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D E C I S I O N
of 22 April 1998

Case Number: T 0237/96 - 3.4.2

Application Number: 89108768.6

Publication Number: 0342600

IPC: G03G 15/00

Language of the proceedings: EN

Title of invention:

Image forming apparatus with transfer material separating means

Applicant:

Canon Kabushiki Kaisha

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 113(2)
EPC R. 86(3), 67

Keyword:

"Refusal by Examining Division to consent to late amendment
(justified) reimbursement of appeal fees (no)"

Decisions cited:

G 0007/93, T 0182/88

Catchword:

The broadening of the scope of claim 1 requested by the applicant after receipt of the Examining Division's communication under Rule 51(4) EPC so as to encompass one originally disclosed embodiment was not consistent with his previous submission that said embodiment was not part of the invention, raised new issues as to clarity and inventive step and was not supported by any argumentation in favour of the allowability of the amendment claim: the Examining Division in refusing to consent to the amendment under Rule 86(3) EPC was not considered in the circumstances to have exercised its discretion in a wrong or unreasonable manner.

The Board gave its consent to an amendment consisting essentially in the addition of a single independent claim specifically directed to said originally disclosed embodiment, filed together with a detailed and convincing argumentation in favour of inventive step in view of the citations in the Search Report.



Case Number: T 0237/96 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 22 April 1998

Appellant:

Canon Kabushiki Kaisha
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Tokyo (JP)

Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 4 December 1995
refusing European patent application
No. 89 108 768.6 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: A. G. Klein
M. Lewenton

Summary of Facts and Submissions

- I. Examination of European patent application No. 89 108 768.6 (publication No. 0 342 600) led to the issuance of a communication under Rule 51(4) EPC dated 27 April 1994, by which the Examining Division informed the applicant of its intention to grant a European patent on the basis of application documents which, apart from a few minor editorial corrections, corresponded to the application documents proposed by the applicant in response to two earlier official communications.
- II. In his reply dated 29 August 1994 the applicant requested that claim 1, as proposed for grant by the Examining Division, be replaced with an amended claim 1. He submitted that the amendment had become necessary since it had been noted that claim 1 as proposed for grant did not cover the first embodiment disclosed in the specification in relation with Figure 2.
- III. The Examining Division did not consent under Rule 86(3) EPC to the amendment of claim 1, proposed by the applicant after receipt of the communication under Rule 51(4) EPC, and it refused the application on the ground that there was no version approved by the applicant in which a patent could be granted (Article 113(2) and Rule 51(5) EPC).
- IV. The appellant (applicant) appealed against the Examining Division's decision to refuse the patent application.
- V. Following a communication of the Board pursuant to Article 110(2) EPC, the appellant requested that a patent be granted on the basis of an amended set of

claims 1 to 15 as filed on 24 March 1998, corresponding in substance to the set of claims 1 to 14 as proposed for grant by the Examining Division in its communication under Rule 51(4) EPC, with an additional independent claim 15 specifically directed to the embodiment disclosed in relation with Figure 2.

The appellant also requested that oral proceedings be appointed if a patent could not be granted on the basis of the amended claims 1 to 15, and that the appeal fees be reimbursed according to Rule 67 EPC.

Claims 1 and 15, the only independent claims of the set of claims according to appellant's main request, read as follows:

"1. An image forming apparatus, comprising:
a movable photosensitive member (1);
image forming means (22, 23, 24) for forming an image on a surface of said photosensitive member;
transfer means (2) for transferring the image on the surface of the photosensitive member formed by said image forming means onto a transfer material (P); and
separating means (7) for electrostatically separating the transfer material from said photosensitive member after the image is transferred by said transfer means, said separating means being supplied with an alternating voltage having a waveform which is flattened in a neighborhood of a peak of the alternating voltage,
characterized in that
said alternating voltage supplied to said separating means (7) has a DC component having a polarity opposite to the polarity of a voltage applied to said transfer means (2), and control means (12, 13, 14; 30, 31, 32, 33, 34) are provided for controlling the level of the DC component so that the current difference between the positive component and the negative component of the

current supplied to said separating means (7) is constant while said waveform of the alternating voltage supplied to said separating means is maintained."

"15. An image forming apparatus, comprising:
a movable photosensitive member (1);
image forming means (22, 23, 24) for forming an image on a surface of said photosensitive member;
transfer means (2) for transferring the image on the surface of the photosensitive member formed by said image forming means onto a transfer material (P); and
separating means (7) for electrostatically separating the transfer material from said photosensitive member after the image is transferred by said transfer means, said separating means being supplied with an alternating voltage having a waveform which is flattened in a neighborhood of a peak of the alternating voltage,
characterized in that control means (3 to 5, 8 to 10) are provided for controlling the duty ratio of the alternating voltage so that the current difference between the positive component and the negative component of the current supplied to said separating means (7) is constant."

VI. In support of his requests, the appellant essentially submitted that the additional independent claim 15 was directed to an image forming apparatus as disclosed in Figures 2, 4 and 5 and in the corresponding portions of the description of the application documents as originally filed, which was characterised in that control means were provided for controlling the duty ratio of the alternating voltage so that the current difference between the positive component and the negative component of the current supplied to the separating means was constant.

Document JP-A-62 043 681 as cited in the European Search Report admittedly also disclosed separating means supplied with a voltage having a duty ratio different from 1:1, but this duty ratio was not controlled in any way and it was not taken care in the apparatus described in the document that the difference between the positive and the negative components of the current supplied to the separating means be constant, as was evidenced by the English translation of the Japanese document provided by the appellant.

Concerning his request for reimbursement of the appeal fees, the appellant submitted that the Examining Division by refusing the amendment of claim 1 pursuant to Rule 86(3) EPC had violated the provisions of Article 113(2) EPC, according to which the European Patent Office shall consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for the proprietor of the patent. In his opinion, Article 113(2) EPC had to take precedence over both Rule 86(3) and Rule 51(5) EPC.

The decision of the Examining Division to refuse the requested amendment pursuant to Rule 86(3) EPC was not appropriate either. Amended claim 1 of 29 August 1994 differed from claim 1 intended for grant by the Examining Division merely in that the feature "DC component" was replaced by "component". The fact that it was possible to manufacture an apparatus which made use of the teaching of the invention and worked with any "component" instead of the "DC component" was evidenced for instance by the disclosure in the application documents of the embodiment according to Figure 2. Resuming the examination on the basis of the

amended claim could only have led to the result that, regarding clarity and inventive level, what applied to claim 1 in the version of the official communication under Rule 51(4) EPC necessarily also applied to the amended claim 1 of 29 August 1994.

Reasons for the Decision

1. The appeal is admissible.
2. *Refusal by the Examining Division to consent to the amendment to claim 1 proposed by the appellant on 29 August 1994*
 - 2.1 Under Rule 86(3) EPC, after reply to the first communication from the Examining Division (in this case by appellant's letter dated 15 June 1993), amendment of a European patent application cannot be made without the consent of the Examining Division and is therefore matter of discretion for the latter.

According to consistent case law of the Boards of Appeal of the EPO, an Examining Division when exercising such discretion must consider all relevant factors of the specific case and balance in particular the applicant's interest in obtaining an adequate protection for his invention and the EPO's interest in bringing the examination to a close in an effective and speedy way. Furthermore, once an Examining Division has exercised such discretion, a Board of Appeal should only overrule it if it comes to the conclusion either that the Examining Division has not exercised its discretion in accordance with the right principles or that it has exercised its discretion in an unreasonable way and has thus exceeded the proper limit of its discretion; see in particular the decision of the

Enlarged Board of Appeal G 7/93, OJ EPO 1994, 775, points 2.5 and 2.6 of the Reasons and decision T 182/88, OJ EPO 1990, 287, points 3 and 4 of the Reasons.

- 2.2 The Examining Division did not find its decision on the sole fact that appellant's request for amending claim 1 had been filed later than the issuance of the communication under Rule 51(4) EPC which was based on a version previously accepted by him. The Examining Division also felt that the reason given for filing the amendment - namely that it had been noted that the embodiment of Figure 2 was not covered by the claims as proposed for grant - was not consistent with the appellant's previous submissions in his responses to the two communications of the Examining Division which preceded the issuance of the communication under Rule 51(4) EPC.

