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**Datasheet for the decision  
of 26 September 2012**

**Case Number:** T 0573/09 - 3.5.04  
**Application Number:** 04734106.0  
**Publication Number:** 1631057  
**IPC:** H04N7/26, H04N7/30, H04N1/41  
**Language of the proceedings:** EN

**Title of invention:**

IMAGE PROCESSING DEVICE AND IMAGE PROCESSING PROGRAM

**Applicant:**

NIKON CORPORATION

**Headword:**

**Relevant legal provisions:**

EPC Art. 108, 113(2)  
EPC R. 71(3) (2007), 99(2), 101(1), 137(3) (2007)

**Keyword:**

Admissibility of appeal - appeal sufficiently substantiated  
(no)

**Decisions cited:**

G 7/93, J 22/86, T 220/83, T 162/97, T 177/97, T 717/01,  
T 934/02, T 1276/05

**Catchword:**

see point 2.5 of the reasons



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Case Number: T 0573/09 - 3.5.04

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.04**  
**of 26 September 2012**

**Appellant:** NIKON CORPORATION  
(Applicant) 12-1, Yurakucho 1-chome  
Chiyoda-ku  
Tokyo 100-8331 (JP)

**Representative:** Zeitler - Volpert - Kandlbinder  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 6 November 2008  
refusing European patent application No.  
04734106.0 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** R. Gerdes  
B. Müller

## Summary of Facts and Submissions

- I. The appeal is directed against the decision to refuse European patent application No. 04 734 106.0, published as EP 1 631 057 A1.
- II. In oral proceedings before the examining division on 13 February 2008, the applicant was informed that the claims of the sole request filed by a letter dated 21 December 2007 were not regarded as allowable because they lacked novelty and clarity. The applicant withdrew this request and requested grant of a patent on the basis of amended claims filed during the oral proceedings. The chairperson 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 claims as filed in the oral proceedings.
- III. On 12 March 2008 the examining division issued a communication according to Rule 71(3) EPC informing the applicant that it intended to grant a patent on the basis of the amended claims filed during the oral proceedings.
- IV. The applicant replied by a letter dated 7 July 2008 stating that "the applicant cannot accept the amendments made during the oral proceedings ..., such that the applicant cannot give his agreement on the text for grant". The applicant requested the examining division "to grant the patent on the basis of the claims and amendments dated December 21, 2007".
- V. The examining division refused consent to the amendments (Rule 137(3) EPC) and finally refused the patent application, on the grounds that there was no text of the application which had been agreed by the

applicant (Article 113(2) EPC 1973). The examining division's reasons for refusing consent to the amendments under Rule 137(3) EPC may be summarised as follows.

The examining division had provided arguments during the oral proceedings as to why the subject-matter of the request dated 21 December 2007 did not comply with the substantive requirements of the EPC. In reply to the communication under Rule 71(3) EPC the applicant wished to revert to that request. Consequently, the objections provided during the oral proceedings were still applicable. The examining division also stated that "the communication under Rule 71(3) EPC does not constitute an opportunity for the applicants to call into question the outcome of an earlier procedure which in this case is the oral proceedings held on 13 February 2008" (see point 2.1 of the decision under appeal).

- VI. With the statement of grounds of appeal the appellant filed an amended set of claims as his sole request. He submitted arguments as to why the amended claims were clear and involved an inventive step in view of the prior art cited in the first-instance proceedings.
  
- VII. In a communication according to Article 15(1) of the Rules of Procedure of the Boards of Appeal (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 had addressed the decision under appeal by providing reasons as to why the refusal should be set aside. The board further noted that the submissions and amendments made on appeal concerning lack of clarity could already have been made during the

examination proceedings in reply to the examining division's communication of 19 August 2008. Hence, if the appeal was found to be admissible, the admissibility of the amended claims would have to be discussed in the oral proceedings (Article 12(4) RPBA). If these preconditions were fulfilled, objections under Article 123(2) EPC and Article 84 EPC 1973 against the amended claims would have to be discussed.

