

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 15 December 2015**

Case Number: T 1924/10 - 3.5.04
Application Number: 00114380.9
Publication Number: 1079611
IPC: H04N5/33
Language of the proceedings: EN
Title of invention:
A monitoring system

Applicant:
Bayerische Motoren Werke Aktiengesellschaft

Headword:

Relevant legal provisions:

RPBA Art. 12(4)
EPC 1973 Art. 113(2)

Keyword:

Late-filed request -
request could have been filed in first instance proceedings (yes)
Late-filed request - admitted (no)
Basis of decision - text submitted or agreed by applicant (no)

Decisions cited:

G 0010/93

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1924/10 - 3.5.04

**D E C I S I O N
of Technical Board of Appeal 3.5.04
of 15 December 2015**

Appellant: Bayerische Motoren Werke Aktiengesellschaft
(Applicant) Petuelring 130
80809 München (DE)

Representative: Bayerische Motoren Werke Aktiengesellschaft
Patentabteilung, AJ-5
80788 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 10 May 2010
refusing European patent application
No. 00114380.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 00 114 380.9 under Article 97(2) of the European Patent Convention (EPC).
- II. The application was refused, in a decision according to the state of the file, on the grounds of lack of clarity of claim 1 according to the sole request then on file (Article 84 EPC) and of lack of inventive step of the monitoring system of claim 1 (Article 56 EPC).

The sole claim 1 then on file reads as follows:

"A monitoring system suitable for a vehicle, the system having a monitor means arranged in use to display an image which is built-up using an infra red detection means, the system being capable of changing the assignment of grey values to the temperature of objects in the image, wherein changes to said assignment are made in response to a user operated input means, said input means comprising a multi-position switch, each position of which is arranged in use to assign a different set of grey values to high and/or low temperatures such that the road surface appears brighter than the verges."

- III. The examining procedure may be summarised as follows:

In a first communication pursuant to Article 96(2) EPC 1973 the examining division raised a number of objections to the application documents as originally filed, which included claims 1 to 7. With a reply letter dated 22 August 2006, the applicant filed new claims 1 to 5. A consultation by telephone between the

first examiner and the representative took place on 12 November 2007 concerning the status of claims 6 and 7. In a second communication dated 17 March 2008, the examining division raised new objections. With a reply letter dated 14 August 2008 and received on 18 August 2008 with the EPO, the applicant filed a new sole claim 1 (see above) and submitted that the underlying object of the features was to improve driving safety. The expression "such that the road surface appears brighter than the verges" had not been present in any of the previous claims. The examining division then issued a summons to oral proceedings dated 31 March 2010, raising *inter alia* an objection as to lack of clarity. In particular, the examining division objected to the fact that the claim attempted to define subject-matter in terms of the result to be achieved. The examining division argued that the claim failed to specify the technical features necessary for obtaining the result that the road surface appeared brighter than the verges and in particular did not specify how the system could make a difference between the road surfaces and the verges in order to make them appear with different brightness. In a reply dated 12 April 2010, the applicant requested a decision according to the state of the file. By email dated 23 April 2010, the applicant withdrew its request for oral proceedings and confirmed the withdrawal by telephone on the same day. The examining division then cancelled the oral proceedings scheduled for 29 June 2010. The examining division continued the procedure in writing and refused the application.

IV. The applicant appealed against this decision and requested that the decision be set aside. It filed amended claims 1 to 3 with the statement of grounds of appeal and requested that a patent be granted on the

basis of these claims and a description to be adapted. The appellant also explained the differences between present claim 1 and claim 1 filed with the letter dated 22 August 2006. Oral proceedings were requested as a precaution.

V. Present claim 1 reads as follows:

"A monitoring system of a vehicle comprising a device arranged to display (22) an image generated using an infrared detector (14), and being capable of changing an assignment of grey values to temperatures of objects (18, 20) in the image, wherein:
the monitoring system further comprises a memory (26) having stored therein a table containing a plurality of alternative assignments (1, 2, 3, 4) of grey values to temperatures of the objects (18, 20) sensed by the infrared detector (14),
at least a first assignment (1) in which brighter grey values are assigned to relatively higher temperatures and darker grey values are assigned to relatively lower temperatures,
a second assignment (2) in which brighter grey values are assigned to relatively lower temperatures and darker grey values are assigned to relatively higher temperatures,
changes to the assignment of grey values are made by selection of an assignment (1, 2, 3, 4) from the table in the memory (26) in response to a user operated input means (24), and
in response to a driving situation assessment means implemented on the basis of the driving context of the vehicle using an input obtained from a navigation system."

