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Datasheet for the decision of 6 March 2014

Case Number: T 2209/09 - 3.5.05

Application Number: 01965769.1

Publication Number: 1325407

IPC: G06F3/033, G06K11/08, G06K11/18

Language of the proceedings: EN

Title of invention:
DRAWING, WRITING AND POINTING DEVICE

Applicant:
Epson Norway Research and Development AS

Headword:
DRAWING, WRITING AND POINTING DEVICE/EPSON

Relevant legal provisions:
EPC 1973 Art. 84
EPC Art. 111(1), 123(2)
RPBA Art. 12(4)

Keyword:
Late-filed request - admitted (yes)
Claims - support in the description (yes)
Extension of subject-matter (no)
Remittal to the department of first instance (yes)

Decisions cited:

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Catchword:

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Case Number: T 2209/09 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 6 March 2014

Appellant: (Applicant)	Epson Norway Research and Development AS Postboks 1288, Sluppen 7462 Trondheim (NO)
Representative:	Boult Wade Tennant Verulam Gardens 70 Gray's Inn Road London WC1X 8BT (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 9 June 2009 refusing European patent application No. 01965769.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman: A. Ritzka
Members: P. Corcoran
G. Weiss

Summary of Facts and Submissions

I. The present appeal is against the decision of the examining division to refuse the European patent application no. 01 965 769.1, publication no. EP 1 325 407.

II. The impugned decision was issued in the form of a "decision according to the state of the file" which referred to the previous official communication dated 12 March 2009.

III. The decision was taken with respect to a main request comprising 40 claims and an auxiliary request comprising 37 claims both of which were submitted with the letter of 23 December 2008, the auxiliary request having been originally filed with the letter of 31 July 2008.

IV. Claim 1 of the aforementioned main request reads as follows:

"Apparatus for data presentations, computer supported work or other interactive use of a computer, comprising:

a camera, characterised in that the apparatus further comprises:

a recognition system operatively coupled to the camera;

a drawing, writing or pointing device (1) comprising one or more code patterns (3) adapted to be detected by the camera and recognition system,

the camera being adapted to record one or more images (31), at least one of the images containing one or more code patterns (3) from the device (1),

the recognition system comprising position determining means adapted to determine the position of the device (1) in the images (31),

the position determining means including filtering means comprising one or more matched filters adapted to the one or more code patterns (3), to thereby identify positions and/or orientations of the one or more code patterns (3)."

V. In the official communication dated 12 March 2009, the examining division expressed the opinion that the subject-matter of claim 1 of the main request did not involve an inventive step in the light of the following prior art document:

D1: EP 0 716 389 A.

In said communication, the opinion was further expressed that claim 1 of the auxiliary request likewise lacked an inventive step in the light of D1.

VI. With reference to the earlier procedural history of the proceedings before the department of first instance the following details which are considered to be of relevance to the present appeal proceedings are noted:

(i) In item 4.1 of the official communication of 31 March 2008, the examining division referred to the request filed with the letter of 25 February 2008 and contained a brief statement to the effect that "the subject-matter of claims 1, 17 and the gist of claims 20-22 would constitute a basis for subject-matter meeting the requirements of Article 52(1) EPC."

(ii) Claim 1 of a second auxiliary request filed with the letter of 6 May 2009 included the specification of an "activation mechanism/

function" corresponding to the "activation mechanism/device" recited in the aforementioned claim 17 filed with the letter of 25 February 2008 but it did not include any further features from the subsequent dependent claims 20-22. This second auxiliary request was subsequently withdrawn with the letter dated 1 June 2009 in which a decision in writing was requested.

VII. Notice of appeal was received on 8 July 2009 with the appropriate fee being paid on the same date. A written statement setting out the grounds of appeal was received at the EPO on 12 October 2009. With the statement setting out the grounds of appeal, the appellant submitted a main request and an auxiliary request which were identical to the main and auxiliary request on which the impugned decision was based.

VIII. In a communication accompanying a summons to oral proceedings the board gave its preliminary opinion that the appellant's requests were not allowable.

IX. With a letter of reply dated 6 February 2014, the appellant maintained the main request filed with the letter of 12 October 2009. An amended first auxiliary request was filed and the previous auxiliary request was maintained as a second auxiliary request. The appellant further filed a third auxiliary request comprising 14 claims.

X. Oral proceedings were held as scheduled on 6 March 2014. During the oral proceedings the appellant maintained the aforementioned third auxiliary request and withdrew all other requests on file.

XI. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 14 filed as third auxiliary request submitted with the letter dated 6 February 2014.

XII. Claim 1 of the third auxiliary request submitted with the letter dated 6 February 2014 reads as follows:

"Apparatus for data presentations, computer supported work or other interactive use of a computer, comprising:

a camera, characterised in that the apparatus further comprises:

a recognition system operatively coupled to the camera;

a drawing, writing or pointing device (1) comprising one or more code patterns (3) adapted to be detected by the camera and recognition system,

the camera being adapted to record one or more images (31), at least one of the images containing one or more code patterns (3) from the device (1),

the recognition system comprising position determining means adapted to determine the position of the device (1) in the images (31),

the position determining means including filtering means comprising one or more matched filters adapted to the one or more code patterns (3), to thereby identify positions and/or orientations of the one or more code patterns (3),

wherein the device comprises an activation mechanism/device (8) such that the code patterns (3) may be activated/controlled by the user of the device, where one end of the activation mechanism/device comprises a spring suspended tip with additional code patterns (33), the tip being mechanically coupled to a through-going centre pin of the device such that the tip and the centre pin are displaced along the centre

line of the device (1) and that the effective stripe pattern in one end of the device is altered when the tip is pressed towards a surface."

