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**Datasheet for the decision  
of 27 July 2012**

**Case Number:** T 0206/09 - 3.5.05

**Application Number:** 02253065.3

**Publication Number:** 1259029

**IPC:** H04L 29/06, H04L 29/12,  
H04L 12/24, H04L 12/56

**Language of the proceedings:** EN

**Title of invention:**  
Network application gateway

**Applicant:**  
Canon Development Americas, Inc.

**Headword:**  
Gateway for mimicking legacy devices/CANON

**Relevant legal provisions:**  
EPC Art. 123(2)

**Keyword:**  
"Added subect-matter - No"  
"Remittal for further prosecution"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0206/09 - 3.5.05

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.05  
of 27 July 2012

**Appellant:** Canon Development Americas, Inc.  
(Applicant) 110 Innovation Drive  
Irvine  
California 92612 (US)

**Representative:** TBK  
Bavariaring 4-6  
D-80336 München (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 16 October 2008  
refusing European patent application  
No. 02253065.3 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** A. Ritzka  
**Members:** P. Cretaine  
D. Prietzel-Funk

## Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 02 253 065.3 published as EP 1 259 029. The decision was announced in oral proceedings held on 4 September 2008 and written reasons were dispatched on 16 October 2008.
- II. The decision under appeal was based on the **sole ground** that the claims did not meet the requirements of **Article 123(2) EPC**.
- III. The notice of appeal was submitted on 26 November 2008 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was submitted on 10 December 2008.
- IV. The appellant (applicant) requested that the decision under appeal be set aside and a patent be granted on the basis of claims 1 to 34 filed with the statement setting out the grounds of appeal. Oral proceedings were requested as auxiliary request. Moreover, the appellant indicated that, in case of any objections regarding claims 29 to 32, such claims might be cancelled and claims 33 and 34 should be renumbered.
- V. In a communication issued on 16 May 2012, the board expressed the opinion that the **Article 123(2) EPC** objection raised in the decision under appeal had been overcome and that the further amendments to claim 1 were based on the originally filed application documents. The board however expressed the preliminary opinion that dependent claim 32, and claims 33 and 34

when referring to 32, did not meet the requirements of **Article 123(2) EPC**. The board further informed the appellant that it was minded **to remit the case to the department of first instance for further prosecution**, provided claim 32 was deleted and claims 33 and 34 renumbered.

VI. With a letter received 12 June 2012, the appellant filed a new set of claims 1 to 33, replacing claims 1 to 34 of the previous request, for further prosecution. The appellant requested that the decision under appeal be set aside and maintained its request for oral proceedings only in the event that the board intended to dismiss the appeal.

VII. Claim 1 of the appellant's request reads as follows:

"A method for mimicking network devices, the method being performed in a computing device (20) having first and second network interface cards, the first network interface card (22) connecting the computing device (20) to an external network (10) and the second network interface card (21) connecting the computing device (20) to a local network (14), the method being characterized in comprising the steps of:

discovering each of a plurality of legacy network devices on the local network by listening to the local network for messages from the legacy network devices, and creating a target descriptor entry corresponding to each discovered legacy network device in a target descriptor table;

creating a rule corresponding to each target descriptor entry in an inbound rules table containing a plurality of rules, wherein each rule corresponds to

one of the plurality of legacy network devices on the local network and at least on rule indicates whether a functionality requested for a corresponding legacy network device to perform is to be processed by an application module residing in the computing device;

receiving, via the first network interface card, an incoming message from a client first network device (12) residing on the external network (10), the incoming message being addressed to a network address of a legacy network device (15, 16) residing on the local network (14);

determining if the incoming message requires a functionality provided by an application module (70, 71, 72) residing in the computing device (20), wherein the inbound rules table is used to determine if the functionality is to be processed by an application module residing in the computing device;

redirecting, in the case that the application module is configured to provide functionality, the incoming message to the application module which performs the required functionality in response to the incoming message; and

passing the incoming message through the local network (14) via the second network interface card to the legacy network device (15, 16) residing on the local network (14) in a case that the application module (70, 71, 72) is not configured to process the functionality."

The request comprises further independent claims seeking protection for a corresponding computing device (claim 32) and a corresponding computer program (claim 33).

## Reasons for the Decision

1. The appeal is admissible.
2. *Article 123(2) EPC*
  - 2.1 The decision under appeal was based on the **sole ground** that the claims did not meet the requirements of Article 123(2) EPC since some features, identified in paragraphs 1.1 and 1.2. of part II of said decision, did not have any support in the application as originally filed.
  - 2.2 The board notes however that the objected feature of "determining if an application module residing in the computing device is configured to process a functionality requested by the incoming message" was not present in claim 1 on which the decision was based but had been replaced by the feature of "determining if the incoming message requires a functionality provided by an application module residing in the computing device", as defined in the originally filed claim 1. The Article 123(2) EPC objection raised in the decision in respect of this feature is thus not valid. Present claim 1 also contains the above-mentioned originally filed feature, so that the formulation of the determining step complies with the provisions of Article 123(2) EPC.
  - 2.3 The wordings "first network device", "second network device", "target port identifier" and "target network printer", which were objected to in the decision under appeal, have been replaced in all present claims by the wordings used in the originally filed claims, i.e.

"client network device", "legacy network device", "legacy port identifier" and "legacy network printers", respectively. The wording "target network device", objected to in the decision under appeal, no longer appears in any of the present claims. The Article 123(2) EPC objection raised in the decision with respect to the above-mentioned wordings has thus been overcome.

- 2.4 The board is also satisfied that the further amendments to claim 1 are entirely based on the originally filed claims 4 to 7 and the corresponding passages of the originally filed description and thus do not contravene Article 123(2) EPC. Dependent claims 2 to 28 are based on the originally filed dependent claims, and dependent claims 29 to 31 are based on the passage from page 10, line 21 to page 11, line 23 of the originally filed description. Claims 32 and 33 are based on originally filed claims 34 and 35.

Therefore the board judges that the claims meet the requirements of Article 123(2) EPC.

3. *Remittal to the department of first instance*

The decision under appeal contained comments which were explicitly defined as not being part of the decision but as serving for a possible further prosecution (see section IV, "Comments", first sentence). In these comments (see last sentence), the examining division expressed the opinion that the subject-matter of the combination of claims 1 and 4-7 appeared to be new and inventive. The appellant, in the statement setting out the grounds of appeal and in the response to the board's communication, relied only on this last

sentence of the decision's comments and on a passage in a communication of the examining division dated 24 August 2004 (see page 4, first paragraph) to argue that the subject-matter of claim 1 according to the request on file was new and involved an inventive step.

The board however notes that these passages do not contain any substantial technical analysis of the differences between the subject-matter of the claims according to the appellant's request and the disclosure of the prior-art documents on file. Therefore the board considers it appropriate to remit the case to the department of first instance for further prosecution (Article 111(1) EPC), in particular with respect to novelty and inventive step issues, as already notified in paragraph 4 of the board's communication. Moreover, since the appellant's appeal is allowed, there is no need to consider its conditional request for oral proceedings.



**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 for further prosecution on the basis of:
  - claims 1 to 33 filed with letter of 12 June 2012;
  - description pages 1 to 7 filed with the statement setting out the grounds of appeal;
  - description pages 8 to 45 as originally filed;
  - drawings sheets 1/16 to 16/16 as originally filed.

The Registrar:

The Chair:

K. Götz

A. Ritzka