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**Datasheet for the decision
of 28 August 2014**

Case Number: T 0423/10 - 3.5.04

Application Number: 02021303.9

Publication Number: 1282301

IPC: H04N1/00

Language of the proceedings: EN

Title of invention:

An electronic-mail reception apparatus and method for receiving image data

Patent Proprietor:

Panasonic Corporation

Headword:

Relevant legal provisions:

RPBA Art. 13(1)

Keyword:

Late-filed request - change of subject-matter

Decisions cited:

Catchword:



**Beschwerdekammern
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Chambres de recours**

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Case Number: T 0423/10 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 28 August 2014

Appellant: Panasonic Corporation
(Patent Proprietor) 1006, Oaza Kadoma
Kadoma-shi
Osaka 571-8501 (JP)

Representative: Grünecker, Kinkeldey,
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 15 December
2009 revoking European patent No. 1282301
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman F. Edlinger
Members: C. Kunzelmann
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the decision of the opposition division to revoke European patent No. 1 282 301 under Article 101(3)(b) of the European Patent Convention (EPC).
- II. The patent derives from European patent application No. 02 021 303.9, a divisional application of European patent application No. 99 124 161.3, which is itself a divisional application of European patent application No. 96 105 799.9. The opponent had filed opposition against the grant of the patent on the grounds according to Articles 100(a), 100(b) and 100(c) EPC. The opponent had based its submissions with respect to the grounds under Article 100(a) EPC on a number of prior-art documents including D1C and D7.
- III. In the reasons for the decision under appeal only documents D1C and D7 were considered:
- D1C: BORENSTEIN N. et al.
'MIME (Multipurpose Internet Mail Extensions)
Part One: Mechanisms for Specifying and
Describing the Format of Internet Message
Bodies'
Network Working Group, Request for Comments
RFC 1521, September 1993
- D7: WO 94/03994 A1.
- IV. The patent was revoked on the grounds that, taking into consideration the amendments made by the patentee during the opposition proceedings, the subject-matter of claim 1 of the main request and the first auxiliary request then on file did not involve an inventive step (Article 56 EPC) in view of document D1C, and the

- subject-matter of claim 1 of the second auxiliary request did not involve an inventive step in view of documents D1C and D7.
- V. The patentee appealed against this decision and filed claims according to a new main request and new first to third auxiliary requests with the statement of grounds of appeal.
- VI. The respondent (opponent) replied with a letter dated 7 September 2010. It maintained all of the grounds for opposition raised during the opposition proceedings. It also raised objections under Articles 84 and 123(3) EPC against the amended claims filed with the statement of grounds of appeal, and filed two further prior-art documents.
- VII. The board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to a summons to oral proceedings dated 22 April 2014. In this communication the board indicated its provisional opinion that it tended to agree with the analysis given in the reasons for the decision under appeal, and that consequently the subject-matter of claim 1 of all requests did not appear to involve an inventive step.
- VIII. With a letter of reply dated 24 July 2014 the appellant filed amended claims according to a new main request and new first to third auxiliary requests. The appellant indicated that the amended claims were directed to the fourteenth embodiment described in the patent specification, and addressed the objections raised in the board's communication. The letter of reply also indicated that explanations and arguments as

to inventive step would be provided during the oral proceedings.

IX. For each claim 1 recited below in this paragraph and paragraphs X to XII, amendments with respect to claim 1 of the patent as granted, which is the same as claim 1 of the main request underlying the decision under appeal and as claim 1 filed with the statement of grounds of appeal, are set in *italics*.

Claim 1 of the main request reads as follows:

"An electronic-mail reception apparatus, said apparatus comprising:

an electronic-mail receiver (9) that receives data in an electronic mail format including one of image data and character code data via a communication network;

a converter (10) that converts the received data in the electronic mail format into printable image data when a processor (1) determines that the received data is image data in the electronic mail format;

a font section (12) that converts the character code data into printable image data when said processor (1) determines that the received data is character code data; and

a printer (11) that prints the printable image data obtained by one of said converter (10) and said font section (12),

characterized in that

said processor (1) determines whether the data received by said electronic-mail receiver (9) is one of the image data and the character code data, said processor (1) referring to a data format information in a header of the received data in the electronic-mail format to determine whether the received data is the image data or the character code data,

said processor (1) is further adapted to analyze the header of received data in the electronic mail format with respect to a requirement for facsimile transmission, and the electronic-mail reception apparatus further includes a facsimile modem (18) that transmits the received data in electronic mail format to a destination via a telephone network."

- X. Claim 1 of the first auxiliary request has the same wording as claim 1 of the main request, except for the features set in *italics* which now read as follows:

"said processor (1) is further adapted to analyze the header of received data in the electronic mail format with respect to a requirement for facsimile transmission, the converter (10) is further adapted to convert the received data in the electronic mail format into image data of a facsimile format, and the electronic-mail reception apparatus further includes a facsimile modem (18) that transmits the converted image data in the facsimile format to a destination via a telephone network."

- XI. Claim 1 of the second auxiliary request has the same wording as claim 1 of the main request, except for the features set in *italics* which now read as follows:

"said processor (1) is further adapted to analyze the header of received data in the electronic mail format with respect to a requirement for facsimile transmission and to extract information of a destination telephone number from a portion of the received data in electronic mail format,

the converter (10) is further adapted to convert the received data in the electronic mail format into image data of a facsimile format, and the electronic-mail reception apparatus further includes a facsimile modem (18) that transmits the converted image data in the facsimile format to the destination telephone number via a telephone network."

XII. Claim 1 of the third auxiliary request has the same wording as claim 1 of the main request, except for the features set in *italics* which now read as follows:

"said processor (1) is further adapted to analyze the header of received data in the electronic mail format with respect to a requirement for facsimile transmission and to extract information of a destination telephone number from a portion of the received data in electronic mail format, the converter (10) is further adapted to convert the received data in the electronic mail format into image data of a facsimile format, the electronic-mail reception apparatus further includes a facsimile modem (18) that transmits the converted image data in the facsimile format to the destination telephone number via a telephone network, and said processor (1) is adapted to analyze the "subject" part of the header of the received data in the electronic mail format with respect to a requirement for facsimile transmission and is furthermore adapted to extract the destination telephone number from a portion of the received email which follows the "subject" part."

XIII. In a letter dated 18 July 2014 the respondent (opponent) informed the board that it would not be

attending the oral proceedings. In a further letter dated 28 July 2014 the opponent withdrew the opposition.

XIV. Oral proceedings before the board were held on 28 August 2014. The board raised the issue whether the claims filed with the letter dated 24 July 2014 should be admitted into the appeal proceedings under Article 13(1) RPBA. The appellant's final request was that the decision under appeal be set aside and that the patent be maintained on the basis of the claims of one of the requests submitted with the letter dated 24 July 2014 and the description and drawings of the patent as granted.

XV. At the end of the oral proceedings the chairman announced the board's decision.

XVI. The appellant's arguments as to why the claims filed with the letter dated 24 July 2014 should be admitted into the appeal proceedings may be summarised as follows:

When filing the statement of grounds of appeal the appellant had considered the decision under appeal to be incorrect and expected it to be set aside by the board. The claims had been filed in reaction to the board's communication, which indicated that the board tended to confirm the finding in the decision under appeal as to lack of inventive step. They were restricted to one specific embodiment (the fourteenth) which was covered by the patent as granted, and corresponded essentially to the combination of claims 1 and 3 as granted. The invention related to an automatic fax forwarding function and only those features of claim 3 as granted which were unnecessary for the

invention were not comprised in the claims dated 24 July 2014. The technical teaching of these claims was not very complex. Explanations and arguments relating to inventive step had not been submitted before the oral proceedings since in view of the new claims the question as to which of the documents considered in the opposition proceedings should be regarded as the closest prior art (and all the resulting issues relevant for the assessment of inventive step) had to be discussed anew.

Reasons for the Decision

1. The appeal is admissible.
2. *Admission of the claims of the appellant's final requests (Article 13(1) RPBA)*
 - 2.1 According to Article 13(1) RPBA, "Any amendment to a party's case after it has filed its grounds of appeal ... may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject matter, the current state of the proceedings and the need for procedural economy."
 - 2.2 In the present case, the amended claims of the appellant's final requests were filed about one month before the oral proceedings, long after the filing of the statement of grounds of appeal.
 - 2.3 The amended claims of the appellant's final requests all specify an electronic mail reception apparatus having *inter alia* the features of a processor adapted to analyse the header of received data in an electronic

mail format with respect to a requirement for facsimile transmission, and of a facsimile modem that transmits the received data in electronic mail format to a destination via a telephone network. These features are related to the fourteenth embodiment described in the patent specification (see paragraphs [0123] to [0130] and figure 27). In this embodiment, image data of the e-mail format are received and converted into corresponding image data of a given facsimile format. The "Subject" part of the header of the received e-mail is analysed as to whether it includes a requirement for facsimile transmission. Depending on the result of the analysis, the image data of facsimile format are either transferred to a modem (for output to a telephone line) or expanded to binary image data and transferred to a printer.

Thus the amended claims are concerned with the issue of analysing (the header of) a received e-mail and forwarding the e-mail (implicitly, after conversion) as a facsimile to a destination via a telephone network.

2.4 This issue was not reflected in the claims of the patent in suit or in any of the claims submitted to the opposition division and is based exclusively on the description and drawings relating to the fourteenth embodiment of the patent specification.

2.4.1 The independent claims of the patent and claim 1 of the main request underlying the decision under appeal relate to the issues of determining whether received image data in e-mail format are image data or character code data and converting them into printable image data (see, for instance section 3 of the decision under appeal). In the first-instance proceedings, the

discussion as to inventive step focused on the question whether D1C taught a person skilled in the art how to build an apparatus comprising the functional means specified in claim 1. The auxiliary requests underlying the decision under appeal relate to this aspect, too, in that they additionally specify *inter alia* a connection of components of the claimed apparatus via a bus line.

