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Datasheet for the decision
of 10 November 2011

Case Number:	T 0556/09 - 3.2.05
Application Number:	99309442.4
Publication Number:	1004448
IPC:	B41J2/175
Language of the proceedings:	EN

Title of invention:
Printer and ink cartridge attached thereto

Applicant:
Seiko Epson Corporation

Opponent:
Pelikan Hardcopy Production AG

Headword:

Relevant legal provisions:
EPC Art. 54, 56, 112a(2)(d)
RPBA Art. 12, Art. 13
EPC R. 106

Keyword:
Novelty (main request - yes)
Inventive step (main request - no)
Admissibility of auxiliary requests 1 to 4 - no
Objection according to Article 112a(2)(d) EPC - dismissed

Decisions cited:
T 708/05, R 10/09

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: **T0556/09 - 3.2.05**

D E C I S I O N
of the Technical Board of Appeal 3.2.05
of 10 November 2011

Appellant: (Opponent)	Pelikan Hardcopy Production AG Gewerbestrasse 9 8132 Egg (SUISSE)
Representative:	Fähndrich, Martin Hogan Lovells International LLP Kennedydamm 24 40476 Düsseldorf (ALLEMAGNE)
Respondent: (Patent Proprietor)	Seiko Epson Corporation 4-1, Nishi-shinjuku 2-chome Shinjuku-ku Tokyo 163-0811 (JAPON)
Representative:	HOFFMANN EITLE Patent- und Rechtsanwälte Arabellastraße 4 81925 München (ALLEMAGNE)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 23 December 2008 rejecting the opposition filed against European patent No. 1004448 pursuant to Article 101(2) EPC, second sentence.**

Composition of the Board:

Chairman: W. Zellhuber
Members: S. Bridge
              A. Pignatelli

Summary of Facts and Submissions

I.   The appellant (opponent) lodged an appeal against the
        decision of the Opposition Division rejecting the
        opposition filed against the European patent
        No. 1 004 448.

        The Opposition Division held that the grounds for
        opposition submitted by the appellant under Article
        100(a) EPC (lack of novelty, Article 54 EPC, and lack
        of inventive step, Article 56 EPC) and Article 100(b)
        and (c) EPC did not prejudice the maintenance of the
        patent in suit as granted.

II.   Oral proceedings were held before the Board of Appeal
        on 10 November 2011.

III.   The appellant requested that the decision under appeal
        be set aside and European patent No. 1 004 448 be
        revoked. He further requested, that the auxiliary
        requests, filed on 10 October 2011, be rejected as late
        filed, and, if this request were rejected, that the
        oral proceedings then be adjourned.

IV.   The respondent (patent proprietor) requested that the
        appeal be dismissed, as main request, or, as an
        auxiliary measure, that the patent be maintained on the
        basis of one of the auxiliary requests 1 to 4, filed on
        10 October 2011. He further requested that the
        documents filed by the appellant on 9 and 10 November
        2011 be not admitted in the proceedings.

V.   Independent claim 1 of the patent as granted (main
        request) reads as follows:

"1. A printer (1), to which a cartridge (107) is
detachably attached, said cartridge (107) keeping ink
therein and having a rewritable non-volatile
memory (80), said printer (1) causing the ink kept in
said cartridge (107) to be transferred to a printing
medium (105), thereby implementing a printing
operation, said printer (1) being **characterised by**
comprising:

a printer memory (90) that stores information relating
to the ink kept in said cartridge (107) into a
predetermined area thereof in a predetermined format of
addressing, which is different from a specific format
of addressing adopted in said non-volatile memory (80);

a memory writing unit that reads the information
relating to the ink kept in said cartridge (107) from
the predetermined area and writes the read-out
information into a specific area of said non-volatile
memory (80), which corresponds to the predetermined
area of said printer memory (90) and

an address decoder that converts a storage format of
addressing of the information relating to the ink from
the predetermined format of addressing into the
specific format of addressing when said memory writing
unit writes the information."

