

A		B	X	C	
---	--	---	---	---	--

File Number: T 734/91 - 3.5.1
Application No.: 87 301 187.8
Publication No.: 0 234 809
Title of invention: Image processing apparatus

Classification: H04N 1/40

D E C I S I O N
of 7 April 1992

Applicant: CANON KABUSHIKI KAISHA

Headword:

EPC Articles 113(1), 111(1); Rule 67

Keyword: "Procedural violation; remittal to the first instance;
reimbursement of the appeal fee"



Case Number : T 734/91 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 7 April 1992

Appellant :

CANON KABUSHIKI KAISHA
30-2, 3-chome, Shimomaruko,
Ohta-ku
Tokyo (JP)

Representative :

Beresford, Keith Denis Lewis
BERESFORD & Co.
2-5 Warwick Court
High Holborn
London WC1R 5DJ (GB)

Decision under appeal :

Decision of Examining Division of the European
Patent Office dated 19 April 1991 refusing
European patent application No. 87 301 187.8
pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : R. Randes
W.M. Schar

Summary of Facts and Submissions

- I. By a decision of the Examining Division dated 19 April 1991, the Appellant's European patent application No. 87 301 187.8, filed on 11 February 1987, claiming priority from three previous applications in Japan, was refused.

- II. In the first and only communication according to Art. 96(2) and Rule 51(2) EPC dated 25 June 1990 the Examining Division had informed the Applicant of its grounds against the grant of a patent.

- III. The Applicant (now Appellant) had replied in the letter dated 4 January 1991 and filed a new and amended set of claims.

- IV. The decision of the Examining Division was taken on the basis of Claims 1 to 18, filed with said letter dated 4 January 1991, of which Claim 1 reads as follows (the Board has identified the features of the claim by the signs (a) to (e)):
 - (a) An image recording apparatus comprising:

 - (b) recording means for recording on a medium on the basis of n-bit image data an image having a multi-value for each pixel;

 - (c) image data providing means for providing image data having m-bits for each pixel;

 - (d) first conversion means for converting m-bit image data provided by said image data providing means into image data having n-bits ($n > m$) for each pixel; and

(e) second conversion means for converting n-bit image data converted by the first conversion means into n-bit image data appropriate to the characteristics of the recording means, the output of the second conversion means being the basis for recording of the image by the recording means.

V. The reason for the refusal was that the subject-matter of Claim 1 was considered not to be novel having regard to the disclosure of

D1: EP-A-0 024 902.

In the decision the Examining Division referred in its argumentation to the communication, dated 25 June 1990, wherein it had been stated that features (a), (c) and (d) were disclosed by D1. Moreover, it had been indicated therein that according to D1 a one-bit pixel bit stream was converted to a six-bit per pixel gray scale output. In the decision the Examining Division contests Appellant's (Applicant's) argumentation (letter filed on 4 January 1991) that D1 "is not concerned with the reproduction of images represented by multi value data". Referring to page 3 of D1 the Examining Division stated that it is made quite clear therein that this document is concerned with the reproduction of "gray scale representation" of an original, which the skilled man recognises as "multi-value" type image data (cf. feature (b)).

Having regard to feature (e), the Examining Division in its decision refers to Figure 2 of D1 and states:

"the adder 22 constitutes second conversion means in which the n-bit input is modified to produce n-bit out-put image data which is "appropriate" to the characteristics of the

recording means to which it is applied and is the basis for recording..".

Thus the Examining Division was of the opinion that in addition to the features (a), (c) and (d) also the features (b) and (e) were disclosed by D1. The Examining Division also referred to the statement by the Appellant in the said letter, dated 4 January 1991 that "there is no disclosure in D1 of converting the image data into a form suitable for input into a printer having particular recording characteristics"

and made the following counter-argument:

"The skilled man is aware that all printers have their own "particular recording characteristics" and since the output of the apparatus described in D1 "can be fed to either a thresholding device or a halftone screener of any kind to produce a hard copy" (see D1, p. 3 ...) - it is manifest that the Applicant's comments in these respects are spurious."

- VI. An appeal was lodged against the decision on 14 June 1991 and the fee was received on 22 June 1991. In support of the appeal the Appellant argued in the Grounds of Appeal, filed on 23 August 1991, that the decision of the Examining Division was "ill-founded under Article 113(1) EPC since the Applicants had no bona fide opportunity to comment on the grounds of rejection before the decision". It was said that the first and only communication by the Examining Division overwhelmingly dealt with matters of clarity and unity, and "made a reasoned rejection, based on the state of the art, only of Claim 19" (which contained the said features (a), (c) and (d)).

Therefore the Appellant made the following requests:

- (1) "Interlocutory revision (Article 109(1) EPC), and the reimbursement of the Appeal fee is requested in accordance with Rule 67 in conjunction with Guidelines E,XI,8."

On the basis of amended Claims 1 to 17 filed with the Grounds of Appeal the Appellant formulated:

- (2) A first auxiliary request as follows:

"The Examining Division is requested to rectify the decision under Article 109(1) EPC, and to issue a further communication examining the application as amended".

- (3) A second auxiliary request was made as follows:

"In the alternative, the Board of Appeal are requested to reverse the decision of the Examining Division in the light of the amended claims, and to remit the application back to the Examining Division for examination at first instance."

- (4) In the event that none of the above requests were allowed, oral proceedings were requested.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. The main request and the first auxiliary request refer to interlocutory revision according to Art. 109 EPC.

Interlocutory revision is within the competence of the department whose decision is contested by the appeal (Art. 109(1) EPC). Once the one-month period of Art. 109(2) EPC has lapsed and once the case has been remitted to the Board of Appeal this remedy is not available anymore. The main request and the first auxiliary request of the Appellant are thus not allowable as far as they refer to interlocutory revision. The portion of the main request that refers to reimbursement of the appeal fee is dealt with in point 5 below.

3. The decisions of the European Patent Office may only be based on the grounds or evidence on which the parties concerned have had an opportunity to present their comments (Art. 113(1) EPC). According to Art. 96(2) the Examining Division "shall invite the applicant, in accordance with the Implementing Regulations and as often as necessary, to file his observations within a period fixed by the Examining Division". Rule 51(2) of the Implementing Regulations reads: "In any invitation pursuant to Article 96, paragraph 2, the Examining Division shall, where appropriate, invite the applicant to correct the disclosed deficiencies and where necessary, to file the description, claims and drawings in an amended form." Rule 51(3) reads: "Any communication pursuant to Article 96, paragraph 2, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent."

Thus the Examining Division has to communicate the grounds against the grant of a patent to the applicant before refusing an application. In doing so it has to exercise its discretion to decide when it is deemed necessary and appropriate to invite the applicant's comments. This has to be done objectively in the light of the circumstances of each case (T 162/82, OJ EPO 1987, 533, point 12).

This does not mean that the applicant should be given repeated opportunity to comment on the same objections (T 161/82, OJ EPO 1984, 551; T 42/84, OJ EPO 1988, 251, point 12; T 243/89, point 5.1).

In a case where an applicant has made a bona fide attempt to overcome the objections raised by the Examining Division, Art. 113(1) may require such an attempt to be confirmed in the light of amended claims and substantial comments of the applicant.

4. In the present case, the Examining Division, in dealing with Claims 1 to 20 as originally filed, started its first and only communication by stating:

"The independent claims are so vague, speculative and numerous that no meaningful examination is at present possible. As far as the scope of the claims can at present be determined, it appears that EP-A-0 024 902 (D1) discloses the most relevant state of the art."

The communication then continues by summing up, using the particular wording of the respective claims, which features of each of the independent Claims 1, 6, 13 and 19 are to be considered as known from D1. Claim 19 was considered to be "wholly anticipated" by the disclosure of document D1.

However, each of the independent Claims 1, 6 and 13, contains features which the communication does not indicate as being known from D1.

The communication not only considers the exact wording of the independent claims but also describes what has to be considered as known from D1 in a more general way, citing the abstract of D1, noting that as a result of this, it is

not clear that any of the independent claims could possibly involve an inventive step and that in the dependent claims minor modifications to the respective independent claims are set out, all of which appear to relate to matters of routine, insofar as these are not explicitly disclosed in D1 or the other documents cited in the search report.

In his reply to this communication (letter dated 4 January 1991) the Appellant (then Applicant) deleted Claim 19 and filed a fresh set of Claims 1 to 18, having only one independent claim. This independent Claim 1 comprised mainly the features of original Claim 19 and two additional features which are identified as (b) and (e) under IV above.

The Board notes that the only independent Claim 1 no longer refers to "an image processing apparatus", as did all the original independent claims, but to "an image recording apparatus" (feature (a)) and that the added features (b) and (e) in their wording are not easily and unambiguously derivable from the features comprised in original Claims 1 to 20 on which the Examining Division's communication was based.

In view of the foregoing, the Appellant (Applicant) tried to overcome all the objections mentioned in the Examining Division's communication:

- by filing only one independent claim he met the objection that the independent claims were numerous;

- by deleting Claim 19 he has avoided the lack of novelty objection raised against that claim in the communication;

- by introducing features (b) and (e) in new Claim 1 the Appellant (Applicant) from his point of view may have hoped to avoid a lack of novelty objection against the combination of features of this new claim, although feature (b) as such seems to have been considered at least to some extent to be known from D1 according to the communication; this may follow from the considerations given there to the abstract of D1, so that the Appellant (Applicant) had had an opportunity to comment on this item, which he did in that in his reply he disagreed with the Examining Division's interpretation.

These are substantial amendments in the light of the objections raised by the Examining Division. They changed the subject-matter of Claim 1 considerably. The effort by the Appellant (then Applicant) is therefore considered to represent a bona fide attempt to overcome these objections. Claim 1 as amended including feature (e) has not been dealt with in the communication by the Examining Division but only in the contested decision. The reasoning why Claim 1 including feature (e) was considered to be anticipated by D1 appears for the first time in the contested decision, e.g. at the top of page 4. Thus the Appellant did not have an opportunity to present his comments with regard to the grounds for refusal of this amended Claim 1. This is both necessary and appropriate in the light of Art. 113(1) and Art. 96(2) and the requirements according to Rule 51(2,3) EPC.

All this amounts to a substantial procedural violation which renders the contested decision void. The case has thus to be remitted to the Examining Division for further

examination of the application (Art. 10 Rules of Procedure of the Boards of Appeal, OJ EPO 1980, 171). This means here resumption of the examination on the basis of the requests as they stood when the contested decision was taken. However the amended claims filed with the Board of Appeal may then be taken into consideration if the Appellant confirms their validity.

Remittance seems to be appropriate also because it appears that the Examining Division has not finally decided upon the lack of unity objection in the Partial European Search Report, dated 9 November 1988.

- 5. Since the Board has found the substantial procedural violation to be the ground for allowing the appeal, it finds it equitable to order reimbursement of the appeal fee in accordance with Rule 67 EPC.

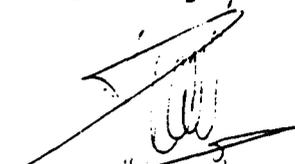
Order

For these reasons, it is decided that:

- 1. The decision under appeal is set aside.
- 2. The matter is referred back to the Examining Division for further examination of the application as indicated in point 4 above.
- 3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



M. Kiehl



P.K.J. van den Berg

00974

RR 26/3
 in. dh. 29/3