons for setting the decision aside.
- There was no need to mention section 3.4 of the decision under appeal, because the appellant had not argued inventive step based on this feature.
- The appellant's position was supported by decisions **T 644/97** and **T 382/96**, whereas the decision **T 95/10** was not applicable to the current case.

VI. In a further letter dated 20 March 2012, the appellant indicated that it would not be represented during oral proceedings scheduled to be held on 28 March 2012, and maintained its request for setting aside the decision

under appeal and granting a patent based on the main request filed with letter dated 19 October 2007, or with the first, second or third auxiliary request filed with letter dated 28 February 2012, respectively.

VII. Oral proceedings were held on 28 March 2012, at the end of which the subsequent decision was rendered.

### **Reasons for the Decision**

#### 1. *Admissibility of the appeal*

1.1 Under current case law, an appeal by the applicant or patentee is deemed sufficiently reasoned if, either, the applicant files new claims (decision **T 934/02**) or takes up the arguments set out in the decision under appeal and argues that these were incorrect. It is insufficient to merely refer to the arguments brought forward during the examination procedure (decisions **T 220/83** and **T 213/85**). Decision **T 95/10** identified three reasons for this. First, that the appeal procedure was no mere continuation of the examination procedure, but separate therefrom. Second, that in the same way as Article 114 EPC required the Patent Office to take into account the applicant's submissions prior to rendering a decision, the applicant had to take into account the arguments set out in the appealed decision when filing an appeal. Third, that otherwise, it was not sufficiently clear why the decision under appeal was deemed incorrect. Where the applicant in the grounds of appeal repeats its arguments set out during the examination phase without taking into account the decision under appeal, it mistakes the function of the



boards of appeal. The boards of appeal are not a second go of the examination procedure, but are meant to review decisions from the examining divisions. Such review requires the applicant to provide the board either with a new set of claims that deprives the decision under appeal of its basis, or to present an argumentative framework that, when adopted by the boards of appeal, would justify the decision under appeal to be set aside. The mere indication of an applicant that it considers the decision under appeal to be wrong and to invite the board to try again based on the same facts and arguments is insufficient. The above considerations do not apply, however, where the decision under appeal itself does not or insufficiently take into account the arguments presented by the applicant in the examination procedure, as in such case the applicant can indeed only repeat what has been argued before.

- 1.2 It is uncontested that no new claims have been filed with the grounds of appeal.
  
- 1.3 Apart from the introductory paragraph cited in section III above, the grounds of appeal are nearly literal copies of passages from the letter of reply to the examining division dated 19 October 2007. Moreover, the grounds reiterate substantially all the arguments relating to inventive step in that letter. The board thus fails to see any selection of arguments previously presented that could be regarded as arguments against the decision under appeal. Already the wording of the grounds of appeal indicates that they address the "Examination Report" and the "Examiner", and tellingly the last sentence reads: "Applicant submits that the

amended claims overcome the Examiner's objections...". There is no passage in the grounds of appeal providing arguments against the appealed decision. Neither are there arguments in the grounds referring to section 3.4 of the refusal, i.e. as to why it would not be obvious to a skilled person to use the third-party file transfer of the form-based file upload function of the HTML standard. From the grounds of appeal, it is clear that the appellant is unhappy with the appealed decision, but that much is already clear from the notice of appeal.

- 1.4 The appellant has argued that there was no need to address the decision under appeal because the decision under appeal was based on the same incorrect premise as the first examination report and the annex to the summons to which the appellant had responded with its letter of 19 October 2007. This would be relevant for the question of admissibility if indeed the examining division had failed to take into account the arguments submitted by the appellant in its letter of 19 October 2007 when rendering its decision. This letter contained arguments that have been mentioned above, and a new set of claims. In its decision to refuse that patent application, the examining division took into account the new set of claims, summarised the arguments brought forward by the appellant (section 3.5 of the decision under appeal) and explained over almost two pages why it found these arguments unconvincing (section 3.6). Thus, the decision under appeal indeed maintains the position set out in the examination report and in the annex to the summons, but is based on a set of claims different from the set of claims as filed, and further explains why the position taken by the applicant in its

letter dated 19 October 2007 is deemed unconvincing. It would thus have been the task of the appellant in the grounds of appeal to take into account those grounds of the decision under appeal that deal with the applicant's arguments, and provide reasons why the examining division was wrong. No such arguments have been provided, though. The appellant's argument that section 3.4 need not have been addressed may be true, but the point is that no section of the decision under appeal has been addressed at all.

1.5 Decision **T 644/97** cited by the appellant in order to support its position concerns the scope of appeal in terms of subject matter. In order to address the opposition division's decision, the opponent on appeal had, *inter alia* argued that "the decision under appeal had applied different and inconsistent criteria to the assessment of one and the same document", thereby clearly addressing the appealed decision rather than any previous report or communication. In the other decision cited by the appellant, **T 382/96**, (partial) admissibility of the appeal was discussed in light of some possibly inadmissible auxiliary requests filed with the appeal, while the main request was considered undoubtedly admissible.

1.6 The board therefore comes to the conclusion that the appeal is not sufficiently reasoned, contrary to Article 108 EPC, third sentence, in combination with Rules 101(1) and 99(2) EPC, and is therefore inadmissible.

2. As the appeal is held inadmissible, *no further issues* of substance have to be dealt with.

**Order**

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

The appeal is dismissed as inadmissible.

The Registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees