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**Datasheet for the decision
of 24 May 2016**

Case Number: T 0368/15 - 3.2.05

Application Number: 08150986.1

Publication Number: 1964805

IPC: B42C1/12, B65H45/30

Language of the proceedings: EN

Title of invention:

Sheet folding and creasing apparatus allowing intermittent relative movement between the sheets and the creasing unit

Applicant:

Canon Kabushiki Kaisha

Relevant legal provisions:

EPC Art. 84, 123(2)

RPBA Art. 13(1)

Keyword:

Admissibility of the main request (no)

Admissibility of the amendments of the auxiliary request (yes)

Clarity of the auxiliary request (yes)

Remittal to the department of first instance (yes)



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Case Number: T 0368/15 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 24 May 2016

Appellant: Canon Kabushiki Kaisha
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 30 September 2014 refusing European patent application No. 08150986.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman S. Bridge
Members: O. Randl
J. Geschwind

Summary of Facts and Submissions

- I. This appeal lies against the decision of the examining division to refuse European patent application No. 08 150 986.1.

The examining division had found both the main request and the first auxiliary request before it to lack clarity.

- II. Oral proceedings before the board took place on 24 May 2016.

- III. The appellant (applicant) requested that the decision under appeal be set aside and a patent be granted on the basis of the new main or the amended auxiliary request filed during the oral proceedings.

The appellant also requested the board to decide on all substantive matters (including novelty and inventive step) and not to remit the case to the examining division for further prosecution.

Finally, the appellant asked the board to decide on amendments of the description which the examining division had suggested and which the appellant was unwilling to accept.

- IV. Claim 1 of the new main request reads:

"A sheet processing apparatus (500) comprising: folding means (810a, 810b, 830) for performing a folding process on a sheet or on a bundle of sheets made up of a plurality of sheets;

a creasing unit (860) for pressing a folded portion of the sheet or the bundle of sheets folded by the folding means (810a, 810b, 830);

moving means (M6, 868) for bringing about relative movement between the creasing unit (860) and the folded sheet, or between the creasing unit and the folded bundle of sheets in a direction parallel to a fold of the folded sheet or the bundle of folded sheets while the folded sheet or bundle of folded sheets is being pressed by said creasing unit;

characterised by controlling means (515) adapted to control the moving means so that phases of the relative movement and at least one stoppage of the relative movement are automatically performed alternately, while the folded sheet or bundle of folded sheets is being pressed by said creasing unit (860), at least one said stoppage being at a stop position intermediate between end positions of the relative movement."

Claims 1 and 8 of the amended auxiliary request read:

"1. A sheet processing apparatus (500) comprising:
folding means (810a, 810b, 830) for performing a folding process on a sheet or on a bundle of sheets made up of a plurality of sheets;
a creasing unit (860) for pressing a folded portion of the sheet or the bundle of sheets folded by the folding means (810a, 810b, 830) by nipping the folded portion between a pair of press rollers (861a, 861b);
moving means (M6, 868) for bringing about relative movement between the creasing unit (860) and the folded sheet, or between the creasing unit and the folded bundle of sheets in a direction parallel to a fold of the folded sheet or the bundle of folded sheets while the folded sheet or bundle of folded sheets is being pressed by said creasing unit;

characterised by controlling means (515) adapted to control the moving means so that the relative movement and at least one stoppage of the relative movement are automatically performed alternately, while the folded sheet or bundle of folded sheets is being pressed by said creasing unit (860), at least one said stoppage nipping the folded portion at a stop position intermediate between opposite ends of the fold."

"8. The sheet processing apparatus according to any preceding claim, wherein said controlling means (515) is operable, when a plurality of sheets or bundles of sheets forming a job are folded one after the next by the folding means, to control the moving means without any stoppage during the processing by the creasing unit of a last one of the plurality of folded sheets or bundles of folded sheets forming the job."

V. The appellant (applicant) argued as follows:

(a) New main request

The request is filed because the appellant would prefer not to limit claim 1 to the structure with two rollers. It should be admitted because the appellant realised in the course of the oral proceedings that the board had objections in respect of Article 123(2) EPC (rather than clarity objections) against the (former) main request filed before the oral proceedings. The appellant had realized that there were other promising ways of overcoming the original clarity objections of the board when studying the case in depth in view of the oral proceedings.

The new main request addresses the need for an unambiguous definition of the stop position. "Relative

movement" is to be understood as the whole movement between the extremes; the "phases" of the relative movement are portions of the whole movement. An intermediate position between the extremes does not depend for its clarity on the particular structure of the creasing unit. A reference position on the creasing unit will move between the end points, and it can be established where the stoppage occurs. Thus the clarity problem can be solved without there being a need for claiming a particular structure of the creasing unit.

Referring to "phases" (or "parts" or "portions") seems helpful to clarify that the relative movement is the whole movement (the total travel) between the end points. There is no explicit disclosure of "phases" in the original application, but this feature can be derived from Figure 20:

FIG. 20

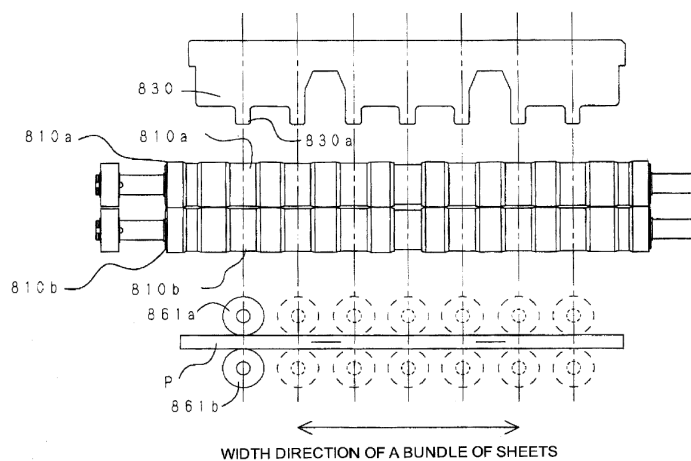


Figure 20 shows the stop positions; each interval between the stop positions defines a phase of movement.

End positions are also mentioned in paragraph [0005] in the context of the prior art.

(b) Remittal to the examining division

There is no need to remit the case to the examining division for further prosecution because it is clear that the examining division will find the claims allowable.

In the course of the examination proceedings, there had been a telephone interview in August 2012 in the course of which the examiner had declared claim 1 to be allowable. The appellant had been surprised to see that the subsequent communication under Rule 71(3) EPC nevertheless contained amendments of claim 1. It is, however, clear that those amendments were only made in order to clarify the claim and not in order to restore novelty or inventive step.

Therefore, a remittal would only mean further delays in a case which has taken four years already, despite attempts to accelerate the proceedings.

(c) Amendments of the description

There had been a disagreement between the examining division and the appellant as to whether the description should be amended by deleting the expression "and the like", which occurs three times in the description (page 1, lines 13-14; page 10, line 18; page 11, line 21); see point 15 of the Minutes of the oral proceedings before the examining division. The initial objection against this expression concerned clarity, but during the oral proceedings the chairman had raised objections under Article 83 EPC. The appellant reluctantly accepted to carry out those amendments (point 17 of the Minutes) in order to bring

the then second auxiliary request into an allowable condition.

Reasons for the Decision

1. Admissibility of the new main request

The new main request was filed in the course of the oral proceedings, after the board had found that claim 1 of the (former) main request filed on 18 May 2016 did not comply with the requirements of Article 123(2) EPC, whereas claim 1 of the amended auxiliary request did fulfil these requirements.

The board has doubts that the objection under Article 123(2) EPC could have come as a surprise to the appellant, because claim 1 had been amended using a feature ("a roller") that is disclosed in the description of the original application only in the context of the discussion of some prior art. An appellant basing an amendment on such a basis must be aware that the amendment will be challenged under Article 123(2) EPC and might be found not to meet the requirements of this Article.

The filing of the request cannot, therefore, be said to have been triggered by unexpected findings of the board, all the more as the board had found the amended auxiliary request to comply with the requirements of Article 123(2) EPC. Rather, as the appellant explained, the new main request was motivated by the desire to obtain a scope of protection that exceeded the scope of the amended auxiliary request.

Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) stipulates that any amendment to a

party's case after it has filed its grounds of appeal or reply 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 submitted, the current state of the proceedings and the need for procedural economy.

Claim 1 of the new main request introduces the notion of "phases" of the relative movement. Although the skilled person would understand what is meant by alternately performing relative movements and stoppages, it is not clear to the board what exactly is meant by performing phases of the relative movement.

Claim 1 of the new main request also appears to redefine the notion of "relative movement" between the creasing unit and the folded sheet. The natural meaning of "relative movement" is the relative change of position of the creasing unit with respect to the sheet. Claim 1 of the new main request refers to "end positions of the relative movement", which suggests that the relative movement is now understood as a domain of relative displacement with well-defined boundaries or end positions. The appellant confirmed this understanding of "relative movement". The board, however, cannot see any basis for this redefinition in the original application.

Moreover, whenever a stoppage of the relative movement occurs, the relative movement can be said to have reached an end position. Whether such an end position is intermediate between (further) end positions of the relative movement depends on the further relative movement.

In view of the above, the board notes that claim 1 of the new main request raises complex questions in respect of the admissibility of the amendments and the clarity of the claims. Claim 1 cannot be said to be *prima facie* clear and compliant with the requirements of Article 123(2) EPC. As a consequence, the board has availed itself of its discretion under Article 13(1) RPBA and has decided not to admit the new main request into the proceedings.

2. Amended auxiliary request

2.1 Admissibility of the amendments

2.1.1 Claim 1

Claim 1 was amended by introducing the feature according to which the folded portion is nipped "between a pair of press rollers".

The board is satisfied that the amendment has a sufficient basis in the original application. The only embodiment of the invention comprises a pair of press rollers 861a and 861b (see, for instance, Figures 17 to 20 as well as the corresponding part of the description).

2.1.2 Claim 8

Claim 8 was amended by introducing two references to a job formed by a plurality of sheets or bundles of sheets. This amendment is supported by the disclosure of paragraph [0135] of the original application.

2.1.3 Conclusion

The board has reached the conclusion that the amended auxiliary request complies with the requirements of Article 123(2) EPC.

2.2 Clarity

2.2.1 Claim 1

The board is satisfied that claim 1 is clear. Because of the amended wording, the sole objection raised by the examining division (see point 1.1 of the decision under appeal) does not apply to claim 1 of the amended auxiliary request.

The board is not aware of any other lack of clarity in respect of claim 1.

2.2.2 Claim 8

By introducing the notion of a job and defining the "last one" of the sheets with respect to this job, the appellant has overcome the clarity objection raised by the examining division (see point 1.2 of the decision under appeal).

2.2.3 Conclusion

The board has reached the conclusion that the amended auxiliary request complies with the requirements of Article 84 EPC.

3. Remittal to the examining division

The amended auxiliary request has never been presented to the examining division.

The examining division has issued a communication pursuant to Rule 71(3) EPC on 6 December 2012. In its communication dated 28 November 2013 it has also expressed the opinion that the subject-matter of the the then second auxiliary request filed during the oral proceedings of 6 November 2013 met the requirements of the EPC. However, both sets of claims which the examining division had found to be allowable differ from the amended auxiliary request and contain limiting features which are not part of claim 1 of the amended auxiliary request. Therefore, contrary to the assertion of the appellant, the finding of allowability regarding those former sets of claims does not necessarily apply to the subject-matter of the amended auxiliary request.

As a consequence, the board is of the opinion that the most appropriate way of proceeding is to remit the case to the examining division for further prosecution based on the amended auxiliary request, rather than to order the grant of a patent based on that request.

The board notes the appellant's need for speedy proceedings and its complaints regarding the duration of the proceedings so far. However, it has to be said that the procedural behaviour of the appellant (requesting a further communication to be issued after the oral proceedings and then withdrawing the sole request that had been found to be allowable) has also contributed to the duration of the proceedings. The Minutes of the oral proceedings (point 20) mention that this course of action had been agreed upon. The

appellant has not requested the examining division to correct the Minutes, which means that the board cannot take account of the assertion of the appellant that this statement of the Minutes is incorrect.

The board also wishes to add that the present appeal proceedings have been conducted very swiftly so as to shorten the overall proceedings as far as possible.

4. Amendment of the description

The appellant has requested the board to decide on amendments of the description which the examining division had made in the *Druckexemplar* (triple deletion of the expression "and the like") and which the appellant did not find acceptable.

The appropriateness of these amendments appears to have been discussed during the oral proceedings before the examining division (see point 15 of the Minutes) but the decision is silent on this matter. Therefore, the board cannot see any legal basis for the board deciding on the amendments in a way that would be binding on the examining division. Therefore, this request cannot be granted.

This notwithstanding, the board wishes to add, as an *obiter dictum*, that it does not see any good reason why the examining division would require the appellant to delete the three occurrences of the expression "and the like" in the description (page 1, lines 13-14; page 10, line 18; page 11, line 21). An objection against the use of such a vague expression in a claim would be justified, because the expression would make the claim unclear, but, as a rule, the same does not hold true for the description. In the present case the board

cannot see any - direct or indirect - impact of the use of the expression in the description on the claimed subject-matter. The invitation to delete the expression, therefore, appears to be unfounded.

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 the amended auxiliary request filed during the oral proceedings.

The Registrar:

The Chairman:



D. Meyfarth

S. Bridge

Decision electronically authenticated