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Aktenzeichen / Case Number / N° du recours : T 63/86

Anmeldenummer / Filing No / N° de la demande : 82 111 966.6

Veröffentlichungs-Nr. / Publication No / N° de la publication : 083 086

Bezeichnung der Erfindung: Method and apparatus for sensing and maintaining  
Title of invention: colour registration  
Titre de l'invention :

Klassifikation / Classification / Classement : B41 F13/12

### ENTSCHEIDUNG / DECISION

vom / of / du 10 August 1987

Anmelder / Applicant / Demandeur : Kollmorgen Technologies Corporation

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPO / EPC / CBE Articles 109, 111(1), Rule 86(3)

Kennwort / Keyword / Mot clé : "Substantially amended claims filed with  
statement of grounds of appeal" - "Remittal  
to Examining Division"

#### Leitsatz / Headnote / Sommaire

- I. The amendment of claims during an appeal from a decision to refuse a European patent application is a matter of discretion under Rule 86(3) EPC, final sentence.
- II. In a case where substantial amendments to the claims are proposed on appeal, which require substantial further examination, the case should be remitted to the Examining Division, so that such examination should be carried out, if at all, by the Examining Division after the latter has exercised its discretion under Rule 86(3) EPC, final sentence.

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : T 63/86

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.1  
of 10 August 1987

**Appellant :** Kollmorgen Technologies Corporation  
Suite 300, 2001 Bryan Tower  
Dallas  
USA - Texas 76201

**Representative :** Königseder, Claudia  
Zugspitzstrasse 65  
D-8104 Grainau

**Decision under appeal :** Decision of Examining Division 086  
of the European Patent Office  
dated 05.11.86 refusing European  
patent application No. 82 111 966.6  
pursuant to Article 97(1) EPC

**Composition of the Board :**

**Chairman :** P. Delbecque  
**Members :** G.D. Paterson  
M. Liscourt

**Summary of Facts and Submissions**

- I. European patent application No. 82 111 966.6 was filed on 23 December 1982.

On 1 October 1984, the Examining Division issued a Communication in which it was indicated that each of the twenty claims filed with the application appeared not to be allowable on the ground of lack of inventive step, having regard to two cited prior patent specifications. The Communication included an invitation to file a new set of claims including a main claim whose characterising portion was considered to differ from the prior art and to involve an inventive step. In any event, in accordance with the first sentence of Rule 86(3) EPC the Appellant had the right to amend the application at the same time as he filed a reply to that Communication.

In reply, on 15 January 1985 the Appellant filed a new set of ten claims and submitted reasons why Claim 1 involved an inventive step over the two cited specifications.

On 19 April 1985, the Examining Division issued a second Communication which indicated that the new Claim 1 lacked novelty over one of the two previously cited specifications, and in addition lacked inventive step over the other. It was further indicated that of the other nine new claims, four were unallowable for the reasons already set out in the first Communication, and the remainder were also unallowable for reasons there stated, mainly lack of inventive step. The Communication ended with a further invitation to file a new set of claims which were free of the deficiencies indicated, this being a limited form of

consent in accordance with the final sentence of Rule 86(3) EPC.

In reply, the Appellant filed a new Claim 1, which included Claims 2 and 3 of the claims filed on 14 January 1985, and as an auxiliary request, offered to include Claim 5 in Claim 1 as well.

On 5 November 1985, the Examining Division issued a Decision refusing the application, on the grounds essentially as set out in the second Communication.

- II. On 2 January 1986, a notice of appeal was filed, and the appeal fee paid. On 10 January 1986 the Appellant filed a statement of grounds of appeal together with a new set of Claims 1 to 16, which were described as "replacing all claims on file". The new Claim 1 does not appear to correspond to any particular combination of the claims previously filed. The statement of grounds of appeal contains various submissions traversing the reasoning of the Decision under appeal.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is admissible.
2. The Appellant has made it plain in the statement of grounds of appeal that he no longer wishes to apply for a European patent containing claims as previously examined and refused by the Examining Division; instead, he wishes to apply for a patent containing an amended set of claims. However, amendment of the claims of an application at the present

stage of examination is a matter of discretion governed by the final sentence of Rule 86(3) EPC, which states "No further amendment may be made without the consent of the Examining Division", that is, no further amendment without such consent after the opportunity to amend in reply to the first communication of the Examining Division has passed.

Thus, the fact that an appeal has been filed does not give the patent proprietor any right to amend his application as part of the appeal proceedings. The final sentence of Rule 86(3) EPC is still applicable.

Once an admissible appeal has been filed, the Board of Appeal has responsibility for the case in place of the Examining Division, and "can exercise any power within the competence of the department which was responsible for the decision appealed" (Article 111(1) EPC). Nevertheless, in a case such as the present, where substantial amendments to the claims have been submitted with the grounds of appeal, in the Board's view there are good reasons why the Board should not, at this stage, exercise the discretionary power under Rule 86(3) EPC in relation to such proposed amendments. The wording of the whole of Rule 86(3) EPC points specifically to the Examining Division. In cases of minor amendments filed during the appeal, it may be appropriate for a Board of Appeal to exercise the discretion of the Examining Division under Rule 86(3) EPC. However, in a case such as the present, where substantial amendments have been proposed which require a substantial further examination in relation to both the formal and substantive requirements of the EPC, such further examination should be carried out, if at all, by the Examining Division as the first instance, only after the Examining Division has itself exercised its discretion under Rule 86(3) EPC. In this way, the applicant's right to

appeal to a second instance is maintained, both in relation to the exercise of discretion under Rule 86(3) EPC, and (if such discretion is favourably exercised) in relation to the formal and substantive allowability of the amended claims.

3. In the present case, the Examining Division did not exercise its power to rectify its decision under Article 109 EPC. However, this fact is irrelevant to the exercise of discretion under Rule 86(3) EPC.
  
4. In the circumstances of this case, the Board has accordingly decided to exercise its power under Article 111(1) to remit this case to the Examining Division, in order that it should examine and decide:
  - (i) whether the further amendments to the claims, filed with the statement of grounds of appeal on 10 January 1986, can be made under Rule 86(3) EPC;
  
  - (ii) if such amendments can be made, whether such claims are allowable.

**Order**

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

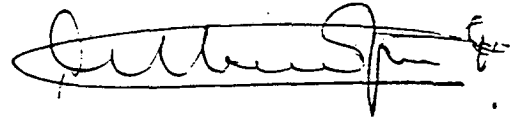
The case is remitted to the Examining Division for further prosecution in relation to the proposed amendments filed on 10 January 1986.

Registrar

*B.A. Norman*

B.A. Norman

Chairman



P. Delbecque

*Handwritten notes:*  
6/11/86  
H. H. G.