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D E C I S I O N
of 10 July 1997

Case Number: T 0390/94 - 3.4.2

Application Number: 88101716.4

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IPC: G03G 15/00

Language of the proceedings: EN

Title of invention:

Paper size selection apparatus for use in copier machines

Applicant:

MINOLTA CO., LTD.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 83, 84, 123(2)

Keyword:

"Amendments - claims admissible and clear (yes)"

"Disclosure - sufficiency (yes)"

Decisions cited:

G 0003/89, G 0009/91

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0390/94 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 10 July 1997

Appellant:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 13 December 1993
refusing European patent application
No. 88 101 716.4 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: S. V. Steinbrenner
L. C. Mancini

Summary of Facts and Submissions

- I. The appellant lodged an appeal against the decision of the Examining Division to refuse European patent application No. 88 101 716.4.

The Examining Division held that the application did not meet the requirements of Article 83 EPC.

- II. In the communication of 26 March 1997 pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal, the Board expressed its reservations under Articles 123(2) and 84 EPC about the subject matter of claim 1. Moreover, in view of the apparent incorrectness of Figure 5, the issue was raised whether a skilled person would nevertheless be able to carry out what the application purports to achieve. In addition, the appellant was informed that the Board did not intend to address matters of patentability during the oral proceedings since the contested decision was based on Article 83 EPC.

- III. Oral proceedings took place on 10 July 1997.

- IV. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the new set of claims filed at the oral proceedings, with drawings and description to be adapted if necessary.

- V. The wording of claim 1 on which the present decision is based, reads as follows:

"1. A copying machine having a plurality of paper accommodating sections capable of accommodating papers of different size, and a paper size selection apparatus carrying out an automatic paper size selection mode, a preferential paper size selection mode and a manual paper size selection mode, said apparatus comprising:

- means for automatically determining a paper size to be used for copying in accordance with the size of a document and a magnification factor in said automatic paper size selection mode;
- means for selecting and storing a paper size to be used for copying in said preferential paper size selection mode;
- key input means for manually selecting a paper size selection mode and for determining a paper size to be used for copying in said manual paper size selection mode, and
- control means for controlling the selection of the paper size selection mode by switching in succession and rotation from said automatic paper size selection mode via said preferential paper size selection mode to said manual paper size selection mode in response to successive actuations of the key input means."

Claims 2 and 3 as submitted at the oral proceedings are appended to claim 1.

VI. The appellant's argumentation in support of its request may be summarised as follows:

It is admitted that neither Figure 5 of the present application nor the associated text are fully correct. However, a skilled person would be clearly able to make

the necessary corrections on the basis of the original disclosure and common general knowledge. In particular, as can be seen from the amended Figure 5 submitted with the appellant's letter of 10 June 1997, in step S8 "now A3?" has to be replaced by "now preferential size?". The mistake is due to the fact that in the associated text of the description A3 was assumed to be the preferential paper size in order to give a specific example (see page 11, end of last paragraph of the present application). Moreover, in a further version of this Figure handed over during the oral proceedings another mistake has been corrected: apparently step S24 and reference "A" have to be deleted completely since assessing whether the ADF mode is available or not obviously does not make sense at this point of the routine. Corresponding corrections of the application documents as filed should therefore be allowed.

There are various passages of the original application documents clearly describing a "closed loop" sequence of paper size selection modes as the very idea of the present invention, i.e. switching from the automatic paper size selection mode (= APS) via the preferential paper size selection mode (= PPS) to the manual paper size selection mode (= MPS) by actuating key 832 repeatedly (see in particular page 3, second paragraph; page 14, last paragraph (which is however wrong in that A3-paper size does not come first but last); page 15, first paragraph; page 22, second and fourth paragraphs; and page 22, last line - page 23, second line). In consequence, a skilled person having been taught the idea of succession and rotation of modes so insistently would have no doubt about the fact that the present invention relates to a routine functioning in this sense.

Even if Figure 5 does not correctly reflect this routine in every detail, a skilled person would have no basic problems in realising the invention. First of all, it has to be reminded that the different paper size selection modes of the routine as such are known in the art (see the appellant's acknowledgement of the prior art submitted at the oral proceedings and provided for insertion between pages 2 and 3 of the description). Secondly, despite the errors Figure 5 gives a sufficiently clear hint as to how the claimed sequence can be carried out.

An expert will immediately realise that the flow chart of Figure 5 is erroneous in that a prevailing PPS state necessary for realising the sequence PPS > MPS with a further stroke of key 832 is lacking whereas the sequence APS > PPS is provided (see Steps S1 to S5). Moreover, as can be seen from the general logical structure of the flow chart, in particular from steps S9 to S23 which are correct, for the formation of a closed-loop sequence APS > PPS > MPS a series of "zig-zag loops" should be expected in that the paper size displayed at the end of one logical column, e.g. B4 in step S11, must form the prevailing paper size at the beginning of the next logical column, e.g. B4 in step S12. Therefore, a skilled person would interpret A3 in step S8 to correctly mean PPS displayed in preceding step S5 and the first MPS paper size to be B4, accordingly. A separate column starting with A3 as prevailing paper size is not necessary since A3 constitutes the last alternative and with the next key actuation after step S23 the routine should go back to APS via steps S2, S8, S12, S16, S20 and S25.

However, regarding the fact that key actuation (step S1) precedes the possible prevailing status of paper sizes and modes (steps S2, S8, S12, S16 and S20), Figure 5 makes sense since in the time sequence of the

flow chart two alternative interpretations are possible in principle: either a change effected by the key actuation itself is assessed in the next step or, triggered by the preceding key actuation, an assessment of the prevailing state is carried out, the latter being the correct interpretation in the present case (see e.g. page 11, beginning of last paragraph).

Reasons for the Decision

1. *Articles 84 and 123(2) EPC*

1.1 A copying machine having

- a plurality of paper accommodating sections capable of accommodating papers of different size, and
- a paper size selection apparatus

is disclosed in original claim 1, lines 1 to 3.

The three different paper size selection modes carried out by the paper size selection apparatus are described on page 22, lines 4 to 7 of the present application.

An APS means, a PPS means and a key input means are also disclosed in original claim 1, paragraphs 2 to 4. Apart from a minor reformulation, the following clarifications have been included in the claimed wording:

- the selection function of the PPS means with respect to the preferential paper size (see page 22, lines 14 to 17 and original claim 5), and

- the manual selection function of the key input means with respect to paper size selection mode and MPS paper size (see original claim 1, last paragraph; page 7, lines 11 to 16; page 11, lines 3 to 9; and page 22, lines 7 to 9).

A control means for controlling the selection of the paper size selection mode from the APS, PPS and MPS modes in response to successive actuations of the key input means can be derived from original claim 1, last paragraph in combination with page 22, lines 7 to 9. A switching sequence "in succession and rotation" from APS via PPS to MPS is inter alia disclosed in original claim 1, last paragraph and page 22, lines 4 to 9. The fact that APS is initially selected (see page 22, lines 10 to 13) and that MPS is carried out **after** the PPS mode (see page 22, last line - page 23, line 2), i.e. is last, necessarily leads to the claimed sequence.

Therefore, in the Board's view the subject matter of claim 1 now under consideration complies with the requirements of Article 123(2) EPC.

- 1.2 The Board considers claim 1 also to be clear since it defines a copying machine having a paper size selection apparatus capable of carrying out different known paper size selection modes (see, e.g., the appellant's acknowledgement of the prior art submitted at the oral proceedings) with the aid of respective means. Furthermore, in accordance with the claimed subject matter these paper size selection modes may be manually selected in a specific sequence. Therefore, claim 1 imparts an unambiguous and technically understandable teaching to an average practitioner and should thus meet the requirements of Article 84 EPC as well.

Dependent claims 2 and 3 correspond to original claims 2 and 6, respectively, and have been adapted to the wording of present claim 1. Apart from the fact that claims 2 and 3 should be further amended to relate to "a copying machine" as claimed in claim 1 to which they are appended, these claims are also considered to conform to Articles 83 and 123(2) EPC.

2. *Article 83*

2.1 The present claims being admissible and clear, an objection under Article 83 EPC could in substance only be based on the assertion that the claimed subject matter either is speculative so that it cannot be carried out at all by a skilled person or the disclosure is so confusing or incomplete that it could only be carried out with undue burden.

2.2 In the Board's view neither of these alternatives applies to the present case. Even without taking account of Figure 5 and its associated text, the Board tends to answer the question of whether a skilled person would be able to realise the claimed copying machine in the affirmative.

The subject matter of claim 1 as compared to the prior art basically relates to the implementation of a specific sequence of known paper size selection modes with the aid of a control means having a specific layout to achieve said sequence. A skilled person who must be assumed to know the prior art control means as described on pages 1 and 2 of the present application would therefore in substance be confronted with the task of differently organising the application of known selection modes. Since the implementation of such an organisation on the electronic level including the necessary circuit logic should be familiar to a skilled person from the prior art and therefore - per se -

could not make a contribution to patentability, a workable solution to the above clear task would not appear to face an average practitioner with unsurmountable barriers or undue efforts.

- 2.3 In addition, although Figure 5 and the corresponding text are not fully correct, these parts of the original application documents nevertheless give a clear hint to the expert in which direction to proceed on the circuit logic level. First of all, a skilled person would become aware of the errors in Figure 5 by simply running through the flow chart for specific example cases. The skilled person will thus necessarily realise that a closed-loop sequence is not achieved in the embodiment of Figure 5. However, the skilled person would not consider this fact to cause a substantive confusion about the overall disclosure of the application since a major portion of Figure 5, i.e. the subroutines comprising steps S1 - S7 and S9 - S23, would appear to be in accordance with the claimed subject matter. Furthermore, although the description of Figure 5 is not clear in every detail, a highly plausible interpretation of this Figure cannot be said to be substantially inconsistent with, or even contradictory to, the claimed subject matter. In consequence, a skilled person would basically realise that correction of the flow chart was needed with respect to two apparent flaws, i.e. the transition from prevailing PPS (steps S5 and S7, respectively, of Figure 5 as filed) to MPS (steps S8 - S23 of Figure 5 as filed), and from prevailing MPS (steps S20 and S23, respectively, of Figure 5 as filed) back to APS (steps S24 and S25, respectively, of Figure 5 as filed). As the appellant convincingly argued at the oral proceedings, resolving these specific "singular" errors should fall within an average practitioner's competence.

2.4 The Examining Division based its objection under Article 83 EPC in substance on the assertion that the original application did not disclose in a sufficiently clear manner the appellant's interpretation of Figure 5 and its associated text having regard to the effect of an actuation of key 832, i.e. that step S1 triggers an investigation of the status of the apparatus at the time of, or immediately before, depressing the key.

Moreover, a skilled person would be misled by the fact that the object of the present invention lists three distinct modes which in fact turn out to be only two different modes, i.e. a manual one wherein the hierarchy of selectable paper sizes can be modified, and an APS.

Finally, it appears from the contested decision that the Examining Division did not consider Figure 6 and its associated text to clearly disclose effects of the claimed invention since this Figure only relates to a preferential size setting routine and must be understood to select a preferred paper size for later use in the claimed invention.

2.5 In the Board's view, however, the appellant is right in pointing out that its interpretation of the flowchart, i.e. the prevailing status is assessed on demand by pressing key 832, is compatible with conventional practice and derivable from the original application documents in so far as these can be understood (see, e.g., page 11, second paragraph).

Since the existence of three distinct selection modes and their application has been clarified in present claim 1, the Board does not consider the claimed subject matter to be misleading in this respect.

Finally, the Board does not consider a reference to Figure 6 to be necessary in the context of sufficient disclosure.

- 2.6 Therefore, in the Board's view the present application meets the requirements of Article 83 EPC.
3. Claims 1 to 3 being admissible and clear (apart from a minor amendment to claims 2 and 3 mentioned in item 1.2 above), the application shall be further examined by the Examining Division with respect to the remaining requirements of the EPC (in particular Articles 52 to 57 and Rules 27 and 29 EPC), the preliminary remarks of the Examining Division in this respect neither appearing complete nor consistent (see minutes of the oral proceedings dated 25 November 1993, page 4, second paragraph, and the contested decision, page 4, C.4).

Although the corrections to Figure 5 suggested by the appellant in its letter dated 10 June 1997 and during the oral proceedings do not appear implausible, the Board does not consider these corrections to be admissible under Rule 88 EPC since they cannot be derived directly and unambiguously from the originally filed application documents (see G 3/89 and G 11/91). This Figure should therefore be kept in unamended form, leaving its correct interpretation to the skilled reader.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.

The Registrar:

The Chairman:

E. Görgmaier

E. Turrini