VI. Respective claims 1 according to auxiliary requests 1
to 3 are identical and read as follows (the underlining
of the changes with respect to claim 1 according to the
main request was added by the Board):

"1. A printer (1), to which a cartridge (107) is
detachably attached, said cartridge (107) keeping ink
therein and having a rewritable non-volatile

memory (80) <u>carrying out transmission of data by serial access</u>, said printer (1) causing the ink kept in said cartridge (107) to be transferred to a printing medium (105), thereby implementing a printing operation, said printer (1) being characterised by comprising:

a printer memory (90<u>, 210</u>) that stores information relating to the ink kept in said cartridge (107) into a predetermined area thereof in a <u>parallel</u> format of addressing, which is different from a specific format of addressing adopted in said non-volatile memory (80);

a memory writing unit that reads the information relating to the ink kept in said cartridge (107) from the predetermined area and writes the read-out information into a specific area of said non-volatile memory (80), which corresponds to the predetermined area of said printer memory (90<u>, 210</u>) and

an address decoder that converts a storage format of addressing of the information relating to the ink from the <u>parallel</u> format of addressing <u>into a number of pulses of a clock signal constituting</u> the specific format of addressing when said memory writing unit writes the information."

VII. Claim 1 according to auxiliary request 4 differs from claim 1 according to auxiliary requests 1 to 3 in that, the term "*8-bit*" is inserted before both instances of the term "*parallel format of addressing*" and in that the term "*printer memory (90)*" is replaced by the term "*printer memory (90, 210)*" in both instances.

VIII. The following documents are referred to in the present
       decision:

       O7: JP-A-62-184856
       L8a: German translation of JP-A-62-184856 (document O7)
       L10: U.Tietze, Ch.Schenk, "Halbleiter-
            Schaltungstechnik", ISBN 3-540-56184-6, Zehnte
            Auflage; Springer-Verlag, 1993, cover pages, pages
            VIII to XIV, 270 to 301, 624 to 641, 676, 677 and
            704 to 707
       L17: WO-A-90/00974

IX.   The arguments of the appellant in the written and oral
       proceedings can be summarised as follows:

       Admissibility of document L17
       Document L17 could only be filed together with the
       grounds of appeal, because it was not available
       earlier. It contains clear indications that the printer
       memory SP is larger than the memory strip used on the
       ink cartridge and thus requires a different "*format of
       addressing*" than the latter. This document is thus
       relevant and should be admitted into the proceedings.

       Main request, novelty of the subject-matter of claim 1

       Document O7
       Document O7 discloses a printer as defined in claim 1
       of the patent in suit. In particular, according to
       document O7, data relating to the amount of ink
       remaining in the ink cartridge is stored in the
       memory 12 of the printer (translation L8a, page 5, last
       five lines to page 6, end of first paragraph). As that
       memory constitutes the printer memory and as the
       printer carries out various functions (see also
       translation L8a, page 6, second paragraph) the

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memory 12 in the printer is necessarily of a larger capacity than the memory 3 on the ink cartridge. A larger memory 12 requires a larger number of address bits so that its "*format of addressing*" thereby inevitably differs from that of a smaller memory 3 in the ink cartridge.

As was already noted in the grounds of appeal (page 7, point g), the otherwise undefined term "*format of addressing*" cannot just be interpreted narrowly in the light of the embodiment described in the patent specification, which only discloses converting parallel addressing into a particular kind of serial addressing.

Therefore, the subject-matter of claim 1 of the patent as granted (main request) lacks novelty with respect to the disclosure in document O7.

Document L17
The memory SP in the printer is larger than the memory on an ink cartridge, because it contains sufficient memory locations SP1 to SP5 for all ink cartridges (11, 12) and can also store the program for the printer controller (page 7, lines 1 to 10, figure 1). A larger memory requires a larger number of address bits so that its "*format of addressing*" thereby differs from that of a smaller memory used in an ink cartridge. It is thus implicit that the different memories SP and 14 require a conversion of their formats of addressing when writing to the memory 14 used in the ink cartridge (page 9, lines 25 to 34, figure 1).