XIII. Insofar as they are relevant to the present decision, the written and oral submissions made on behalf of the appellant during the present appeal proceedings, may be summarised as follows:

(i) With respect to the third auxiliary request filed with the letter dated 6 February 2014, it was submitted that claim 1 thereof was based on a combination of the subject matter of claims 16 and 21 of the main request filed with the letter of 12 October 2009.

(ii) It was further submitted that this subject-matter was proposed as allowable for grant by the Examining Division in their report of 31 March 2008 where the relevant subject-matter had been referred to in paragraph 4 as claim 22.

XIV. At the end of the oral proceedings the chair announced the board's decision.

Reasons for the Decision

1. The appeal is admissible. The appeal is also judged to be allowable for the reasons which follow.

2. The appellant's sole request is the third auxiliary request submitted with the letter dated 6 February 2014 (cf. Facts and Submissions, item X above).

3. Articles 84 EPC 1973 and 123(2) EPC

3.1 The additional features which have been introduced into claim 1 of the appellant's request by way of amendment, i.e. the features relating to an "activation mechanism/ device", find support in claims 6 and 11 of the originally filed claims and in the following passages of the originally filed description: p.7, l.31 to 34 and p.9, l.25 to 38.

3.2 In view of the foregoing, the board is satisfied that the matter for which protection is sought in claim 1 of the request is supported by the description in a manner compliant with the requirements of Articles 84 EPC 1973.

3.3 Having regard to the fact that the original application documents clearly provide support for the amendments to claim 1, said amendments are likewise judged to be in conformity with Article 123(2) EPC.

4. *Admissibility of the request*

4.1 The features which have been introduced into to claim 1 of the request by way of amendment include the

specification of an "activation mechanism/device" and further details of its mechanical construction which were not present in the independent claims of the requests on which the decision under appeal was based.

4.2 In the official communication of 31 March 2008, the examining division indicated with respect to the request filed with the letter of 25 February 2008 that "the subject-matter of claims 1, 17 and the gist of claims 20-22 would constitute a basis for subject-matter meeting the requirements of Article 52(1) EPC" (cf. Facts and Submissions, item VI(i) above).

4.3 Claim 1 of the second auxiliary request filed with the letter of 6 May 2009 included the specification of an "activation mechanism/function" in accordance with the aforementioned claim 17 as filed with the letter of 25 February 2008 but said claim 1 did not include any further features from the related dependent claims 20-22. This request was subsequently withdrawn (cf. Facts and Submissions, item VI(ii) above).

4.4 Claim 1 of the present request re-introduces the specification of an "activation mechanism/device" and further includes details of its mechanical construction substantially in accordance with claim 22 as filed with the letter of 25 February 2008.

4.5 The board notes that a claim incorporating such subject-matter could have been but was not pursued to a final decision in proceedings before the department of first instance. Nevertheless, having regard to the fact that said subject-matter was present in dependent claims 16 and 21 of the main request on which the impugned decision was based, the appellant cannot be considered to have abandoned it. In view of this

consideration, the board decided to exercise its discretion under Article 12(4) RPBA in the appellant's favour by admitting the request.

5. *Remittal*

5.1 The brief statement by the examining division in the official communication of 31 March 2008 to the effect that "the subject-matter of claims 1, 17 and the gist of claims 20-22 [*as filed with the letter of 25 February 2008*] would constitute a basis for subject-matter meeting the requirements of Article 52(1) EPC" is only a very general statement indicating potentially allowable subject-matter.

5.2 The official communication of 31 March 2008 fails to provide a precise indication as to what the examining division would have considered to constitute the essential technical features of an allowable claim. For example, item 4.1 of said communication also makes reference *inter alia* to features that have not been included in the present claim 1 such as "the compressible air chamber" and "the roughly conical outer and inner two pen-tips".

5.3 Insofar as can be determined from the record of first instance proceedings no independent claim incorporating "the subject-matter of claims 1, 17 and the gist of claims 20-22" was filed in response to the official communication of 31 March 2008. The only request which partially incorporated this subject-matter into an independent claim was subsequently withdrawn (cf. 4.3 above).

5.4 Hence, the question as to what would constitute the essential technical features of an allowable claim

cannot be considered to have been dealt with in a comprehensive and exhaustive manner during first instance proceedings such that it would be appropriate for the board, in its role as a review instance, to proceed to give a final decision on this point.

5.5 Although it would, in principle, lie within the discretion of a board to decide itself on the merits of the case pursuant to Article 111(1) EPC (second sentence), under the given circumstances the board judges that it is more appropriate to exercise its discretion in favour of remitting the present case to the department of first instance for further prosecution.

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 14 filed as third auxiliary request with letter dated 6 February 2014.

The Registrar: The Chair:

K. Götz A. Ritzka

Decision electronically authenticated