The appellant had indeed in these responses entirely concentrated his argumentation in support of inventive step on the merits of the embodiment of Figures 6 to 8 with the controlling of a DC component of the alternating voltage supplied to the electrostatic separating means. He had also expressly stated that the embodiments of Figures 2 to 5 which involved instead control of the duty ratio of an AC voltage were not to be regarded as embodiments in accordance with the invention; see appellant's letters dated 15 June 1993, page 3, third paragraph and 9 February 1994, page 2, sixth paragraph.

- 2.3 The Examining Division also emphasized that, had it given its consent to the amended version of the claim, the examination should have been re-started from the beginning, which, given the prima facie lack of clarity of the claim, would have led to a considerable delay.

Whether resuming examination could have been expected to lead to a considerable delay or not is of course a matter of judgement and experience.

To refuse minor amendments of merely editorial nature, or amendments relating to aspects of the invention of no relevance to the assessment of the patentability of the claimed subject-matter, if such amendments were clearly acceptable under Articles 84 and 123(2) EPC, may for instance not be considered reasonable of an Examining Division.

In the present circumstances, however, there is little doubt that the feature of a "DC component" of the alternating voltage being supplied to the electrostatic separating means, which was removed from claim 1 by the appellant after issuance of the communication under Rule 51(4) EPC, actually played a central role for the assessment of inventive step in the examining procedure up to the issuance of the communication under Rule 51(4) EPC. The appellant did not however in his letter of 29 August 1994 submit any reasoned argument whatsoever in support of the patentability of the subject-matter of the proposed broader claim. Such patentability clearly could not follow from his earlier submissions, which were all expressly directed to the embodiment with the control of a DC component only.

Concerning the prima facie lack of clarity of amended claim 1, which was also alleged by the Examining Division to justify its decision to refuse its consent to the amendment, the reference to "a component" of a periodic voltage which has a certain polarity and which is controlled so as to achieve a constant difference of the positive and negative currents supplied to the

separating means can, in the Board's judgement, hardly be considered to clearly encompass the controlling of the duty ratio of an alternating voltage disclosed in the description with reference to Figures 2 to 5.

Moreover, when the duty ratio of an alternating voltage is varied, the waveform of the voltage is necessarily changed, and it cannot therefore be maintained as is set out at the end of the claim.

2.4 For these reasons, the Examining Division does not in the circumstances appear to have exercised its discretion under Rule 86(3) EPC in a wrong or unreasonable manner.

2.5 The refusal by the Examining Division to admit the amended claim 1 into the procedure is not considered either to have infringed against the provisions of Article 113(2) EPC, as was further submitted by the appellant.

Article 113(2) EPC indeed specifies that a decision on a European patent application can only be based on the text submitted or agreed by the applicant, and the Examining Division would certainly have offended against these provisions, had it decided to grant a patent or refused the application on the basis of the application documents indicated in its communication pursuant to Rule 51(4) EPC, to which the appellant no longer agreed.

Article 113(2) EPC cannot however be interpreted in the sense that the Examining Division is bound to accept any amendment which the applicant might propose, only to ensure that there is a version approved by him.

In circumstances in which, like in the present case, amendments proposed by the applicant are not allowed by the Examining Division by virtue of Rule 86(3) EPC and the applicant does not give its agreement to any other version of the application documents, the established practice of the EPO, sanctioned by consistent case law, is to refuse the application on the ground that there is no version approved by the applicant in the sense of Article 113(2) EPC, on which a patent could be granted.

3. *Appellant's main request*

3.1 Claims 1 to 14 of the set of claims according to appellant's main request correspond to the claims on the basis of which the Examining Division intended to grant a patent, as indicated in its communication pursuant to Rule 51(4) EPC, the expression "periodic voltage" having however being amended to "alternating voltage" throughout the claims for consistency with the description.

The Board sees no reason to question the Examining Division's conclusion, reflected by its intention to grant a patent, that these claims fulfilled the requirements of the Convention.

The subject-matter of independent claim 1 was indeed disclosed originally in relation with the embodiment of Figures 6 to 8.

The nearest prior art as defined in the preamble of independent claim 1 is constituted by the apparatus disclosed in either of documents JP-A-60 220 381 or JP-A-62 043 681 as referred to in the introductory portion of the present description. The technical problem solved by the distinguishing features set out in the characterising portion of claim 1, namely the

provision of a DC component having a polarity opposite to the polarity of a voltage applied to the transfer means and the controlling of the level of said DC components so that the current difference between the positive component and the negative component of the current supplied to the separating means is constant while the wave form of the alternating voltage supplied to the separating means is maintained, is to guarantee a proper separation of the transfer material from the photosensitive member under all circumstances, in particular independently of whether the transfer material comprises toner free or toner carrying portions. None of the documents presently on the file discloses nor suggests these features, nor addresses the technical problem underlying the invention and the interest of controlling the current difference between the positive and the negative components of the current supplied to the separating means.

- 3.2 The preamble of additional independent claim 15 is identical to the preamble of independent claim 1 and its characterising portion is comprised of a combination of the features of dependent claims 6 and 7 as originally filed. Independent claim 15 thus defines the embodiment of the invention originally disclosed in relation to Figures 2 and 5, which is distinguished from the embodiment defined in claim 1 in that the current difference between the positive and the negative components of the current supplied to the separating means is maintained constant by controlling the duty ratio of the alternating voltage instead of controlling the level of the DC component.

From the detailed explanations given by the appellant in his letter dated 24 March 1998 as supported by the attached English translation of document

JP-A-62 043 681, it is immediately apparent that the reasons which justify the non-obviousness of the subject-matter of independent claim 1 also apply to the subject-matter of independent claim 15.

Document JP-A-62 043 681 indeed discloses two distinct embodiments in which the duty ratio of the alternating voltage supplied to the separating means is either 1:1 (see Figure 2) or 1:3 (see Figure 4). There is however no hint in the document to control the duty ratio in a single embodiment, for any purpose whatsoever.

- 3.3 The version of the description which formed the basis of the Examining Division's communication under Rule 51(4) EPC has been maintained unamended. Obviously, the generic reference made on page 6a, line 2 to claim 1 should be corrected so as to refer also to independent claim 15. No further adaptation is considered necessary, because the passage from line 17 of page 10 to line 26 of page 11, in particular its last sentence, clearly implies that the embodiment of Figure 2, which is compared there to the prior art system, is part of the invention.
- 3.4 Thus, in contrast with the situation which prevailed when the Examining Division took its decision to refuse the application, in which in particular the amendment brought to claim 1 raised new issues as to clarity and was not supported by any argumentation by the appellant in favour of the inventive step involved by the amended subject-matter, it is now clear that the present amendment, consisting essentially in an additional independent claim directed to a further embodiment of the invention disclosed in the description, is immediately acceptable.

The Board, exercising its powers within the competence of the Examining Division as provided for in Article 111 EPC therefore gives its consent under Rule 86(3) EPC to the claims being amended in accordance with appellant's main request, and confirms that a patent can be granted on the basis of these claims.

4. Since the Board could not identify any substantial procedural violation by the Examining Division (see above, point 2 of the Reasons), appellant's request for reimbursement of the appeal fees is dismissed.

His auxiliary request for oral proceedings was conditional to a patent not being granted on the basis of his main request, and it need not therefore be considered.

Order

For these reasons it is decided that:

The case is remitted to the first instance with the order to grant a patent with the following version:

Description and drawings: as indicated in the Examining Division's communication under Rule 51(4) EPC dated 27 April 1994, with the amendment consisting in replacing the expression "claim 1" on page 6a, line 2 of the description by the expression "independent claims 1 and 15, respectively".

Claims: 1 to 15 as submitted with appellant's letter dated 24 March 1998.

The Registrar:

The Chairman:

P. Martorana

E. Turrini

Order

For these reasons it is decided that

The case is remanded to the trial court with the order to grant a writ with the following terms:

Reinstatement and salary as indicated in the T-100 form. The court is directed to award the plaintiff the amount of back pay as indicated in the T-100 form. The court is directed to award the plaintiff the amount of interest as indicated in the T-100 form. The court is directed to award the plaintiff the amount of attorney's fees as indicated in the T-100 form. The court is directed to award the plaintiff the amount of costs as indicated in the T-100 form.

It is so ordered. Dated this 11th day of June, 1981.