Therefore, the subject-matter of claim 1 of the patent as granted (main request) lacks novelty with respect to the disclosure in document L17.

Main request, inventive step of the subject-matter of claim 1

Starting from the teaching of document O7, the skilled person is motivated to select different sized memories (see document L10, pages 277, 296 and 299) respectively for use in the printer and the ink cartridge and thus inevitably also has to provide an address decoder for converting their correspondingly different "*format of addressing*" and, in particular, between their differing number of address bits. The skilled person thus immediately arrives at the subject-matter of claim 1 of the patent as granted (main request) which therefore lacks an inventive step.

Auxiliary requests

Auxiliary requests 1 to 4 are late filed, concern issues already raised inter alia in the grounds of appeal (page 7, point g) and, thus, are not admissible under Articles 12 and 13 of the RPBA. Furthermore, the introduction of previously unclaimed features ("*parallel format of addressing*", "*8-bit*") from the description raises issues for which the appellant did not have enough time to prepare so that the oral proceedings would have to be adjourned. Moreover, these features are only disclosed in a specific context, thus raising questions with regards to the requirements of Article 123(2) EPC). For all of these reasons, auxiliary requests 1 to 4 should not be admitted into the proceedings.

Respondent's objection concerning an alleged procedural defect during the appeal proceedings (Article 112a(2) (d) EPC)

In accordance with decision T 708/05 (not published) a party must always be prepared for the fact that a board of appeal reverses a conclusion reached in a decision at first instance and the respondent should have taken appropriate steps, if so desired, in due time in order to respond to this possible outcome.

X.   The arguments of the respondent in the written and oral proceedings can be summarised as follows:

Admissibility of document L17
Document L17 could already have been submitted during the opposition proceedings and is thus late filed. The device of document L17 only involves counting emitted ink drops, does not calculate the amount of ink remaining in the ink cartridge and thus cannot write this amount into the memory on the cartridge: instead, the memory strip on the ink cartridge is merely erased one bit at a time. Document L17 is thus not relevant to the subject-matter of claim 1 of the patent as granted and should not be admitted into the proceedings at this late stage.

Main request, novelty of the subject-matter of claim 1

Document O7
This document is silent about the size of the printer memory 12 in comparison with the cartridge memory 3. Data other than the amount of ink remaining in the ink cartridge is not necessarily stored in the memory 12, but could, for example, be held in the subtraction unit 13. Furthermore, according to figures 3 and 4, the

memory 3 in the cartridge and the memory 12 in the
printer are connected via a bi-directional serial link
so that there is no need to convert the "*format of
addressing*". The non-standard term "*format of
addressing*" must be interpreted according to the patent
in suit where the embodiment set out in paragraph
[0099] (B1-publication) provides as an example the
conversion from the "*format of addressing*" (8 bits,
parallel) used in EEPROM 90 in the printer to a
different "*format of addressing*", that is, the number
of pulses of the clock signal CLK for the serial access
type of EEPROM 80 in the ink cartridge.

Document L17
It is not immediately and directly derivable from
document L17 that the counter values are actually read
out from the memory locations SP1 to SP5 in the printer
and provided to the TI-ASIC circuit for writing to the
ink cartridge memory. Document L17 only discloses that
resetting one of the counters SP1 to SP5 causes the TI-
ASIC to delete a bit in the corresponding ink cartridge
memory 17 (page 9, lines 25 to 30).

Therefore, the subject-matter of claim 1 of the patent
as granted (main request) is not immediately and
directly derivable from either one of documents O7
and L17 and is thus new.

*Main request, inventive step of the subject-matter of
claim 1*

Document O7 does not contain any indications concerning
differently sized memories in the printer and the ink
cartridge. There are also no indications concerning
different "*formats of addressing*" so that the skilled
person is therefore not motivated to introduce an

address decoder, particularly, as it is simpler not to have one. The effect of providing an address decoder according to the invention is to decrease the load on the print controller (patent as published, paragraph [100]).

The non-standard term "*format of addressing*" must be interpreted according to the patent in suit where the embodiment set out in paragraph [0099] (B1-publication) provides as an example the conversion from the "*format of addressing*" (8 bits, parallel) used in EEPROM 90 in the printer to a different "*format of addressing*", that is, the number of pulses of the clock signal CLK for the serial access type of EEPROM 80 in the ink cartridge. The skilled person would thus use his knowledge of the art to disregard any irrelevant specificity of the embodiment and thus identify converting "*formats of addressing*" with changes such as from parallel to serial addressing. "*Formats of addressing*" which merely involve a different number of address bits thus do not constitute different "*formats of addressing*" as exemplified in the patent in suit.

Therefore, the subject-matter of claim 1 of the patent as granted (main request) is not obvious when starting from document O7 and is thus based on an inventive step.

Auxiliary requests

Auxiliary requests 1 to 4 became necessary after the negative opinion in the annex to the summons to oral proceedings which considered document O7 as highly relevant. Thus, in these requests, the meaning of the term "*format of addressing*" has been further restricted based on the disclosure of paragraph [0096] of the

application as filed (published version). Furthermore, as this is the only detailed example provided in the description, it is obvious that nothing else could be intended so that one month is sufficient time for the other party to prepare a response. Auxiliary requests 1 to 4 should therefore be admitted into the proceedings.

Objection concerning an alleged procedural defect during the appeal proceedings (Article 112a(2)(d) EPC)

During the oral proceedings and after the Board had informed the parties of its conclusion not to admit auxiliary requests 1 to 4, the respondent made the following declaration verbatim:

"*An objection is raised in respect to the procedural defect of rejecting auxiliary requests in spite of the invitation to file amendments relevant to resolution of an issue to be discussed at the oral proceedings which was first communicated by the Board of Appeal in the annex to the summons to oral proceedings dated 9 August 2011 and which related to the construction of the main claim of the patent as granted and as maintained.*"

No further reasons were given concerning the nature of the alleged procedural defect.

Reasons for the Decision

1. Main request

1.1 Admissibility of document L17

Document L17 was filed by the appellant with its statement of grounds of appeal as a reaction to the decision of the Opposition Division, rejecting the opposition. The requirements of Article 12(2) RPBA to the effect that "*the statement of grounds of appeal … shall contain a party's complete case. They … should specify expressly all the facts, arguments and evidence relied on*" are thus met.

Document L17 (abstract, figure 1) concerns "c*ontainers (11, 12) for printing devices, … ink reservoirs [which] are fitted with an electronic storage device (14) in the form of a chip in which the information on the current level of the container … are stored. The level of the printing medium is detected via the central control system (16) of the printing device and transmitted to the chip*" and is thus, a priori, relevant to the subject-matter of the claim 1 of the main request.

For these reasons, document L17 is admitted into the appeal proceedings, Article 114 EPC and Article 12(2)(4) RPBA.

1.2 Novelty, claim 1, main request

1.2.1 Document O7
According to this document, the data relating to the amount of ink remaining in the ink cartridge and contained in its non-volatile memory 3 is read out and

written into the memory 12 of the printer
(translation L8a, page 5, last five lines and page 6,
first five lines). Document O7 is silent about the
format of addressing used for the memory 12 and also
does not discuss the relative capacity of the
memories 3 and 12. Although document O7 refers to other
data such as, amongst others, the amount of ink
consumed for one line of printing or the amount of ink
consumed for circulating the ink not used for printing
(translation L8a, page 6, line 5 to end of first
paragraph), these are not inevitably also stored in the
memory 12, but could, for example, also be held in the
subtraction unit 13. Thus, it is not possible to rule
out that the memory 12 of the printer is of same size
as the memory 3 of the ink cartridge and thus could,
furthermore, share the same "*format of addressing*".

In consequence, it is not directly and immediately
derivable from document O7 that the two memories 3
and 12 require a different "*format of addressing*".
Therefore, the subject-matter of claim 1 of the patent
as granted (main request) is new with respect to the
disclosure of document O7 (Article 54 EPC).

1.2.2 Document L17
       This document discloses that the EE-PROM memory SP in
       the printer has memory locations SP1 to SP5 which are
       configured as counters which reset once the maximum
       count value has been reached (page 7, lines 1 to 10,
       page 9, lines 17 to 25). Resetting one of the counters
       SP1 to SP5 causes the TI-ASIC to delete a bit in the
       corresponding ink cartridge memory 17 (page 9, lines 25
       to 30). It is thus not immediately and directly
       derivable from document L17 that the counter values are
       actually read out from the memory locations SP1 to SP5
       and provided to the TI-ASIC circuit for writing to the

ink cartridge memory, because the TI-ASIC only has to delete a bit in the ink cartridge memory. Therefore, the feature of claim 1 of the patent as granted (main request) that the information relating to the ink kept in said cartridge read-out from the memory in the printer is the information which is written into the memory in the ink cartridge is not immediately and directly derivable from document L17.

Document L17 (page 3, line 35 to page 4, line 4; page 9, lines 35 to 37) further discloses that it is impossible to re-program the memory on ink cartridge, so that this memory may be written but not rewritten: the feature "re*writable*" from the preamble of claim 1 of the patent as granted (main request) is thus not disclosed either.

Therefore, the subject-matter of claim 1 of the patent as granted (main request) is new with respect to the disclosure of document L17 (Article 54 EPC).

1.3   Inventive step, claim 1, main request

Document O7 forms the closest prior art. The subject-matter of claim 1 of the patent as granted (main request) differs therefrom in that the printer memory (90) and the rewritable non-volatile memory (80) in the ink cartridge each have a respective, different "*format of addressing*" and thus require an address decoder to carry out the necessary "*format of addressing*" conversion when writing the information relating to the ink kept in said cartridge into the ink cartridge memory (80).

Both RAM and EPROM memories, as used respectively in the printer and ink cartridge according to document O7

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(translation L8a, page 5, last paragraph, first
sentence; page 7, second paragraph, last sentence), are
available in a variety of different sizes
(document L10, page 277, table 11.8 static RAMs;
page 279, table 11.10 dynamic RAMs; page 299,
table 11.35 EPROMs; page 300, table 11.36 EEPROMs). The
person skilled in the art is motivated to use the
smallest memory necessary for storing information
(relating to the ink kept in the cartridge) on the
replaceable ink cartridge as this will contribute to
reducing costs, which is a known issue
(translation L8a, page 8, second paragraph). As
additional information has to be stored when
controlling the printer as a whole (translation L8a,
page 6, line 5 to end of second paragraph), the person
skilled in the art is also motivated to use an
accordingly larger memory in the printer.

A fundamental characteristic of a given memory is the
"*format of addressing*" required for data read/write
access and a larger memory necessarily requires a
larger number of address bits so that its "*format of
addressing*" thereby inevitably differs from that of a
smaller memory. Whenever data stored in a first memory
requiring a first "*format of addressing*" is to be
transferred into a second memory requiring a second
"*format of addressing*" which differs from the first
"*format of addressing*", converting between the
respective "*format of addressing*" is an unavoidable
necessity for the normal use of two such memories. For
this reason the skilled person will provide an address
decoder where necessary in the course of the normal
practice of his art.

Thus, the skilled person starting from the teaching of
document O7 has to choose appropriately sized memory

devices. This means using a relatively larger memory in the printer and relatively smaller memory in the cartridge so that he is confronted with the necessity of providing an address decoder to convert the different "*format of addressing*" resulting from the different number of address bits needed by the differently sized memories. Thus starting from the disclosure of document O7, the skilled person arrives at the subject-matter of claim 1 (main request) through the normal practice of his art without performing an inventive step.

