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Datasheet for the decision of 16 June 2015

Case Number: T 2001/14 - 3.4.03

Application Number: 09159210.5

Publication Number: 2088476

IPC: G03G15/08, G03G21/18

Language of the proceedings: EN

Title of invention:
Image forming apparatus, cartridge detachably mountable to the image forming apparatus, developer remainder displaying method and system

Applicant:
Canon Kabushiki Kaisha

Headword:

Relevant legal provisions:
EPC Art. 108 sentence 3, 111(1)
EPC R. 99(2), 101(1), 137(3), 71(3)
RPBA Art. 13(1), 12(2), 15(1), 12(4)
EPC 1973 R. 86(3)

Keyword:
Admissibility of appeal - (yes)
Late-filed request - admitted (no) -
main request, first and second auxiliary requests
Remittal to the department of first instance - (yes)

Decisions cited:
G 0007/93, J 0022/86, T 0213/85, T 0162/97, T 0509/07

Catchword:
Reasons, points 1.6 and 1.7 and point 3.1

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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 2001/14 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 16 June 2015

Appellant: (Applicant)	Canon Kabushiki Kaisha 30-2 Shimomaruko 3-chome Ohta-ku Tokyo 146-8501 (JP)
Representative:	TBK Bavariaring 4-6 80336 München (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 12 May 2014 refusing European patent application No. 09159210.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	G. Eliasson
Members:	T. M. Häusser
	T. Karamanli

Summary of Facts and Submissions

I. The appeal concerns the decision of the examining division refusing European patent application No. 09159210.

II. The examining division issued a communication under Rule 71(3) EPC dated 30 July 2012 informing the applicant that it intended to grant a patent on the basis of a set of claims of a sole request submitted by the applicant during oral proceedings before the examining division.

III. The applicant did not consent to the text proposed for grant but instead, with a letter dated 10 December 2012, submitted claims of a new main request and requested the grant of the patent on the basis of these claims, or, as an auxiliary request, based on the claims as indicated in the communication under Rule 71(3) EPC.

IV. By a letter dated 12 December 2012, the applicant withdrew the "auxiliary request as of December 10, 2012".

V. In a communication dated 2 January 2013, the examining division expressed its preliminary view that, prima facie, claim 1 of the main request then on file would lead to objections that had already been overcome during oral proceedings and that, considering that two auxiliary requests had already been discussed during the oral proceedings, the applicant was not considered to be entitled to call into question the outcome of the previous course of the proceedings. It further informed the applicant that the application would be refused under Article 90(5) and Rule 137(3) EPC.

VI. With a letter dated 13 May 2013, the applicant submitted claims of a new auxiliary request 1.

VII. In its decision the examining division exercised its discretion as provided for in Rule 137(3) EPC and did not consent to the amendments to the claims of the main request filed with the letter dated 10 December 2012 and of the auxiliary request 1 filed with the letter dated 13 May 2013. The examining division gave reasons in the decision under appeal why it refused its consent to these amendments, which replaced the text of the application on the basis of which a patent could have been granted according to the communication under Rule 71(3) EPC dated 30 July 2012. Since only the claims according to the main request and the auxiliary request 1 were then on file, the application was refused.

VIII. The applicant (appellant) appealed against the decision of the examining division.

Within the two-month period under Article 108, first sentence, EPC, a notice of appeal was filed and the prescribed appeal fee was paid (Article 108, first and second sentences, EPC). The statement setting out the grounds of appeal was filed within the four-month period under Article 108, third sentence, EPC.
In the statement of grounds of appeal, the appellant did not challenge the legal basis given in the appealed decision, nor did it give any reasons why the decision under appeal was wrong. In particular, no reason was given as to why, in the given circumstances of the present case, the division had not exercised its

discretion under Rule 137(3) EPC in accordance with the right principles.

Instead, with the statement of grounds of appeal, the appellant filed new amended claims according to a main request and a first auxiliary request, as well as new claims according to a second auxiliary request, the claims being "identical with the statement of claim set out in the Official Communication under Rule 71(3) EPC".

IX. The board sent a communication under Article 15(1) RPBA annexed to the summons to oral proceedings.

In that communication, the board expressed doubts that the appeal was admissible since the statement of grounds of appeal appeared unsubstantiated and thus seemed not to comply with the requirements of Article 108, third sentence, and Rule 99(2) EPC.

The board also stated that the claims according to the second auxiliary request filed with the statement of grounds of appeal were identical to the claims which formed the basis for the communication under Rule 71(3) EPC dated 30 July 2012 and this fact could play a role for the question whether the appeal was admissible in view of the jurisprudence of the boards of appeal.

The board also informed the appellant that, if the appeal was found admissible, the debate would continue in the oral proceedings on the allowability of the appeal and that the first issue for discussion on the allowability of the appeal would be the admission of the requests in view of Article 12(4) RPBA. The board expressed its view that the admissibility of the main request and the first auxiliary request then on file

was highly doubtful whereas the second auxiliary request could be considered admissible because the claims of this request formed the basis on which the examining division intended to grant a patent.

X. With a letter dated 13 May 2015, the appellant filed new claims according to a new main request and according to new first to third auxiliary requests.

XI. At the oral proceedings before the board the appellant (applicant) requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 5 of the main request, or claims 1 to 4 of the first auxiliary request, or claims 1 to 4 of the second auxiliary request, or claims 1 to 3 of the third auxiliary request, all requests filed with letter dated 13 May 2015.

XII. The wording of the independent claims of the various requests is as follows:

Main request:

Claim 1 of the main request differs from claim 1 of the third auxiliary request in that the features "and a developer amount detecting means" and "a display (25) for displaying said level (A) calculated by said calculating means (62)" are deleted and the expression "as a rate of the amount of the developer detected by said developer detecting means" in the feature relating to "calculating means ..." is replaced by the expression "as a rate of a detected amount of the developer".

First auxiliary request:

"1. An image forming apparatus (A) to which a first unit (B1) and a second unit (B2) each including a developer container (4) and a memory element (31) storing information are selectively detachably mountable, wherein said developer container (4) of said first unit (B1) contains a first amount of a developer in an unused state, and said developer container (4) of said second unit (B2) contains a second amount of a developer in an unused state, the second amount being larger than the first amount, said apparatus (A) comprising:

a main assembly to which said first unit (B1) and said second unit (B2) are selectively detachably mountable;

wherein said memory element (31) of said first unit (B1) and said second unit (B2) store information related to amounts of the developer accommodated in said developer containers (4) in unused states, respectively, and

calculating means for calculating a level (A) of the remaining developer amount to be displayed based on information relating to an after-use amount of the developer accommodated in said developer container (4) of said mounted unit (B1, B2),

characterized in that

said calculating means is adapted to calculate the level, as a ratio of the after-use amount of the developer accommodated in said developer container (4) of said first or second unit (B1, B2) mounted to the main assembly to the amount of the developer accommodated in said developer container (4) of said mounted unit (B1, B2) in the unused state, using the information stored in said memory element (31) and the information relating to the after-use amount of the developer accommodated in said developer container (4) of said mounted unit (Bl, B2)."

Second auxiliary request:

Claim 1 of the second auxiliary request differs from claim 1 of the third auxiliary request in that the feature "a display (25) for displaying said level (A) calculated by said calculating means (62)" is deleted.

Third auxiliary request:

The claims of the third auxiliary request are identical to those forming the basis of the communication under Rule 71(3) EPC (see point II. above). In particular, claim 1 of the third auxiliary request reads as follows:

"1. An image forming apparatus (AS) comprising

a main assembly to which a unit (B1, B2) is detachably mountable,

said unit having a developer container, a memory (31) adapted to store information relating to the lifetime of said unit, wherein the information relating to the lifetime relates to the amount of the developer originally filled in the developer container or to a number of prints which can be produced by said unit initially and a developer amount detecting means,

said image forming apparatus further comprising

a controller (33) for effecting reading lifetime information from said memory (31),

calculating means (62) adapted for calculating a level (A) of the remaining developer amount to be displayed, as a rate of the amount of the developer detected by said developer amount detecting means and the information relating to the lifetime stored in said memory (31), and

a display (25) for displaying said level (A) calculated by said calculating means (62)."

XIII. The appellant argued as follows:

a) Admissibility of the appeal

The claims of the second auxiliary request filed with the statement of grounds of appeal could be understood as an attempt to remedy the fact that there was no allowable request on file. The amendments evidently overcame the grounds for the decision so that the appeal was admissible.

b) Admissibility of the requests

The new sets of claims were a reaction to the board's communication. As it could be deduced from this communication that the former second auxiliary request was the most promising request, the new sets of claims were based on that request. Furthermore, the new sets of claims were filed late for procedural economy, as this avoided the examining division having to deal with a large number of auxiliary requests.

The new requests should therefore be admitted into the appeal proceedings.

Reasons for the Decision

1. Admissibility of the appeal

1.1 According to Article 108, third sentence, EPC a statement setting out the grounds of appeal must be filed in accordance with the Implementing Regulations

within four months of notification of the decision. Furthermore, Rule 99(2) EPC provides that in the statement of grounds of appeal the appellant must indicate the reasons for setting aside the decision, or the extent to which it is to be amended and the facts and evidence on which the appeal is based.

1.2 It is an established general principle that the grounds for appeal should specify the legal or factual reasons on which the case for setting aside the decision is based. The arguments must be clearly and concisely presented to enable the board to understand immediately why the decision is alleged to be incorrect, and on what facts the appellant bases his arguments, without first having to make investigations of its own (see Case Law of the Boards of Appeal of the European Patent Office, 7th edition, September 2013, section IV.E.2.6.3 a)). Moreover, the grounds of appeal must deal with the main reasons given for the contested decision (see, for example, T 213/85, OJ EPO 1987, 482, point 3 of the Reasons).

1.3 The examination of whether the requirements of Article 108, third sentence, and Rule 99(2) EPC are met has to be made on the basis of the statement of grounds of appeal and of the reasons given in the contested decision, taking into account any amendments made to the claims (see for example J 22/86, OJ EPO 1987, 280, point 2 of the Reasons; T 162/97, point 1.1.2 of the Reasons).

1.4 In the present case the examining division exercised its discretion as provided for in Rule 137(3) EPC and did not consent to the amendments to the claims of the main request filed with the letter dated 10 December 2012 and of the auxiliary request filed with the letter

dated 13 May 2013. The examining division gave reasons in the decision under appeal why it refused its consent to these amendments, replacing the text of the application on the basis of which a patent could have been granted according to the communication under Rule 71(3) EPC dated 30 July 2012. Since only the claims according to the main request and the auxiliary request were then on file, the application was refused.

1.5 In decision G 7/93 (see point 2.6 of the Reasons) the Enlarged Board of Appeal stated that if an examining division has exercised its discretion under Rule 86(3) EPC 1973 (which corresponds to Rule 137(3) EPC) against an applicant in a particular case and the applicant files an appeal against the way in which such discretion was exercised, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the first-instance department, in order to decide whether or not it would have exercised such discretion in the same way as the first-instance department. The Enlarged Board of Appeal added that if a first-instance department is required under the EPC to exercise its discretion in certain circumstances, such a department should have a certain degree of freedom when exercising that discretion, without interference from the boards of appeal and that a board of appeal should only overrule the way in which a first-instance department has exercised its discretion if it comes to the conclusion either that the first-instance department in its decision has not exercised its discretion in accordance with the right principles, or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion.

1.6 In the statement of grounds of appeal, the appellant did not challenge the legal basis given in the appealed decision, nor did it give any reasons why the decision under appeal was alleged to be wrong. In particular, no reason was given as to why, in the circumstances of the present case, the appellant thought that the division had not exercised its discretion under Rule 137(3) EPC in accordance with the right principles or had exercised its discretion in an unreasonable way. Since the appellant did not provide in the statement of grounds of appeal any reasons as to why the decision was alleged to be incorrect, the reasoning contained in the statement is insufficient to meet the requirements of Article 108, third sentence, and Rule 99(2) EPC. This would usually mean that the appeal has to be found inadmissible (Rule 101(1) EPC).

1.7 With the statement of the grounds of appeal, the appellant filed new amended claims according to a main request and a first auxiliary request, as well as new claims according to a second auxiliary request. The claims according to this second auxiliary request are indicated as being "identical with the statement of claim set out in the Official Communication under Rule 71(3) EPC dated July 13, 2012 [sic]".
In its decision, the examining division exercised its discretion under Rule 137(3) EPC and refused its consent to replace the text of the application on the basis of which a patent could have been granted by the requests then on file. These reasons for refusing the examining division's consent apparently do not apply to the claims of the second auxiliary request, filed with the statement of grounds of appeal, since these claims relate to precisely the claims intended for grant according to the communication under Rule 71(3) EPC dated 30 July 2012.

In view of the above, the mere filing of the second auxiliary request is to be interpreted as removing the factual basis for the refusal, thereby overcoming the reasons for the refusal.