VI. 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. It informed the appellant that it should be prepared to discuss *inter alia* the admissibility of its request under Article 12(4) RPBA and gave reasons for that. It also raised objections under Article 123(2) EPC and Article 84 EPC 1973 which might need to be discussed if the appellant could convince the board that the claims filed with the statement of grounds of appeal should be admitted into the appeal proceedings.

VII. With a reply letter dated 25 September 2015 the appellant withdrew its auxiliary request for oral proceedings and requested a decision according to the state of the file according to the Guidelines for Examination in the European Patent Office C-V, 15. The appellant provided no substantive comments on the board's communication.

VIII. The board then cancelled the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. *Admission of the appellant's request
(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 and requests which could have been presented ... in the first instance proceedings", everything presented by the parties under Article 12(1)

RPBA must 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 the established case law, Article 12(4) RPBA empowers the boards in *ex parte* appeal proceedings to refuse to admit requests which could have been presented in the first-instance proceedings (see Case Law of the Boards of Appeal of the EPO, 7th edition 2013, IV.E.4.3.1 and IV.E.4.3.3b).
- 2.3 It is undisputed that present claims 1 to 3, which were filed with the statement of grounds of appeal, were not submitted in the first-instance proceedings. In particular, present claim 1 has been amended (with respect to claim 1 underlying the decision under appeal) to no longer include the feature "such that the road surface appears brighter than the verges". According to the appellant's submission in the first-instance proceedings, this feature, in context, was one of the main reasons why the then claimed subject-matter involved an inventive step (see its letter of reply dated 14 August 2008). Also, the structural feature of a multi-position switch, which allows the user to give the necessary input to change the assignment of grey values to the temperature of objects in the image, is no longer present in claim 1. Thus, the present claims have been substantially amended compared with the sole claim underlying the decision under appeal.
- 2.4 In fact, the present set of claims is not based on the sole claim underlying the decision under appeal. Instead, as confirmed in point 2 of the statement of grounds of appeal, it is based on the earlier set of claims 1 to 5 filed with the letter of reply dated

- 22 August 2006 to the first communication of the examining division pursuant to Article 96(2) EPC. Indeed, present claim 1 corresponds essentially to the combination of claims 1, 4 and 5 filed with that reply.
- 2.5 In view of the above, the present set of claims could have been presented in the first-instance proceedings, for instance in reaction to the first communication of the examining division pursuant to Article 96(2) EPC. This communication dealt in detail with most of the features of present claim 1. Moreover, the applicant, in reply to the second communication dated 17 March 2008, withdrew the claims filed with the letter of 22 August 2006 and filed instead a new sole claim 1 according to its sole request, on which the decision under appeal is based. In doing so, the applicant chose to move away from the aspects of the assignments table in the memory and the user-operated input means effecting a selection of one of the assignments in the assignments table. The applicant instead chose to focus on the aspect that the assignment results in the road surface appearing brighter than the verges.
- 2.6 By returning, with the statement of grounds of appeal, to a set of claims which is based on the set of claims filed with the letter of reply dated 22 August 2006, the appellant confronts the board with subject-matter on which no decision was taken by the department of first instance.
- 2.7 Thus, if the board of appeal were to admit and consider the present set of claims according to the sole request, it would have to go beyond its primary role, namely the examination of the contested decision (see point 4 of the Reasons of decision G 10/93 of the Enlarged Board of Appeal, OJ EPO 1995, 172).

2.8 On the other hand, a remittal to the department of first instance for further prosecution would be contrary to the need for procedural economy, as it would lead to the examining division having to take a decision on issues which could already have been decided in the oral proceedings before the examining division scheduled for 29 June 2010, had the applicant not replaced the set of claims of 22 August 2006 and requested a decision "in accordance with the state of the file", which prompted the examining division to cancel the oral proceedings.

In particular, it would not serve procedural economy to return to a state of the proceedings that was essentially already reached in the early phase of the first-instance proceedings, in 2006, when the examination division issued the first communication (see point 2.5 above).

2.9 The appellant has not submitted any arguments as to why its sole request should be admitted into the appeal proceedings or why it could not have been presented in the first-instance proceedings.

2.10 In view of the above, the board, exercising its discretion under Article 12(4) RPBA, decided to not admit the appellant's sole request filed with the statement of grounds of appeal.

3. In view of section 2 above, there are no appellant's requests in the appeal proceedings. Thus there is no version approved by the appellant within the meaning of Article 113(2) EPC 1973 on which a patent could be granted. Hence the decision 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 Chairwoman:



K. Boelicke

T. Karamanli

Decision electronically authenticated