It was argued on behalf of the respondent that the need to provide different numbers of address bits for different sized memories does not constitute a different "*format of addressing*", because the first embodiment of the patent in suit only provides an example of the meaning of the term "*format of addressing*" in terms of conversion from the "*format of addressing*" (8 bits, parallel) used in EEPROM 90 in the printer to a different "*format of addressing*", that is, the number of pulses of the clock signal CLK for the serial access type of EEPROM 80 in the ink cartridge (paragraph [0099], B1-publication).

The Board cannot accept this argument, because the term "*format of addressing*" is neither defined in claim 1 (main request) nor given a general definition in the patent as granted. Furthermore, as already pointed out in the response to the appeal (respondent's letter filed 21 September 2009, page 4, second paragraph) and further confirmed by the respondent during the oral proceedings, the first embodiment only constitutes a particular *example* of a "*format of addressing*" conversion and thus does not provide a basis for attributing a corresponding generic limitation to the

term "*format of addressing*" as used in claim 1 of the
main request (see also appellant's grounds of appeal,
filed 6 May 2009, page 7, point g). In particular,
there is no indication in the patent in suit that the
conversion from a parallel to a serial "*format of
addressing*" constitutes an essential feature of the
invention. Thus, in the absence of a more precise
definition in the patent in suit, the term "*format of
addressing*" also includes the number of bits required
for specifying an address.

It was further argued on behalf of the respondent that
the effect the control IC 200 carrying out the
conversion of the "*format of addressing*" is to decrease
the load on the controller 46 included in the print
controller 40 (patent as published, paragraph [0100]).
This argument cannot provide support for an inventive
step, because the subject-matter of claim 1 (main
request) neither refers to a controller, nor specifies
that the address decoder is necessarily separate from
such a controller.

In consequence, the subject-matter of claim 1 of the
patent as granted (main request) does not involve an
inventive step for the skilled person with respect to
the disclosure of document O7 (Article 56 EPC).

2.   Admissibility of auxiliary requests 1 to 4

2.1   Auxiliary requests 1 to 4 were filed on 10 October
        2011, one month before the oral proceedings before the
        Board and are thus late filed.

2.2   According to the respondent itself, the aim of the
        amendments in these requests is to overcome objections
        based on document O7 which is more that ten years in

the proceedings (see letter of 10 October 2011) and concern the meaning of the term "*format of addressing*".

The respondent's argument that auxiliary requests 1 to 4 were filed in response to issues raised by the Board in the annex to the summons to oral proceedings cannot be followed, because the Board did not raise any new issues: in particular, the appellant already argued in his notice of opposition filed 27 June 2007 (page 5, point 3c) and again in the grounds of appeal filed 06 May 2009 (point 6 on pages 5 to 7) that the term "*format of addressing*" can be understood to refer to the number of address bits required for addressing a memory. Therefore, the respondent must have been aware that the meaning of the term "*format of addressing*" was a subject of discussion not only since the beginning of the opposition proceedings but also again since the beginning of the appeal proceedings.

The Board does not accept that simply the fact that some of these objections were reiterated by the Board in a communication allows the respondent to deviate from the rules of procedure and amend his case: An appeal case to be decided only consists of the requests, evidence and arguments put forward by the parties. A communication from the Board which merely reiterates objections already put forward by the parties and sets out the Board's provisional opinion on some of these objections does not change the case to be decided: the provisional opinion of the Board is not part of the case, but merely a provisional opinion concerning the case. Thus, there is no valid reason for the respondent to wait until one month before the oral proceedings before the Board to file auxiliary requests addressing this issue.

Auxiliary requests 1 to 4, filed on 10 October 2011, thus are a response to issues raised by the appellant in his grounds of appeal, not a response to any directions of the Board under Article 12(1)(c) RPBA and constitute a late filed amendment to the respondent's case, because, according to Article 12(2) RPBA the statement of grounds of appeal **and the reply** shall contain a party's **complete case**. After having been confronted with the objections raised by the appellant, the respondent decided to defend its case on the basis of the patent in suit as granted.

2.3   Under Article 13 RPBA, a decision to admit or not to admit a request filed both after the filing of the reply and after oral proceedings have been arranged is at the discretion of the Board of Appeal (see also Enlarged Board of Appeal decision R 10/09, point 2.2, 1st and 3rd paragraphs). The criteria for the exercise of this discretion are the complexity of the new subject-matter, the current state of the proceedings, the need for procedural economy (Article 13(1) RPBA) and the fairness to the other party and the Board (Article 13(3) RPBA). Furthermore, in the annex to the summons to oral proceedings (point 7), the Board already drew the parties' attention to Articles 12 and 13 RPBA in that "*any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The criteria for exercise of discretion include inter alia whether or not there are good reasons for the late filing and whether or not the amendments and submissions are relevant to a resolution of the issues to be discussed at the oral proceedings*".

2.4   The respective claims 1 of auxiliary requests 1 to 4 have in common that the "*predetermined format of*

addressing" of the printer memory 90 in paragraphs 2 and 4 of the claim 1 as granted (main request) has been replaced to read "*parallel format of addressing*" (auxiliary requests 1 to 3), respectively "*8-bit parallel format of addressing*" (auxiliary request 4).

The only basis for this amendment in the patent as filed is the sentence "*The control IC 200 mounted on the carriage 101 carries out the conversion of the format of addressing (8 bits, parallel) in the EEPROM 90 of the printer main body 100 into a different format of addressing, that is, the number of pulses of the clock signal CLK*" (paragraph [0096], published version) which forms part of the description of the first embodiment (paragraphs [0096] to [0100], published version).

The introduction of features from the description which were not previously claimed creates a new case which could not have been anticipated at this late stage of the proceedings.

2.5   Furthermore, as there is no basis in the application as filed for isolating the "*parallel format of addressing*" from the remaining features of the first embodiment, there are serious reasons to believe that this amendment to the subject-matter of claim 1 (auxiliary requests 1 to 4) results in a previously undisclosed intermediate generalisation contrary to Article 123(2) EPC.

2.6   In addition, the appellant raised the question of the meaning of the term "*parallel format of addressing*" as this was not otherwise explained. Thus, the clarity of

the amendments would also require discussion
(Article 84 EPC).

2.7   The subject-matter of claim 1 (auxiliary requests 1
        to 4) is thus not prima facie allowable and it is thus
        already for that reason not conducive to a resolution
        of the issue of the lack of inventive step of the
        subject-matter of claim 1 according to the main
        request.

2.8   Furthermore, the introduction into respective claims 1
        of auxiliary requests 1 to 4 of the previously
        unclaimed feature "*parallel*" (format of addressing)
        from the description raises new issues which the
        appellant cannot be reasonably be expected to deal with
        without the adjournment of the oral proceedings as was
        requested by the appellant.

2.9   For all these reasons, the Board comes to the
        conclusion that the admission of auxiliary requests 1
        to 4 into the proceedings would not be conform to the
        need for procedural economy and to the principle of a
        fair conduct of the proceedings.

        The requests are therefore refused under Article 13(1)
        and (3) RPBA.

3.   Respondent's objection concerning an alleged procedural
        defect during the appeal proceedings (Article 112a(2)
        (d) EPC)

        After the rejection of its auxiliary requests, the
        respondent raised an objection under Article 112a(2)(d)
        EPC.

The respondent appears to consider that the alleged procedural defect consists in that the Board rejected the auxiliary requests in spite of a perceived invitation by the Board itself in its annex to the summons to oral proceedings to file amendments relevant to the resolution of an issue to be discussed at the oral proceedings.

The Board holds that the annex to the summons to oral proceedings before the Board did not contain any invitation to file any amendments in the sense of Article 12(1)(c) RPBA.

It only contained a reference to the relevant provisions of RPBA in case amendments were to be filed. These provision were cited almost verbatim.

The above interpretation of the party is thus void of any support in the text of the annex to the summons to oral proceedings.

In the absence of additional arguments from the respondent, its objection is dismissed in accordance with Rule 106 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:

D. Meyfarth   W. Zellhuber

Decision electronically authenticated