In these exceptional circumstances, the requirements of Article 108, third sentence, and Rule 99(2) EPC are considered to be met in respect of the second auxiliary request.

1.8 Since the admissibility of an appeal can only be assessed as a whole (see T 509/07, point 1.4 of the Reasons) the appeal is admissible.

2. Admission of the main request and the first and second auxiliary requests, all requests filed with letter dated 13 May 2015.

2.1 According to Article 12(2) RPBA, the statement of the grounds of appeal must contain a party's complete case. Any amendment to a party's case after it has filed its grounds of appeal may, according to Article 13(1) RPBA, be admitted and considered at the board's discretion. The discretion must be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

2.2 The sets of claims submitted as the main request and as first and second auxiliary requests were filed with the letter dated 13 May 2015 in reply to the board's communication under Article 15(1) RPBA about one month before the oral proceedings. Hence the amendments to the appellant's case were filed after the statement of the grounds of appeal. The new requests are therefore

an amendment to the appellant's case within the meaning of Article 13(1) RPBA. Consequently, the admission of these requests is at the board's discretion.

2.3 The appellant argued that the new sets of claims were a reaction to the board's communication. As it could be deduced from this communication that the second auxiliary request then on file was the most promising request, the new sets of claims were based on that request.

However, this argument does not apply to the set of claims according to the first auxiliary request, which evidently relates to subject-matter that is significantly different from the subject-matter claimed in the second auxiliary request underlying the board's communication (which corresponds to the present third auxiliary request).

Furthermore, it was already evident in the first-instance proceedings that the claims according to the former second auxiliary request were promising since they formed the basis for the communication of the examining division under Rule 71(3) EPC, informing the applicant that it intended to grant a patent. The communication under Article 15(1) RPBA of the board did not add anything in this respect as it related merely to the board's provisional opinion concerning procedural issues, namely the admissibility of the appeal and the admission of the requests then on file.

The claims of the main request and the first and second auxiliary requests are therefore not considered to be a response to points raised in the board's communication.

2.4 The appellant also argued that the new sets of claims were filed late for procedural economy, as this avoided the examining division having to deal with a large number of auxiliary requests.

However, if the present main request and the first and second auxiliary requests were admitted into the appeal proceedings, the board might well remit the case to the department of first instance for substantive examination of these requests in two instances. The examining division would then have to deal with the requests, while the conduct of the appellant would have led to a considerable delay in the proceedings. Furthermore, the examining division would possibly have to re-open substantive examination with the possible result of further communications and even a second refusal and subsequent appeal proceedings.

The filing of the claims of the main request and the first and second auxiliary requests at this late stage of proceedings is therefore considered to be contrary to the interests of procedural economy.

2.5 Furthermore, were the board to deal with the substantive examination of the claims according to the present main request and the first and second auxiliary requests, complex discussions might well ensue, in particular in relation to the requirements of clarity and the basis in the original application documents as well as novelty and inventive step. This is for example to be expected in relation to the features deleted as compared to the subject-matter of claim 1 of the present third auxiliary request, e. g. those relating to the display.

2.6 In view of the above considerations, exercising its discretion under Article 13(1) RPBA, the board does not admit the main request and first and second auxiliary requests into the proceedings.

3. Admission of the third auxiliary request filed with letter dated 13 May 2015 and further procedure

3.1 The third auxiliary request was filed after the statement of the grounds of appeal and it is therefore an amendment to the appellant's case within the meaning of Article 13(1) RPBA. However, since the claims of the present third auxiliary request are identical to those of the second auxiliary request, filed with the statement of grounds of appeal, it is appropriate for the board to also consider the provisions of Article 12(4) RPBA when exercising its discretion under Article 13(1) RPBA.

The claims according to the present third auxiliary request are also identical to the claims which formed the basis for the communication under Rule 71(3) EPC dated 30 July 2012. In these exceptional circumstances, the board sees no reason *not* to admit the third auxiliary request under Article 12(4) RPBA although this request was withdrawn in the first-instance proceedings and re-filed with the statement of grounds of appeal. Therefore the board admits the third auxiliary request into the proceedings.

3.2 Since the claims of the third auxiliary request are identical to those forming the basis on which the examining division intended to grant a patent, it is considered to be appropriate to remit the case to the department of first instance for further prosecution on

the basis of the present third auxiliary request (Article 111(1) EPC).

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.

The Registrar: The Chairman:

S. Sánchez Chiquero G. Eliasson

Decision electronically authenticated