2.4.2 The claims of the second and third auxiliary requests underlying the decision under appeal additionally comprise features of dependent claim 3 of the patent as granted, in particular a facsimile transmitter, an electronic-mail transmitter and an operational panel. By means of the operational panel the user may designate whether image data originating from a scanner are transmitted by means of the facsimile transmitter or the electronic-mail transmitter. But these claims do not comprise features relating to the analysis of (the header of) a received e-mail and forwarding the e-mail.

2.4.3 The differences between the subject-matter of the claims filed with the letter dated 24 July 2014 and those considered in the opposition proceedings are also reflected in the description of the patent specification. Whereas the subject-matter of the claims filed with the letter dated 24 July 2014 (see point 2.3 above) relates to the fourteenth embodiment, the subject-matter of claim 1 of the main and the first auxiliary requests underlying the decision under appeal (see point 2.4.1 above) is mainly the subject of the third embodiment (see paragraphs [0024] to [0028] and figures 5 and 6). The issues reflected in the second and third auxiliary requests underlying the decision under appeal (see point 2.4.2 above) are mainly the

subject of the twelfth embodiment (see paragraphs [0104] to [0114] and figures 24 and 25).

2.5 Even though the technical features of the claims filed with the letter dated 24 July 2014 are not overly complex in themselves, they lead to procedural complexity in that new prior art not considered up to now may become relevant. Neither documents D1C and D7 considered in the decision under appeal nor the other documents submitted by the former opponent to the opposition division and to the board deal with the issue summarised in point 2.3 above. Nor can this issue be considered as a technical detail of an aspect discussed in the opposition proceedings. Quite to the contrary, it relates to a functionality of the claimed electronic mail reception apparatus which is essentially unrelated to the functionalities discussed in the opposition proceedings and may even not have been searched during examination of the divisional application leading to the patent in suit. Examination of these new issues would require essentially fresh opposition proceedings (possibly before the opposition division, following a remittal to the department of first instance), based on new claims, and without the former opponent. This would be contrary to procedural economy.

2.5.1 Moreover the claims filed with the letter dated 24 July 2014 introduce only some of the features of claim 3 as granted into claim 1 as granted and relate to a different embodiment (see point 2.4.3 above). This raises the issue of possible intermediate generalisations which would require detailed examination as to whether subject-matter has been added (with respect to the divisional application as filed or

with respect to one of the earlier applications as filed). This adds further complexity to the case.

2.6 Moreover, the claims filed with the letter dated 24 July 2014 were filed at a very late stage of the proceedings. The explanations and arguments in their support were left to an even later stage, namely the oral proceedings before the board. However, the board's communication of 22 April 2014 mainly indicated that it tended to confirm the decision under appeal essentially for reasons outlined in section 3 of the decision under appeal. Thus the board's objections raised in the communication were in substance already known from the first-instance proceedings.

3. The appellant's arguments that the claims filed with the letter dated 24 July 2014 should be admitted into the appeal proceedings did not convince the board. The reasons are as follows:

3.1 The appellant's argument that the claims corresponded essentially to the combination of claims 1 and 3 as granted did not convince the board. Features of the combination of claims 1 and 3 as granted which defined the particular context of the facsimile transmitter (which corresponds to the facsimile modem specified in current claim 1) have been omitted in the current set of claims (such as an operational panel, an acceptor/scanner and a compressor) and other features have been added, so that the new combination relates to a different embodiment (see point 2.4.3 above).

3.2 The argument that the requests should be admitted because the claims were filed in reaction to the board's communication did not convince the board either, because its communication did not raise new

issues. Even if the appellant intended to defend the patent essentially in the version(s) submitted to the opposition division and to maintain a more limited version only if the board indicated that it might confirm the decision under appeal, it would nevertheless have been possible to make clear to the then respondent and the board from the beginning of the appeal proceedings which of the at least twenty embodiments of the specification was/were relevant for the appellant and to file corresponding auxiliary requests with the statement of grounds of appeal, thereby presenting the appellant's complete case at an early stage of the appeal proceedings.

- 3.3 The appellant also argued that the fourteenth embodiment was covered by the patent as granted and related to the twelfth embodiment in the chain of embodiments described in the patent specification. However, as discussed in sections 2.3 and 2.4 above, the fourteenth embodiment is concerned with a functionality of the e-mail reception apparatus which is different from the functionality of the e-mail reception apparatus of other embodiments. Formally, there is a chain of embodiments in the patent specification, in that the fourteenth embodiment is described as being "similar to the embodiment of Figs. 24 and 25 [i.e. the twelfth embodiment] except for design changes described hereinafter", with the description of the twelfth embodiment similarly referring back to the seventh, the seventh to the sixth, and then the fourth, third, second and first embodiments. However, the functionalities of these different embodiments are so different from each other that these references essentially only convey the teaching that the described apparatus has a number of

different functionalities. But these references do not change the assessment in section 2 above.

4. In view of the above, the board decided not to admit the sets of claims filed with the letter dated 24 July 2014 into the appeal proceedings under Article 13(1) RPBA. These claims replaced all previous claims. Thus there are no claims submitted by the patentee on the basis of which the patent could be maintained. Therefore, the decision under appeal cannot be set aside and the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated