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Aktenzeichen / Case Number / N° du recours : T 133/85  
Anmeldenummer / Filing No / N° de la demande : 80 302 390.2  
Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 022 680

Bezeichnung der Erfindung: Document handling apparatus and method  
Title of invention:  
Titre de l'invention :

Klassifikation / Classification / Classement : B65H 29/12, G03G 21/00

**ENTSCHEIDUNG / DECISION**

vom / of / du 25 August 1987

Anmelder / Applicant / Demandeur : Xerox Corporation

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Amendments/Xerox

EPO / EPC / CBE Articles 84, 123(2)  
Added subject-matter - Claim not supported by  
Kennwort / Keyword / Mot clé : description.

**Leitsatz / Headnote / Sommaire**

I. A claim which does not include a feature which is described in the application (on the proper interpretation of the description) as an essential feature of the invention, and which is therefore inconsistent with the description, is not supported by the description for the purpose of Article 84 EPC.

II. If such feature was described as an essential feature of the invention in the application as originally filed, an amendment to the description to provide support for such a claim (as in subparagraph I above) is not allowable under Article 123(2) EPC, because the amended description would contain subject-matter which extends beyond the content of the application as filed - namely information that such feature was not an essential feature of the invention.

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Chambres de recours



Case Number : T 133/85

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.1  
of 25 August 1987

**Appellant :** Xerox Corporation  
Xerox Square-020  
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New York 14644 (US)

**Representative :** Weatherald, K.B.  
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**Decision under appeal :** Decision of Examining Division 084  
of the European Patent Office  
dated 4 January 1985 refusing  
European patent application  
No. 80 302 390.2 pursuant to  
Article 97(1) EPC

**Composition of the Board :**

**Chairman :** P. Delbecque  
**Members :** C. Wilson  
G.D. Paterson

## Summary of Facts and Submissions

- I. European patent application No. 80 302 390.2 filed on 16 July 1980 and published on 21 January 1981 under publication No. 0 022 680 was refused by a decision of the Examining Division dated 4 January 1985. The decision was based on Claims 1-10 filed on 18 June 1984, and held that the amended independent method Claims 1 and 3, in omitting features originally disclosed as essential parts of the invention, have added subject-matter extending beyond the content of the application as filed, and therefore contravene the requirements of Article 123(2) EPC.
  
- II. During examination of the application, which is concerned with a method and apparatus for handling documents in a copying machine, the Examining Division in its first Communication dated 8 July 1982 objected to the claims as originally filed, in particular in respect of independent method Claim 10 on the basis that the claimed invention was not supported by the description. In reply, the Appellant filed a new set of method Claims 1 to 6, Claims 1 and 3 being independent claims, and minor amendments to these claims were subsequently filed on 18 June 1984. These Claims 1 and 3 (hereinafter "Claims A") were rejected by the Examining Division in its Decision dated 4 January 1985, as contravening Article 123(2) EPC.

The main reasoning in support of the rejection is set out in paragraph 1 of the Decision. In summary, the Examining Division held that the problem solved by the invention, according to both the original description and the original claims, was within the framework of a copier which carried out the copying in a particular order, i.e. in the first and last copying circulation of the documents only alternate documents are copied, while in all other copying circulations all documents are copied. In contrast, in

Claims 1 and 3 the order of copying is left open, and therefore it was held that these claims contain subject-matter which extends beyond the content of the application as originally filed.

III. A notice of appeal was filed on 11 February 1985 and the appeal fee was paid on the same date. In the Statement of Grounds filed on 4 May 1985, and in a further communication received on 25 November 1985, the Appellant made the following points:

- (i) If Article 123(3) EPC prohibits the broadening of claims of a granted European patent during opposition proceedings, then by implication the broadening of the claims of a pending application is permitted, subject to certain criteria.
- (ii) It is not the function of the claims to "contain subject-matter", that is the function of the description: the claims exist merely to define a patentable invention. Altering the scope of the claims without altering the contents of the description has no effect on the subject-matter contained in the application.
- (iii) The Appellant refers to Chapter VI, Section 5.4 of the "Guidelines for examination in the European Patent Office", and in particular to the statement therein that "the test for additional subject-matter therefore corresponds to the test for novelty given in IV, 7.2". He refers further to two previous decisions of the Technical Appeal Boards, namely T 52/82 and T 190/83.

- (iv) The statement in Section II, paragraph 2 of the impugned decision reading "It is not denied that the present claims would have been acceptable if they had been the originally-filed claims, since even if they were not specifically supported by the description, the claims themselves would have provided the basis for introducing the necessary support at a later stage", is an implicit agreement by the Examining Division that the present Claim 1 is supported by the original document.

The Appellant also filed inter alia a conditional submission B including a new independent Claim 1 corresponding essentially to the original Claim 10 modified in line with the suggestions made by the Examining Division in its communication dated 8 July 1982.

The claim reads as follows:

1. A method for recirculatively copying a set of simplex original documents in a copier (10) on to both sides of copy sheets for forming precollated duplex copy sets by circulating the documents in reverse (descending) serial page (N to 1) order beginning with the last sheet (N) and ending with the first sheet (1) thereof,

characterised by:

automatically determining if there is an odd or an even number of simplex original documents in the set, by counting the documents as they are circulated before they are copied;

copying this last (Nth) and subsequent alternative simplex documents if their number is even, or the next-to-last (N minus 1) and subsequent alternate simplex documents if their number is odd;

temporarily storing the alternatively-copied sheets, and representing them at the appropriate time to receive the appropriate images on their opposite sides;

in all intermediate copying circulations of the set, copying all the documents in the N to 1 order, and

in the last copying circulation of the set, copying the alternate simplex documents not copied during the first copying circulation, to provide properly-collated output duplex sets with consistent copy output inversion.

- IV. At the Oral proceedings held on 25 August 1987 at the Appellant's request, a new independent Claim C was filed as the Appellant's main request. Claim C reads as follows:

A method for recirculatively copying a set of simplex document sheets in a copier (10) on to both sides of copy sheets to make plural, properly-collated, duplex copy sheets, by plurally recirculating the documents for copying in reversed (descending) serial page order (N to 1), i.e. beginning with the last sheet (N) in the document set and ending with the first sheet, comprising the steps of:

counting the number of documents in the set as it is being circulated in an initial non-copying circulation automatically, in response to selection of duplex copying, to determine if the number of documents is odd or even;

in the first copying circulation of the documents, copying in the N to 1 order either the last (Nth) and subsequent alternate documents, or the next-to-last (N-1)th document and subsequent alternate documents, depending on whether the count is odd or even;

in all intermediate copying circulations of the documents, copying all the documents in the N to 1 order to produce duplex copy sheets, and in the last copying circulation, copying the alternate documents not copied on the first copying circulation on to the blank sides of the simplex copy set made in the immediately preceding copying circulation.

An objection was raised by the Board that, insofar as it was not made sufficiently clear in the claim that the last and subsequent alternate simplex documents are copied if the number of documents is even, and that the next-to-last and subsequent alternate simplex documents are copied if the number of documents is odd (i.e. it is always the even documents which are copied and stored), the claim goes beyond what is disclosed by the description. The Appellant argued that in his opinion he was entitled to cover in the claim both the case where even numbered sheets were copied and stored and the case where odd numbered sheets were copied and stored.

- V. At the end of the Oral proceedings, the Appellant requested that the impugned decision be set aside and that as a main request the application be granted on the basis of claim C submitted during the oral proceedings. As a subsidiary request, he requested grant of the application on the basis of the Claim 1 forming the subject of conditional submission B filed with the Statement of Grounds of Appeal on 4 May 1985.

### Reasons for the Decision

1. The appeal complies with Articles 106-108 EPC and with Rule 64 EPC and is admissible.
2. Article 84 EPC requires inter alia that the claims be supported by the description.

Objection can arise under this Article when a claim is so broad that it is not supported by the description of the invention. Such an objection can then be met either by narrowing the scope of the claim or, subject to Article 123(2), by amending the description.

Such an objection under Article 84 arose in the present case in respect of original Claims 1 and 10.

In the description as originally filed, the invention is described within a fairly narrow framework. After a general introduction in which various known copying systems are explained and defined, specific reference is made to a US patent (Adamek) as being concerned with a duplex copying system which is also a pre-collation copying system. It is then made clear at the top of page 3 that the present invention is an improvement over the Adamek patent, as follows:

"The present invention is an improvement over said Adamek Patent No. 4 116 558 for automatically achieving copying and storage of even page numbered copies of simplex documents in the duplex buffer tray to avoid variable output inversion or copying of a blank page when an odd number of simplex documents are being duplex copied, as indicated in that patent to be desirable, and for achieving



this feature under the further difficulty of copying the documents in reverse (descending) serial page order with a different type of document handling system."

In other words, at a very early stage in the description, it is stated that the invention includes as an essential feature an arrangement in which, regardless of whether there are an even or an odd number of documents to be duplex copied, it is always the even numbered documents which are copied and temporarily stored in a buffer. By the use of this arrangement, it is stated that the inversion and copying of a blank page, when an odd number of documents is to be copied, is avoided.

Following further pages of more specific description of the method and apparatus of the invention, at pages 11 onwards the nature of the invention is again described in a limited manner.

Thus, particular passages on pages 12, 13, 16 and 17 all relate to the fact that under the "present system" an additional inversion and copying of blank sheets is avoided.

It is therefore clear from a reading of the original description (on its proper interpretation) that it is an essential feature of the invention that the system is one in which only even-numbered sheets are sent to the buffer store.

However, the wording of the original method Claim 10 (and indeed the original apparatus Claim 1) is such as to cover methods in which after determining that there is an odd number of documents in the set, the last (N) and subsequent

alternate simplex documents would be copied. This would result in the odd-numbered sheets being copied and stored in the buffer store. In all the intermediate copying circulations of the set, this last (N) sheet would then be subjected to a copying run of its blank reverse side, and all sheets would require an additional inversion to produce properly-collated output duplex sets.

This Claim 10, insofar as it is not restricted to sending only even-numbered sheets to the buffer store, is clearly therefore inconsistent with, and not supported by, the original description, and was therefore open to objection under Article 84 EPC in this respect. This was clearly recognised by the Examining Division in paragraph 4(a) of its first Communication dated 8 July 1982. Although there was no specific reference to Article 84 EPC in the Communication, nevertheless the point was clearly made, and in the Board's view Article 84 EPC was clearly the basis for the Examining Division's objection.

Amendment to avoid this objection required the narrowing of the scope of Claim 10 (and also Claim 1). The original description of the invention nowhere contemplated a system in which odd numbered documents were copied and stored: on the contrary, the copying and storing of the even-numbered documents was described as being essential, in order to obtain the stated advantage of the invention. Thus, the alternative of amending the description to support such a broad claim was not available, since it would inevitably have resulted in the addition of subject-matter extending beyond the content of the application as filed. Such amendment of the description would have required the introduction of embodiments into the description in which odd-numbered sheets were sent to the buffer store. Such

embodiments were clearly not disclosed in the original application read as a whole, and their introduction would therefore have been contrary to Article 123(2) EPC.

3. As set out in paragraph II above, in reply to the objection of the Examining Division in its first Communication, the Appellant filed a new set of claims, including independent Claims 1 and 3, which (with subsequent minor amendments) were Claims A which were rejected in the Decision dated 4 January 1985, on the basis set out in paragraph II above. However, the Board notes that in a Communication dated 29 April 1983, which preceded the Decision, the objection to Claims 1 and 3 was phrased differently from the Decision itself: it was stated in the first sentence of the Communication that "Independent Claims 1 and 3 ... do not comply with Article 123(2) EPC, in that the scope of these claims is broader than the original main claims." While later in the Communication this sentence was qualified somewhat, it nevertheless seems to have led the Appellant into thinking that Claims A had been rejected primarily because the Examining Division considered that under Article 123(2) EPC claim broadening was not permissible. The first argument of the Appellant, both in his Statement of Grounds of Appeal, see paragraph III above, and initially in his oral argument, was therefore that Article 123(2) EPC does not necessarily prevent the broadening of claims during examination.
4. As the Board stated during the oral proceedings, in its view the wording of Article 123(2) EPC does not necessarily prohibit the broadening of a claim during examination so as to extend the protection conferred (in contrast to Article 123(3) EPC, which clearly does prohibit amendment of a claim in such a way as to extend the protection conferred, but which only applies during opposition

proceedings). Thus, outside opposition proceedings, and in particular during examination of an application, it is possible without contravening Article 123(2) EPC to broaden a claim (i.e. to extend the protection conferred by it), provided that the subject-matter which is within the claims for the first time as a result of the amendment was already disclosed within the content of the original application as filed. In this connection, see paragraph 5 below.

Nevertheless, the amended Claims A which were rejected in the Decision of the Examining Division in the present case not only extended the protection conferred by such claims, but also (and this was the ground for their rejection) resulted in the application containing subject-matter which extended beyond the content of the application as filed (see paragraph II above).

As a result of the Board's views as expressed early on during the oral proceedings, the Appellant submitted a new Claim C as his main request, and no longer contended for the claims which were rejected by the Decision of the Examining Division.

#### **Main request**

5. The claim filed during the oral proceedings and marked C is worded as set out in paragraph IV above. In considering the allowability of this amended claim, it is important to distinguish between a possible objection under Article 84 EPC and a possible objection under Article 123(2) EPC.

Article 84 EPC requires so far as relevant that the claims of a European patent application shall be supported by the description. This requirement must clearly be satisfied by the specification of every patent application if a patent

is to be granted, whether or not amendments to the description and claims have been proposed during the course of prosecution of an application.

The requirement of Article 84 EPC in respect of the claims of an application should be clearly distinguished from the provision in Article 123(2) EPC.

Article 123(2) EPC, in contrast to Article 84 EPC, is of course only concerned with determining the allowability of an amendment proposed during the course of prosecution of an application (or proposed during an opposition), and is not applicable if no amendment has been proposed.

However, it follows from the above that if an amendment to an application (either the description or the claims) is proposed, the application must be examined to ensure that the requirements of both Article 123(2) EPC and Article 84 EPC are met.

The requirement of Article 123(2) EPC is clearly different from the requirement of Article 84 EPC, both as a matter of wording and as a matter of substance.

As background to Article 84 EPC, it is noted that the description and the claims of a patent application have different functions. The primary function of the description is to enable a person skilled in the art thereafter to be able to carry out the invention. The primary function of the claims is to define the matter for which protection is sought in terms of the technical features of the invention (see Rule 29 EPC); thereafter the actual protection (i.e. the monopoly) given by a granted patent in each designated State is determined in accordance with Article 69 EPC by reference to the claims, ultimately by the courts of such States.

Thus, the requirement in Article 84 EPC that the claims shall be supported by the description is of importance in ensuring that the monopoly given by a granted patent generally corresponds to the invention which has been described in the application, and that the claims are not drafted so broadly that they dominate activities which are not dependent upon the invention which has been described in the application. On the other hand, Article 84 EPC clearly envisages (by the use of the word "supported") that the "matter for which protection is sought" can be defined in a generalised form, compared to the specific description of the invention. The permissible extent of generalisation from the description to the claims, having regard to the requirement of Article 84 EPC, is a question of degree and has to be determined, having particular regard to the nature of the invention which has been described, in each individual case.

In contrast, Article 123(2) EPC only requires to be considered when an amendment is proposed, either to the claims or to the description. For an amendment to be allowable, the application after amendment must not "contain subject-matter which extends beyond the content of the application as filed". Clearly the function of this provision is to prevent the addition of subject-matter to a patent application after the date of filing. In contrast, the reformulation of the same subject-matter as was originally present in an application as originally filed would be permissible under Article 123(2) EPC. Outside opposition proceedings (in which Article 123(3) EPC applies), such mere reformulation could include the broadening of the scope of the claims from their formulation as originally filed. In this particular connection, the statement made in the decision T 190/83,

dated 24 July 1984 (which was referred to by the Appellant), to the effect that the original application may be said to represent a reservoir upon which the applicant may draw to amend the application, appears apposite. However, in accordance with Article 123(2) EPC, the original application should be considered as a reservoir which cannot be expanded after the date of filing.

Having regard to the function of Article 123(2) EPC to prevent the addition of information after the filing date, earlier decisions of the Boards of Appeal have referred to the test for compliance with Article 123(2) EPC as "basically a novelty test" - see in particular Decision T 201/83 "Lead alloys/Shell" (OJ EPO 10/1984, page 481), at paragraph 3. While the Board agrees that the provision of Article 123(2) EPC requires in relation to any proposed amendment considerations which are basically similar to those which are involved in relation to the question of novelty of a claim, nevertheless in the Board's view care is necessary when applying the law relating to novelty to questions which arise in relation to the test under Article 123(2) EPC - namely that it is not permissible to amend "in such a way that (an application or patent) contains subject-matter which extends beyond the content of the application as filed." It is these words which must ultimately always be considered in each particular case.

