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D E C I S I O N
of 14 June 2000

Case Number: T 0864/97 - 3.5.1

Application Number: 88107329.0

Publication Number: 0290976

IPC: H04N 1/40

Language of the proceedings: EN

Title of invention:

Density control system for a digital copier

Patentee:

Ricoh Company, Ltd

Opponent:

Canon Inc.

Headword:

Density control system/RICOH COMPANY

Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Decision re appeals - remittal (yes)"

Decisions cited:

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Catchword:

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Case Number: T 0864/97 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 14 June 2000

Appellant:
(Opponent)

Canon Inc.
No. 30-2, Shimomaruko 3-chome
Ohta-ku
Tokyo 146 (JP)

Representative:

Pellmann, Hans-Bernd, Dipl.-Ing.
Patentanwaltsbüro
Tiedtke-Bühling-Kinne & Partner
Bavariaring 4-6
D-80336 München (DE)

Respondent:
(Proprietor of the patent)

Ricoh Company, Ltd
3-6, 1-chome Nakamagome
Ohta-ku
Tokyo 143 (JP)

Representative:

Schwabe, Sandmair - Marx
Stuntzstrasse 16
D-81677 München (DE)

Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 9 June 1997
rejecting the opposition filed against European
patent No. 0 290 976 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: R. R. K. Zimmermann
P. H. Mühlens

Summary of Facts and Submissions

- I. The appeal concerns European patent No. 0 290 976 granted on the basis of European patent application No. 88 107 329.0, the mention of the grant being published on 5 April 1995 in Bulletin 95/14.
- II. The appellant filed an opposition against the patent on 3 January 1996, invoking lack of novelty and inventive step as grounds of opposition (Article 100(a) EPC) and requesting revocation of the patent in its entirety. In support of the opposition, the appellant cited various prior art documents. In response to summons to attend oral proceedings before the opposition division the appellant (then opponent) filed a further prior art document, the document DE-A-3 049 369.
- III. In the oral proceedings the opposition division decided not to admit this document into the proceedings since it was very late filed and was *prima facie* not more relevant than those prior art documents already on file. The opposition was then rejected essentially for the reason that the grounds for opposition invoked by the appellant did not prejudice the maintenance of the patent unamended.
- IV. Against this decision, posted on 9 June 1997, the appellant filed a notice of appeal on 8 August 1997, requesting reversal of the decision and revocation of the patent. The appeal fee was paid the same day; the grounds of appeal were subsequently filed on 17 October 1997.

The respondent requested that the appeal be rejected.

Both parties to the appeal proceedings, appellant and respondent, submitted requests for oral proceedings as an auxiliary measure if their respective requests are not allowed.

- V. In the grounds of appeal the appellant maintained its view that document DE-A-3 049 369 should be admitted to the proceedings and indicated the reasons for the relevance of this document in some detail.

- VI. In a communication the Board explained its preliminary view that document DE-A-3 049 369 was indeed considered highly relevant for the patentability of the claimed subject-matter and that for this reason the document should be admitted to the proceedings. The parties were invited to indicate whether taking this document into consideration as a pertinent piece of prior art they preferred to continue the appeal proceedings on the substantial issues or to have the case remitted to the opposition division for further examination.

- VII. In reply to this communication the respondent, and patent proprietor, requested that the case be remitted to the opposition division for further examination and that a new time limit should be set for a substantive reply to the communication. The appellant did not comment.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC and is thus admissible.
2. The opposition division assessed novelty and inventive step without taking the late filed document DE-A-3 049 369 into account. After considering this document and the arguments of the appellant the Board, however, arrived at the conclusion that this document is *prima facie* highly relevant and is thus admitted to the proceedings.
3. Since this decision changes the procedural situation to the disadvantage of the respondent, it is in its legitimate interest to have the document considered in two instances. The Board, therefore, allows the request to remit the case to the opposition division for further examination.

The further requests for oral proceedings before the Board and for a further opportunity to comment on the communication of the Board in writing are refused at the present point of time since the parties may first exercise their rights of being heard in oral proceedings and in writing before the first instance.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg