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**Datasheet for the decision
of 22 April 2015**

Case Number: T 1538/10 - 3.5.04
Application Number: 03255722.5
Publication Number: 1416709
IPC: H04N1/00, H04N1/32, H04N1/44
Language of the proceedings: EN

Title of invention:

Image forming apparatus, a scanned data process method, a computer program and a computer readable storage medium

Patent Proprietor:

Ricoh Company, Ltd.

Opponent:

Uwe Spandern

Headword:

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 12(4)

Keyword:

Amendments - added subject-matter (yes)
Late-filed request -
request could have been filed in first instance proceedings (no)

Decisions cited:

Catchword:

See section 2



**Beschwerdekammern
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Case Number: T 1538/10 - 3.5.04

**D E C I S I O N
of Technical Board of Appeal 3.5.04
of 22 April 2015**

Appellant:
(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 10 May 2010
revoking European patent No. 1416709 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chair T. Karamanli
Members: C. Kunzelmann
R. Gerdes

Summary of Facts and Submissions

- I. The appeal is against the decision of the opposition division to revoke European patent No. EP 1 416 709 under Article 101(3) (b) EPC.
- II. The opposition was based on the grounds for opposition under Article 100(a), (b) and (c) EPC. The patent was revoked on the grounds that the subject-matter of claims 1 and 7 of the main request then on file lacked novelty, that the subject-matter of claims 1 and 7 of the first auxiliary request then on file lacked an inventive step, and claims 1 and 7 of the second and third auxiliary requests then on file infringed Article 123(2) EPC.
- III. The patentee appealed against this decision and requested that the decision be set aside. With the statement of grounds of appeal, the appellant filed amended claims according to a main and first to third auxiliary requests and submitted arguments as to why these requests overcame the objections raised in the decision under appeal.
- IV. Claim 1 of the main request reads as follows:

"A compound machine for use in a networked system including a WEB server and a PC, the compound machine comprising:
a scanner engine (103);
an operation panel (150);
a network controller (104) for communicating with the WEB server and the PC;
a display part for displaying a selection screen for selecting a remote transfer destination for scanned

data from among a plurality of transfer destinations on the operation panel;
a scanning process part (162) for causing the scanner engine to scan a document to produce a scanned data file;
a transfer part (163) for transferring the scanned data file to a storing area of the selected remote transfer destination; and
a print process part (501) for downloading the same scanned data file from a storing area of the selected remote transfer destination and printing the scanned data file,
wherein if authentication information is required for accessing the storing area, the display part displays a screen for inputting the authentication information when the storing area is selected, and
wherein the storing area of the selected remote transfer destination is a dedicated storage location and is a storing area (301) of said WEB server which is shared by said compound machine (100) and said PC (200)."

V. Claim 1 of the first auxiliary request reads as follows:

"A system comprising a WEB server, a PC and a compound machine including a scanner engine (103) and an operation panel (150), the compound machine comprising:
a display part for displaying a selection screen for selecting a remote transfer destination for scanned data from among a plurality of transfer destinations on the operation panel;
a scanning process part (162) for causing the scanner engine to scan a document to produce a scanned data file;

a transfer part (163) for transferring the scanned data file to a storing area of the selected remote transfer destination; and
a print process part for downloading the same scanned data file from a storing area of the selected remote transfer destination and printing the scanned data file,
wherein if authentication information is required for accessing the storing area, the display part displays a screen for inputting the authentication information when the storing area is selected, and
wherein the storing area of the selected remote transfer destination is a dedicated storage location and is a storing area (301) of said WEB server which is shared by said compound machine (100) and said PC (200)."

VI. Claim 1 of the second auxiliary request reads as follows:

"A system comprising a WEB server, a PC and a compound machine including a scanner engine (103) and an operation panel (150), the compound machine comprising:
a display part for displaying a selection screen for selecting a remote transfer destination for scanned data from among a plurality of transfer destinations on the operation panel;
a scanning process part (162) for causing the scanner engine to scan a document to produce a scanned data file;
a transfer part (163) for transferring the scanned data file to a storing area of the selected remote transfer destination; and
a print process part for downloading the same scanned data file from a storing area of the selected remote

transfer destination and printing the scanned data file,
wherein if authentication information is required for accessing the storing area, the display part displays a screen for inputting the authentication information when the storing area is selected;
wherein the storing area of the selected remote transfer destination is a dedicated storage location and is a storing area (301) of said WEB server which is shared by said compound machine (100) and said PC (200); and
wherein the WEB server comprises a character recognition application for recognising characters in the scanned data file and a storing directory for storing a result file and the scanned data file."

VII. Claim 1 of the third auxiliary request reads as follows:

"A compound machine for use in a networked system including a WEB server and a PC, the compound machine comprising:
a scanner engine (103);
an operation panel (150);
a network controller (104) for communicating with the WEB server and the PC;
a display part for displaying a selection screen for selecting a remote transfer destination for scanned data from among a plurality of transfer destinations on the operation panel;
a scanning process part (162) for causing the scanner engine to scan a document to produce a scanned data file;
a transfer part (163) for transferring the scanned data file to a storing area of the selected remote transfer destination; and

a print process part (501) for downloading the same scanned data file from a storing area of the selected remote transfer destination, generating a job and printing the scanned data file, wherein if authentication information is required for accessing the storing area, the display part displays a screen for inputting the authentication information when the storing area is selected, and wherein the storing area of the selected remote transfer destination is a dedicated storage location and is a storing area (301) of said WEB server which is shared by said compound machine (100) and said PC (200)."

VIII. The respondent replied to the appeal with a letter dated 17 January 2011. He argued that the claims of the requests filed with the statement of grounds of appeal were (at least partly) rather similar to the claims underlying the opposition division's decision to revoke the patent and that, therefore, all the arguments submitted in the first-instance proceedings were to be expressly maintained and referred to. He also submitted arguments as to why he considered the independent claims of all requests *inter alia* to extend beyond the original disclosure of the application, and arguments as to why the claimed subject-matter did not involve an inventive step. Moreover he submitted new prior-art documents E8 to E11.

IX. The appellant requested with a letter dated 6 June 2011 that documents E8 to E11 should not be admitted into the appeal proceedings for being late-filed. As to the respondent's arguments, it submitted that "The other objections raised by the Opponent are not well founded and do not counter the arguments raised in the

- Statement of Grounds". The appellant did not submit any further arguments in this respect.
- X. 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 8 January 2015.
- XI. The respondent replied with a letter dated 17 March 2015. He requested that the appellant's requests filed with the statement of grounds of appeal should not be admitted into the appeal proceedings under Article 12(4) RPBA, and that documents E8 to E11 be admitted into the appeal proceedings.
- XII. The appellant informed the board with a letter dated 20 March 2015 that no representative for the appellant would be attending the oral proceedings and requested that a decision be taken on the basis of the appellant's written submissions.
- XIII. Oral proceedings before the board were held on 22 April 2015 in the absence of the duly summoned appellant, in application of Rule 71(2) EPC 1973 and Article 15(3) RPBA. During the oral proceedings, the respondent withdrew his request that the first, second or third auxiliary requests be not admitted into the appeal proceedings pursuant to Article 12(4) RPBA.

The chair noted that the appellant (patent proprietor) had requested in writing that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims according to the main, first, second or third auxiliary requests, all requests filed with the statement of grounds of appeal.

The respondent (opponent) requested that the appeal be dismissed.

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

- XIV. The appellant's arguments in writing, as far as they are relevant for the present decision, may be summarised as follows:

The main request had been amended with respect to the main request underlying the decision under appeal to improve the clarity and consistency of the claims and to correct an obvious error. The basis for the amendments made could be seen in the application as originally filed in paragraphs [0018], [0022] and [0080].

The claims of the main request were effectively limited to the inventive concept. The invention related to a compound machine which could perform both scanning of original documents and printing. It aimed to improve the handling of data which was scanned on the compound machine and then transferred to a remote server for storage by providing a simple and user-friendly procedure for retrieving that scanned data from the remote server and printing it on the compound machine. The scanned data file was transferred to and retrieved from the remote storage location directly, and without requiring any process to be performed at the remote storage location.

- XV. The respondent's arguments, as far as they are relevant for the present decision, may be summarised as follows:

The main request filed with the statement of grounds of appeal should not be admitted into the appeal proceedings. There was no objective reason or excuse for not filing this request already in the first-instance proceedings. It was clear from the minutes of the oral proceedings before the opposition division that the patentee had been asked at the end of the oral proceedings whether it had any further requests and had replied in the negative. The appellant filed a large number of requests in appeal proceedings and they raised new aspects and issues in a substantial extent and with significant complexity. In particular, it was difficult identifying the actually effective amendments, and whether all of them were actually caused by the grounds for opposition. There was also the issue of the original disclosure of, for instance, the expression "the same scanned data file", which seemed to lack a basis in the original application. The case presented by the appellant in the appeal proceedings went beyond the factual and legal scope of the preceding opposition proceedings. The appellant had also not submitted a specification adapted to the amended claims, so that the patent could not be maintained with the documents on file. Moreover, twelve years had passed since the priority date and it was in the interest of the competitors that legal certainty be established. The appellant seemed to have lost interest in the patent.

Concerning Article 123(2) EPC, the application as filed did not disclose that the same scanned data file was downloaded from the WEB server. In this respect, the original disclosure was that some arbitrary stored data file may be downloaded from the WEB server to the compound machine. There was no teaching that the scanned data file was not processed at the WEB server

between storage and download thereof. It was, for instance, conceivable that the PC, which was a client PC of the WEB server, might process the scanned data file stored at the WEB server.

Reasons for the Decision

1. The appeal is admissible.
2. *Respondent's request that the appellant's main request not be admitted under Article 12(4) RPBA*
 - 2.1 According to Article 12(4) RPBA, without prejudice to the power of the board "to hold inadmissible facts, evidence or requests which could have been presented ... in the first instance proceedings", everything presented by the parties under Article 12(1) RPBA has to be taken into account by the board if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA.
 - 2.2 According to established case law (see Case Law of the Boards of Appeal of the EPO, 7th edition 2013, IV.E.4.3.2 b)), it is clear from the wording of Article 12(4) RPBA that the board in inter partes proceedings has discretion over whether not to admit requests which could have been presented by the patent proprietor in first-instance proceedings, but were not. It is undisputed that the precondition for the board's power under Article 12(4) RPBA of whether the request at issue could have been presented in the first-instance proceedings relates to the question of whether the presenting party could have been expected to present its request in the first-instance proceedings in the circumstances of the specific case.

2.3 In the present case, the respondent argued that the present main request, filed with the statement of grounds of appeal, could have been presented in the first-instance proceedings and requested that the board exercise its power under Article 12(4) RPBA in not admitting the main request. Thus, the first decisive question is whether the appellant could have been expected to present specifically the present main request in the first-instance proceedings under the circumstances of the present case. The appellant has not submitted any arguments in this respect.

2.4 The respondent's arguments in this respect are general in the sense that they concern all the appellant's requests indiscriminately. There is no argument submitted by the respondent which is specifically related to the present main request. Moreover, most of his arguments concern issues such as added subject-matter, clarity, or whether particular claim amendments are actually caused by a ground for opposition. They do not, however, relate to the precondition for the board's power under Article 12(4) RPBA in the present case, i. e. whether the appellant could have been expected to present specifically the present main request in the first-instance proceedings under the circumstances of the present case.

2.5 The same applies to the argument relating to the complexity of the requests. Moreover, in the present case this argument concerns the entirety of the requests instead of the specific main request in question. Also the argument that the case presented by the appellant in the appeal proceedings went beyond the factual and legal scope of the preceding opposition proceedings does not answer the decisive question

whether the present main request could have been filed in the first-instance proceedings. Moreover, in the board's view, this argument is not consistent with the respondent's view that the main request was rather similar to the main request underlying the decision under appeal (see point VIII above). Also, the arguments relating to the missing adapted description, legal certainty and the assumption about the appellant having lost interest in the case do not concern the question relating to the precondition for the board's power under Article 12(4) RPBA.

2.6 The respondent also referred to the undisputed fact that the appellant had been asked for any further requests at the end of the oral proceedings before the opposition division. However, in the board's view this fact alone does not indicate that the appellant could have been expected to present specifically the present main request in this particular situation. It is clear from the minutes of the oral proceedings that the debate was not focused on one specific issue which should have prompted the appellant to file the present main request in the first-instance oral proceedings. Instead, after discussing added subject-matter issues of the third auxiliary request then on file and before closing the oral proceedings, the opposition division gave the appellant the opportunity to formulate any further requests.

2.7 Thus, in view of the course of the first-instance proceedings and the respondent's arguments, the board is not convinced that the present main request "could have been presented in the first-instance proceedings" within the meaning of Article 12(4) RPBA.

2.8 Therefore, the board refused the respondent's request not to admit the appellant's main request into the appeal proceedings under Article 12(4) RPBA. Consequently, the appellant's main request was taken into account by the board under Article 12(4) RPBA.

3. *Main request: added subject-matter (Article 123(2) EPC)*

3.1 Claim 1 of the main request comprises the features of a scanning process part for causing the scanner engine of the compound machine to scan a document to produce a scanned data file, a transfer part for transferring the scanned data file to a storing area of a selected remote transfer destination, and a print process part for downloading the same scanned data file from a storing area of the selected remote transfer destination and printing the scanned data file. Claim 1 also specifies a display part for displaying a selection screen for selecting a remote transfer destination for scanned data from among a plurality of transfer destinations on an operation panel, and that the selected remote transfer destination is a storing area of a WEB server. Thus, in context, claim 1 specifies a compound machine with the specific functionality that the particular data file which was produced by scanning one specific document by means of the scanner engine of the compound machine and subsequently transferred to a storing area of one previously selected WEB server, may be downloaded from this selected WEB server and printed by the print process part of the compound machine.

3.2 As convincingly argued by the respondent, the application as originally filed does not disclose that the same scanned data file is downloaded from the web server. The application as filed does not in any way

consider the issue of whether the same file or a different file is downloaded from the web server which was previously selected from the plurality of transfer destinations.

- 3.3 In particular, the paragraphs of the description mentioned by the appellant in the statement of grounds of appeal (which are in fact paragraphs of the application as published) do not deal with this issue.
- 3.4 Moreover, none of the originally disclosed embodiments deals with this issue.
- 3.4.1 For instance, in the first embodiment of the compound machine illustrated in figure 1 of the application as filed, a scanned data file is generated by performing a scanning process and subsequently transferred to the web server on the internet (see description as filed, page 9, lines 16 to 25, figures 5A, 5B, 5C and page 20, line 6 to page 24, line 24). The scanned data file is, however, not printed using the compound machine, but using an unspecified desired printer accessible from the PC (page 24, lines 2 to 13). Moreover, in the first embodiment of the application as filed the scanned data file may well be processed by means of a character recognition application installed in the web server (page 23, lines 19 to 23).
- 3.4.2 In the second embodiment of the compound machine illustrated in figure 6 of the application as filed, a file downloaded from a web server is printed using the compound machine (description as filed, page 28, line 23 to page 29, line 24). However, there is no teaching that the downloaded file was previously uploaded from the compound machine to this web server. For instance, it is conceivable that it has been uploaded from a

- different compound machine if many compound machines are connected on the network (see page 4, lines 5 to 10). Moreover, as convincingly argued by the respondent, it is conceivable that the PC might process the scanned data file stored at the web server.
- 3.4.3 The further embodiments are variations of the first and second embodiments. They too do not consider the issue of whether the same file or a different file is downloaded from the web server which was previously selected from the plurality of transfer destinations.
- 3.5 In this context the board notes that the first embodiment in the application as filed has been relabelled as a "First illustrative example" in the patent specification, and the second embodiment of the application as filed has been relabelled as the "First embodiment" in the specification. It is clear from the file that the first embodiment of the application as filed was considered not to fall under the scope of the claims that ultimately led to the grant of the opposed patent. However, the disclosure of the application as filed is not changed by this consideration of the examining division.
- 3.6 The claims of the application as filed constitute generalisations of the described embodiments. They too do not concern the issue of whether the same file or a different file is downloaded from the web server which was previously selected from the plurality of transfer destinations.
- 3.7 In view of the above, the board finds that the subject-matter of claim 1 of the main request is not directly and unambiguously derivable from the application as

filed. Thus this claim is not allowable under Article 123(2) EPC.

4. *First, second and third auxiliary requests: added subject-matter (Article 123(2) EPC)*
- 4.1 Since the respondent withdrew his request for the first, second and third auxiliary requests not to be admitted into the appeal proceedings in application of Article 12(4) RPBA, the board does not need to address this point.
- 4.2 Claim 1 of each of the first, second and third auxiliary requests comprises the features mentioned in point 3.1 above. Thus the board finds that the subject-matter of claim 1 of the first, second and third auxiliary requests is not directly and unambiguously derivable from the application as filed for the reasons given above in points 3.1 to 3.6 in the context of the main request. Hence these claims are not allowable under Article 123(2) EPC, either.
5. Since none of the appellant's requests is allowable in view of Article 123(2) EPC, there is no need for the board to decide upon the parties' procedural requests concerning the admissibility of documents E8 to E11, as these requests concern the relevant state of the art and thus have no bearing on the outcome of the present appeal.
6. In view of the above, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



K. Boelicke

T. Karamanli

Decision electronically authenticated