In this connection the Appellant drew attention to and relied upon a statement in Decision T 52/82 "Winding apparatus/Rieter" (OJ EPO 10/1983, page 416, at paragraph 2), to the effect that it is incumbent on the Board to examine only whether the claim "is supported by the original document". As pointed out above, this consideration is not what is actually required by

Article 123(2) EPC. In the Board's view, it is not necessarily appropriate to use the word "supported" in relation to and as an analogy for the requirement of Article 123(2) EPC. The use of such analogy could in a particular case lead to the wrong result, because in the Board's view the requirement of Article 123(2) EPC is certainly closer to the requirement in relation to novelty than to the requirement of Article 84 EPC that the claims are "supported by" the description. It is possible to "support" something which is broad from a narrower base.

The distinction between the requirement of Article 123(2) EPC and the requirement of "support" in Article 84 EPC is most easily illustrated by reference to a chemical example. If the description of an application as filed describes the preparation of a novel chemical compound having particular properties, a claim as filed which defines that compound together with certain higher homologues might well normally be considered to be supported by such a description and thus to satisfy Article 84 EPC, if the skilled man would have no reason to doubt the soundness of such a generalisation. However, if both the description and the claims of the application as filed are limited to the preparation of one particular compound having particular properties, then a proposed amendment to include higher homologues either in the claims or the description or both would contravene Article 123(2) EPC, because the subject-matter of the amended application (including the higher homologues) would extend beyond the content of the application as filed (limited to the single compound). In contrast, if the description as originally filed disclosed the preparation of both the compound and certain higher homologues, but the claim as originally filed was limited to the one particular compound, an amendment which broadened the claim to include the certain higher



homologues would be allowable under Article 123(2) EPC because the subject-matter of the amended application would not extend beyond the content of the application as filed. (In opposition proceedings such a claim broadening amendment would not be allowable because of Article 123(3) EPC).

6. With the above considerations in mind, clearly in the circumstances of this case the allowability of the application on the basis of the proposed amended Claim C - the main request of the Appellant - must be considered both under Article 123(2) and under Article 84 EPC.

Insofar as Claim C requires a particular order of copying, which is in accordance with the original description, an objection under Article 123(2) EPC such as was taken against Claims A in the Decision dated 4 January 1985 is not applicable to Claim C.

However, Claim C is not restricted to a system in which only even-numbered documents are copied and stored in a buffer. It was the lack of such a restriction in the claims as originally filed which led to the original objection of the Examining Division under Article 84 EPC (see paragraph 2 above). In the Board's judgement, this objection was rightly taken by the Examining Division to the claims as originally filed, and for this same reason Claim C is not allowable because it contravenes Article 84 EPC.

Furthermore, in the Board's view it is clear that any amendment to the description so as to provide support for Claim C would not be allowable under Article 123(2) EPC, because such an amendment would necessarily contain subject-matter which would extend the content beyond that

as originally filed, insofar as it would refer to systems in which odd-numbered sheets were copied and stored as being within the scope of the invention. This would be information which is contrary to the description as originally filed, which made it clear that it was the even numbered sheets which were copied and stored - see paragraph 2 above.

On this basis, the main request is refused.

### **Subsidiary request**

7. Having regard to Claim 1 of the conditional submission B, it is observed that it corresponds essentially to the originally filed Claim 10 modified along the lines suggested by the Examiner, and could possibly, therefore, lead to the grant of a patent. However, since the Examining Division has not considered this claim in detail, it is in the Board's view proper procedure in respect of the rights of the Applicant that the question of patentability of the claim be considered by the first instance. Under these circumstances the Board deems it inappropriate to decide the issue but makes use of its power under Article 111(1) EPC to remit the case to the Examining Division for further prosecution.

### **Order**

**For these reasons, it is decided that:**

1. The decision of the Examining Division of the European Patent Office, dated 4 January 1985, is set aside.

2. The main request of the Appellant is refused.
3. The case is remitted to the first instance with the order to complete the examination of the application on the basis of Claim 1 of the conditional submission B.

The Registrar

The Chairman

F. Klein

P. Delbecque