- VIII. In a reply dated 30 August 2012 the appellant filed amended claims. The appellant stated that these claims should overcome the board's objections under Article 123(2) EPC and Article 84 EPC 1973 but did not comment on the issues of the admissibility of the appeal and the amended claims.
- IX. The board held oral proceedings on 26 September 2012. As announced beforehand, the appellant was not represented at the oral proceedings. The board noted that the appellant had requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the claims filed with the statement of grounds of appeal. The board further noted that, in response to its preliminary opinion, the appellant had filed a set of amended claims 1 to 5 with a letter of 30 August 2012. After deliberation by the board the chairman announced the decision that the appeal was rejected as inadmissible.

### **Reasons for the Decision**

1. Article 108, third sentence, EPC provides that within four months of notification of the decision a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations. According

to Rule 99(2) EPC, in the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based. An appeal which does not comply with this requirement shall be rejected as inadmissible (Rule 101(1) EPC).

- 1.1 If the appellant submits that the decision under appeal is incorrect, then the statement setting out the grounds of appeal must state the legal or factual reasons why the impugned decision should be set aside. The arguments must enable the board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases its arguments, without first having to make investigations of its own (cf. T 220/83, OJ EPO 1986, 249, point 4 and T 177/97, point 1; affirmed by numerous decisions).

Whether the requirements of Article 108, third sentence, EPC in conjunction with Rule 99(2) EPC are met has to be decided 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.

Exceptionally, it has been acknowledged that "the requirement for admissibility [laid down in Article 108 EPC 1973] may be regarded as satisfied if it is immediately apparent upon reading the decision under appeal and the written statement [of grounds] that the decision should be set aside" (see J 22/86, *ibid.*, Headnote I).

1.2 Different principles may apply if the appellant does not submit that the decision under appeal is incorrect but files new claims together with the statement of grounds. In this respect, T 934/02 (at point 2) provides the following summary of T 717/01:

"An appeal of the patent proprietor is to be considered sufficiently substantiated within the meaning of Article 108, third sentence, even though it does not state any specific reasons why the contested decision is wrong, if

(i) there is a change in the subject of the proceedings due to the filing of new claims together with the statement of grounds

(ii) the statement of grounds sets out in detail why the raised grounds for opposition do not prejudice the maintenance of the patent as amended on the basis of these new claims."

Relying on this stance, the board in T 934/02 (*ibid.*) saw no reason why the appellant (patent proprietor) in its appeal should be obliged to deal with the reasoning in the opposition division's decision when such reasoning no longer applied in view of the amended claims. An appeal might be substantiated by filing amended claims which deprived the contested decision of its basis. It was therefore not necessary, and would also be pointless, for the purposes of adequately substantiating an appeal, to file grounds in support of a version of a claim that the appellant (patent proprietor) was no longer defending in the appeal proceedings.

Analogously to the situation under point 1.1 where the appellant submits that the decision under appeal is incorrect, in the present board's view the requirement for admissibility may exceptionally also be regarded as satisfied where the appellant makes no such submission if it is immediately apparent upon reading the decision under appeal and the written statement of grounds that the decision should be set aside. In addition, there may be no need for explanation if - unusually - the amendments offered self-evidently overcome the grounds for the decision (see T 1276/05, point 1.2).

2. In the present case, the examining division did not refuse the application on the basis that the previous set of claims on file could not be allowed. The applicant had requested the grant of a patent on the basis of a set of claims to which the examining division had not given its consent under Rule 137(3) EPC. The application was therefore refused on the ground that the examining division, pursuant to Article 113(2) EPC 1973, was bound to decide on a text submitted to it. Thus the decision under appeal was based on the ground that there was no agreed set of claims. Implicitly this meant that a patent could not be granted (Article 97(1) EPC in conjunction with Article 78(1)(c) EPC 1973), and that the application consequently had to be refused (Article 97(2) EPC).
- 2.1 The statement of grounds of appeal does not give any reasons why the decision under appeal is thought to be incorrect, or discuss the absence of an agreed set of claims underlying it. The appellant does not dispute that there was no agreed set of claims and that, as a consequence, the examining division was entitled to refuse the application. Nor does the appellant dispute that the examining division was entitled to exercise



its discretion under Rule 137(3) EPC or that it had exercised this discretion in accordance with the right principles. Instead the statement of grounds of appeal gives arguments as to why the claims of the sole request filed with the statement of grounds of appeal are clear and why the subject-matter of these claims is both new and inventive in view of the prior art cited in the first-instance proceedings. Furthermore, the appellant did not comment on the issue of admissibility of the appeal raised by the board, in the communication annexed to the summons to oral proceedings, because the board could not see that the appellant, in the statement of grounds of appeal, had addressed the decision under appeal by providing reasons as to why the refusal should be set aside. Against this backdrop the board must conclude that the appellant does not dispute that the decision under appeal was correct.

- 2.2 It is also not apparent upon reading the decision under appeal and the written statement that the decision was so flawed that it should be set aside (see point 1.1 above). On the contrary, the board cannot criticise the examining division's exercise of its discretion under Rule 137(3) EPC not to admit the applicant's request. In exercising its discretion, the division took into account the very late stage in the proceedings at which the applicant had requested to revert to its previously filed request, together with the fact that this request had already been considered in the oral proceedings before the division and, subsequent to the division's unfavourable opinion, had been withdrawn by the applicant. The examining division thus took account of the right principles, as required by the Enlarged Board in G 7/93 (OJ EPO 1994, 775, Reasons, points 2.2 to 2.5).

2.3 Hence the present case corresponds to the situation described above, at point 1.2., citing T 717/01 and T 934/02, insofar as the appellant has not submitted that the decision under appeal was incorrect but filed new claims of a sole request together with a statement of grounds maintaining that these claims were clear and that their subject-matter was both new and inventive. As in those two cases, there was a change in the subject of the proceedings due to the filing of new claims together with the statement of grounds.

2.4 However, unlike the situation in T 717/01 and T 934/02, as already stated, the application was not refused on the basis that the previous set of claims on file could not be allowed, i.e. for lack of clarity, novelty or inventive step. Rather, the decision under appeal was based on the ground that there was no agreed set of claims, due to the fact that the examining division had exercised its discretion not to re-admit the claims of 21 December 2007 into the proceedings after having discussed them at oral proceedings and the applicant having withdrawn them. The underlying principle for the exercise of the examining division's discretion is "the EPO's interest in bringing the examination procedure to a close" (see G 7/93, point 2.5), i.e. the principle of procedural economy, which has to be balanced against the applicant's rights, for example and as was the case in G 7/93, to obtain a patent which is legally valid in all of the designated states. In the present case, by changing its mind with respect to the set of claims according to which a patent was requested and reverting to the set of claims that it had withdrawn during the oral proceedings, the appellant was trying at a very late stage in the proceedings to reopen the discussion on questions of substantive patent law.

Under these circumstances, in the board's view, the statement of grounds should have set out why the appellant should be given the opportunity to have the proceedings continued before the board of appeal. The appellant however has not furnished any such explanation.

- 2.5 Nor do the amendments submitted together with the statement of grounds self-evidently overcome the grounds for the decision (see point 1.2 *in fine* above).

It is not self-evident from the appellant's submissions on filing the appeal that the amended claims filed with the statement of grounds overcome the reason for the refusal. Such a reason is not apparent from these amended claims alone; in particular, they do not correspond to the ones that were considered allowable by the examining division (see point III). The appellant also did not provide arguments in the statement of grounds concerning the question as to which rights of the appellant had to be balanced against the principle of procedural economy in order to admit an appeal based on these amended claims. In the present case the appellant only provided arguments as to why the amended claims were clear, novel and involved an inventive step in view of the prior art cited in the first-instance proceedings. Such arguments may or may not be suitable to address objections with respect to clarity and inventive step. But such reasoning does not take into account that an applicant does not have a procedural right to amend application documents at any time. The filing of amendments is governed by Rule 137 EPC. In appeal proceedings, the right to file amendments may be further restricted by Articles 12 and 13 RPBA. Therefore the mere filing of amended claims and the submission of arguments relating

to substantive issues is not enough, in cases such as the present one, to convince the board that the appellant could only present the amended claims together with the statement of grounds, and thereby to overcome the reason for refusal.

3. It follows from the above that the present statement of grounds of appeal does not fulfil the requirements of Article 108, third sentence, EPC in conjunction with Rule 99(2) EPC. Thus the board must reject the appeal as inadmissible pursuant to Rule 101(1) EPC.

## **Order**

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

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated