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**D E C I S I O N**  
**of 21 October 1999**

**Case Number:** T 0904/97 - 3.4.2

**Application Number:** 93110200.8

**Publication Number:** 0562648

**IPC:** G03G 15/00

**Language of the proceedings:** EN

**Title of invention:**

Apparatus for forming an image on a record medium

**Patentee:**

Seiko Epson Corporation

**Opponent:**

Canon Inc.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 76(1), 100(a), (c), 54, 56  
EPC R. 25

**Keyword:**

"Division of a divisional application"  
"Benefit of the filing date of the grandparent application  
(no)"  
"Patentability (no)"

**Decisions cited:**

T 0905/97; T 0906/97; T 0206/93; T 0194/84; T 0434/97

**Headnote:**

1. Since both the divisional application for which the patent in suit is granted and the parent application comprise subject-matter extending beyond the content of the grandparent application as originally filed, the second-generation patent cannot possibly benefit from the filing date of the grandparent application, the publication of which therefore belongs to the prior art under Article 54(2) EPC.
  
2. Thus there was no need for the Board in the present circumstances to further investigate the issues of the admissibility of sequences of divisional applications and of their proper handling, which therefore could be left open (point 2 of the Reasons).



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Case Number: T 0904/97 - 3.4.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.4.2**  
**of 21 October 1999**

**Appellant:**  
(Opponent)

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**Respondent:**  
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**Decision under appeal:**

Interlocutory decision of the Opposition Division  
of the European Patent Office posted 24 June 1997  
concerning maintenance of European patent  
No. 0 562 648 in amended form.

**Composition of the Board:**

**Chairman:** E. Turrini  
**Members:** A. G. Klein  
B. J. Schachenmann



## Summary of Facts and Submissions

- I. The present proceedings concern European patent No. 0 562 648 (application No. 93 110 200.8). It was filed as a divisional application of European patent application No. 91 201 876.9 (publication No. 0 460 773). The latter will be referred to as the "**parent application**".

The parent application itself was filed as a divisional application of European patent application No. 87 302 839.3 (publication No. 0 240 337). The latter will be referred to as the "**grandparent application**".

The parent application matured into a European patent, opposed by the same opponent, and was revoked by the decision T 905/97 of 11 June 1999 (not published in the OJ EPO).

- II. An opposition was filed against the patent, based on the grounds set out in Article 100(a), 100(b) and 100(c) EPC. The ground for opposition under Article 100(c) EPC was supported in the notice of opposition by an allegation that the subject-matter of the patent had been extended beyond the content its parent application as filed.
- III. The Opposition Division issued an interlocutory decision, ruling that the patent could not be maintained as granted since its description and figures contained subject-matter which had been introduced therein during prosecution of the **parent application** in

violation of Article 123(2) EPC (see point 2.1.1 of the Grounds). It also stated that further subject-matter of the description as granted had not been unambiguously disclosed in the **grandparent application**, in violation of the requirements of Article 76(1) EPC (see point 2.2.1 of the Grounds).

The Opposition Division however decided on the maintenance of the patent in an amended form, i.e. with the claims as granted and with amended description and drawings.

IV. The appellant (opponent) lodged an appeal against the interlocutory decision.

V. Oral proceedings were held on 6 May 1999.

At the end of these oral proceedings the chairman of the Board declared the debate closed, so that no further submissions would be accepted, and he announced that the decision would be given in writing.

VI. In a communication pursuant to Article 11(2) of the Rules of Procedures of the Boards of Appeal, dated 30 June 1999 and annexed to summons to attend further oral proceedings, the Board - after having taken the decision T 905/97 to revoke the patent granted for the parent application on the ground that its subject-matter extended beyond the content of the grandparent application in violation of the requirement of Article 100(c) EPC - re-opened the debate in the present proceedings. It informed the parties that the present patent might not benefit from the filing date of the grandparent application and that its subject-

matter might therefore not be novel in view of the publication of said grandparent application.

- VII. Further oral proceedings were held on 21 October 1999, at which the appellant (opponent) requested that the decision under appeal be set aside and that the European patent 0 562 648 be revoked.

As an auxiliary request, he requested that the following question be referred to the Enlarged Board of Appeal:

- "1. Is an amendment consisting of deletion of description parts and drawings and combining the remaining drawings to embodiments not originally disclosed in a divisional application to be assessed as to its allowability under Article 123(2), second alternative on the basis of the divisional application as originally filed or on the basis of the parent application of the application ("intermediate application") from which the divisional application has been divided?

If the first alternative is correct:

2. Is it to be considered as an "unescapable trap" the situation in which on the one side a patent granted on the basis of a divisional application is to be amended in order to avoid infringement of Art. 76 (1) with regard to the version of an earlier application ("intermediate application") and accordingly a revocation under Art. 100(c) EPC, wherein on the other side such an amendment constitutes an infringement of Art. 123(2), second

alternative EPC with regard to the version of the divisional application as originally filed?"

VIII. The respondent (patentee) requested that the appeal be dismissed and that the patent be maintained in amended form with the claims according to the main request or one of the auxiliary requests I to XI, all filed during the oral proceedings of 6 May 1999, with the description and drawings as maintained by the Opposition Division.

Claim 1, the only independent claim in accordance with the main request reads as follows:

"1. Apparatus for forming an image on a record medium comprising transport means (10, 13) for causing a record medium to be transported along a transport path within the apparatus so as to be discharged therefrom; a rotatable image-receiving member (1) for receiving the said image; a transfer device (5) adjacent the transport path for transferring the image from the image-receiving member (1) to the record medium; and a fixing device (11) adjacent the transport path for fixing the image on the record medium characterised in that the apparatus is provided on a front side thereof with a door (23) which, when open, provides access to the transport path (21), image-receiving member (1), transfer device (5) and fixing device (11) within the apparatus and which is pivoted around an axis parallel to that of the image-receiving member (1), the arrangement being such that access space for insertion and discharge of the recording medium and the said access to the transport path



(21), image-receiving member (1), transfer device (5) and fixing device (11) is only required at the front and top sides of the apparatus."

Claim 1 of auxiliary request I further specifies that "the record medium is discharged from the apparatus having moved from the transport means (13) after receiving the image about one centre of curvature only".

Claim 1 of auxiliary request II further specifies that the transport path includes an opening in the top surface of the apparatus and that the door includes the portion of the said top from the front to the said opening.

Claim 1 of auxiliary request III further specifies that the apparatus is provided with a cartridge provided with the image-receiving member (1) and the cleaning device (6).

Claim 1 of auxiliary request IV further specifies that the door provides "direct" access to the said transport path, image-receiving member, transfer device and fixing device.

Claims 1 of auxiliary requests V to VIII further specify various combinations of the additional limitations in accordance with auxiliary requests I to IV.

As an auxiliary request IX the respondent requested "that the patent be maintained on the basis of the main request and further amended by adding to Claim 1

thereof any one or more of Claims 2 to 13 as granted, with consequential renumbering of the remaining Claims as may be required".

As an auxiliary request X it was requested "that the patent be maintained on the basis of the main request with Claim 1 thereof further amended by the features of any of Auxiliary Requests I to VIII and any one or more of Claims 2 to 13 as granted, with any consequential amendments of Claims 2 to 13 as granted".

As an auxiliary request XI it was requested "that the patent be maintained on the basis of the main request further amended by adding to Claim 1 thereof the feature added by auxiliary request IV together with the features added by Claim 1 of any of the other auxiliary requests, with consequential amendments to the dependent Claims as may be necessary for consistency with the amended Claim 1".

The respondent further requested that the following questions be referred to the Enlarged Board of Appeal:

"Does Article 100(c) EPC, which has two parts separated by the word "or" require a divisional application to meet both parts of Article 100(c) or only to meet the second part thereof. Moreover, following possible interpretation of the above to mean that the divisional must meet only the second part of Article 100(c); does "the earlier application" in the case of a divisional application being filed from an existing divisional application mean the very first patent application or the "intermediate" divisional application" (request A).

"Whether or not it is contrary to the provisions of the EPC, and in particular Rule 25 thereof, for a divisional application to be filed from an earlier divisional application and, if not, whether or not the status (e.g. pending, granted or withdrawn) of the original European application (grandparent application) at the date of filing of the second divisional application (grandchild application) is of any significance" (hereinafter request B, see the letter dated 21 September 1999).

- IX. The arguments put forward by the appellant against the admissibility of the amendments made to the claims can be summarized as follows:

The grandparent application as filed described seven separate, non-unitary arrangements covered by different independent claims, which neither achieved any common technical effects nor solved any single technical problem. Rather than merely pursuing one of these arrangements, the divisional application for which the present patent was granted and, accordingly, the patent itself were directed to a new combination of features which did not correspond to any of the originally described arrangements. This new combination was not even implicitly disclosed in the original grandparent application. Neither was there any indication or suggestion in the grandparent application as filed that this new combination was essential to the disclosed invention.

In particular, the independent claims of the grandparent application as filed explicitly referred to an apparatus having a casing with a paper insertion

opening and a paper discharge opening, and a transport path extending from the former to the latter. The original description, in connection with the discussion of the disadvantages of prior art arrangements, also stressed the merits of the invention in terms of a reduction of the number and extent of the bends which the paper had to follow between both openings, and of an overall shortening of the transport path itself.

Claim 1 of the respondent's various requests did not however include any corresponding limitations. New arrangements were thus claimed, which did not comprise any paper insertion opening. The claim e.g. covered undisclosed arrangements with a paper storage box located inside the casing.

Moreover, as a result of the deleting during the opposition procedure of several figures contained in the grandparent application as filed, the present version of the description now comprised a number of passages by which features disclosed originally only with reference to the arrangements of these - now deleted - figures were ascribed for the first time to the arrangements shown in the remaining drawings.

- X. These arguments were contested by the respondent, who submitted first that in the case of a patent granted for a divisional application the grounds for opposition under Article 100(c) EPC **only** prohibited extension of its subject-matter beyond the content of the **earlier** application as filed.

In his view the conjunction "or" in Article 100(c) EPC was to be read in its disjunctive meaning. Consequently

only the second alternative was applicable in the case of a patent granted for a divisional application, whilst the first alternative, which would refer to subject-matter extending beyond the content of the divisional application itself as filed, was not to be considered. Such an extension did not therefore fall under the grounds of Article 100(c) EPC. Furthermore, in case the divisional was filed from a parent application which itself was a divisional of a grandparent application, the "earlier" application in the sense of the second alternative can only be the grandparent. In view of the importance of this point of law, the respondent requested that it be referred to the Enlarged Board of Appeal.

Concerning the amendments made to the patent, he denied that the absence from the claims of the features which in the grandparent application were directed to the transport path extending between a paper insertion opening and a paper discharge opening was objectionable. Such openings clearly constituted generic features of the type of apparatus concerned, which had not to be stated in the claims, accordingly. Although the embodiments disclosed in the patent did not comprise any inner cassette for blank sheets of paper, the provision of such cassette would certainly also require an opening for its insertion into the housing of the apparatus.

The respondent also submitted that there was no provision in the Convention prohibiting the filing of a divisional application from a still earlier divisional application, or requiring therefore that the latter be still pending. The "earlier" application referred to in

the provision of Rule 25 EPC defining the term of the time delay for the filing a divisional application could only be the immediate parent application which, once validly filed, became a separate application independent from the grandparent application. Given the thousands of divisional applications filed at the EPO, and the retrospective effect a decision against the validity of second-generation divisional patents might have for a large number of already granted such patents, the issue of their conformity with the Convention and of the proper application of Rule 25 EPC should in any case be referred to the Enlarged Board of Appeal.

As far patentability was concerned, the claimed subject-matter could not simultaneously extend beyond the content of the grandparent application as filed and lack novelty over it. The publication of the grandparent application could not therefore prejudice novelty of the claimed subject-matter.

## **Reasons for the Decision**

1. The appeal complies with the requirements of Articles 106 to 108 and of Rule 64 EPC. It is therefore admissible.
  
2. *Preliminary remark*
  - 2.1 The European patent in suit is based on a patent application which was filed as a division of a parent application which itself was a divisional application

of a grandparent application (see point I of the Summary of Facts and Submissions). In this respect the parties thus raised a number of issues, starting with whether successive divisional applications are admissible at all and, if so, whether a second-generation divisional application can still be filed when the grandparent application is no longer pending, as was the case in the present instance.

- 2.2 The Convention does not explicitly foresee the possibility of an application being divided from an earlier divisional application. Even less does it provide guidance for the proper way to apply, in such a case, the provisions of Article 76(1), Article 100(c) or Rule 25 EPC which in fact all refer to a single parent application only ("the earlier application").

The Guidelines for examination in the EPO actually provide for the possibility for an applicant to file a divisional application from an application which itself is a divisional application. They only require the latter to be still pending at the filing date of the second-generation application (see Guidelines, July 1999, Part A, Chapter IV, 1.1.4 and Part C, Chapter VI, 9.1).

- 2.3 The Board having scrutinized the *Travaux Préparatoires* however found a single, early, reference to sequences of divisional applications which would appear to provide evidence that, at least at this stage of the preparatory works, it was not intended to permit the filing of sequences of divisional applications.

According to the minutes of its 12th meeting held from 26 February to 6 March 1964 in Brussels, the EEC Patents Working Party rejected a proposal relating to "a system of divisions in a cascade, which could have constituted a dilatory manoeuvre". Such results in the working party's opinion were ruled out by the division system provided for in Article 80 of the Preliminary Draft Convention (see the document 2632/IV/64-F, 15 April 1964, page 31). According to Article 80 of the Preliminary Draft Convention, divisional applications had to be filed within a time limit of two months after the "limitation" of the parent application, which itself - like in the present Convention - was to be performed at the latest at the end of the examination procedure (i.e. within the time limit set for the payment of the granting and publication fees). The question would not appear to have been raised again later.

The Boards of Appeal of the EPO do not appear to have examined these questions as yet.

- 2.4 However, for the reasons which will be set out in the following, the Board comes to the conclusion that, whatever answer might be given to the above general questions, the specific circumstances of the present case can only result in the revocation of the patent.

Thus there is no need for the Board in the present circumstances to further investigate the raised issues of the admissibility of sequences of divisional applications and of their proper handling, which therefore can be left open.



3. *The subject-matter of the grandparent application as originally filed*

As compared to the claims of the grandparent application as originally filed the claims of both the present patent and its parent application have been substantially amended. Before examining the extent and the legal consequences of these amendments, the Board will first examine the actual content of the grandparent application as filed, having regard in particular to the specific aspect of the path followed by the paper in the image forming apparatus.

The description of the grandparent application as filed starts with the following general statement: "This invention concerns an apparatus for forming an image on a sheet of paper, the apparatus being of the type comprising a casing having a paper insertion opening and a paper discharge opening, transport means within the casing for causing the sheet of paper to be transported along a paper transport path from the paper insertion opening to the paper discharge opening, and electrophotographic means for imparting the image to the sheet of paper while the latter is on the paper transport path" (see page 1, first paragraph).

The introductory portion of the description then proposes several specific statements of the invention in its different aspects, which all explicitly refer to the presence of a casing having a paper insertion opening or region and a paper discharge opening or region, and an internal paper transport path in between (see the paragraph bridging pages 1 and 2, the 1st paragraph on page 6, the paragraph bridging pages 6

and 7 and the 2nd paragraph on page 7).

The subsequent description of the drawings starts with a discussion of the drawbacks of the prior art arrangements as illustrated in Figures 13 and 14, respectively, in which a horizontal transport path within a casing connects paper insertion and paper discharge openings. This discussion stresses the impact on the floor area requirements of a paper stacker 8 located next to the paper insertion opening, which in the arrangement of Figure 13 adds the length  $l$  of the paper to the overall width  $w$  of the apparatus, a further additional paper length  $l$  being required for accommodating a paper delivery tray 18 next to the discharge opening (see page 10, lines 11 to 15 and page 11, lines 14 to 19). In the prior art arrangement of Figure 14, the paper delivery tray is provided on the top of the apparatus so that only the paper stacker 8 next to the insertion opening adds an additional paper length  $l$  to the depth  $D'$  of the apparatus (see page 11, lines 4 to 8 and 14 to 19).

The invention is then described with reference in particular to Figures 1 to 9, which all illustrate arrangements wherein sheets of paper fed from the outside of a casing follow a transport path which, in comparison with the horizontal path of the prior art arrangements of Figures 13 and 14, extends substantially vertically and behind the front wall of the casing. The printed sheets are then discharged from the front side of the casing.

The vertical arrangement of the internal transport path in these embodiments in particular allows for paper

feeding from an insertion opening adjacent the top of the casing and paper delivery from a discharge opening adjacent the bottom of the front of the casing (see page 14, lines 12 to 15). Thereby the size of the floor area required for installing the apparatus can be reduced, at the cost obviously of an increased height. This is emphasized in the first specific statement in the introduction of the description, according to which the invention is characterised in that the casing has a height which is greater than its depth (see the paragraph bridging pages 1 and 2).

The remaining Figures 10 to 12 illustrate various details of a cartridge including a rotatable photosensitive member, for use with the arrangements of the preceding figures.

The grandparent application as filed also comprises five independent claims of which independent claims 1, 30, 31 and 32 explicitly refer to an apparatus for forming an image on a sheet of paper comprising a paper insertion opening or region (19), a paper discharge opening or region (20) and a paper transport path (21) from the paper insertion opening (19) to the paper discharge opening (20).

Substantially the same limitations are implied by the wording of claim 33, the last independent claim, which specifies that the apparatus has a relatively small bottom area and a relatively large height and that "an unprinted sheet may be inserted from the upper side of the apparatus and the printed sheet of paper may be discharged from the lower front side thereof".

Thus, in the Board's view, and for the reasons also set out in its decisions T 905/97 and T 906/97, the direct feeding from the outside of the casing of recording media consisting of sheets of paper, envelopes or the like (see page 28, lines 8 to 12) through an insertion opening or region of the casing to a transport path extending within the casing is an essential feature of the invention as both disclosed and claimed in the grandparent application as originally filed.

4. *The effective filing date of the patent in suit*

The filing date indicated on the published specification of the present patent is 1 April 1987, the actual filing date of the grandparent application. The validity of this filing date was questioned neither in the examining nor in the opposition proceedings. It was derived apparently from the fact that the present patent was based on a parent application which itself, although actually filed on 16 July 1991, was granted the filing date of 1 April 1987 of the grandparent application, of which it was considered a divisional application.

The determination of the effective filing date of the patent in suit however constitutes an essential issue in the assessment of the grounds for opposition under Article 100(a) EPC raised against the patent, which has accordingly to be investigated by the Board.

For the following reasons, the Board comes to the conclusion that the filing date of 1 April 1987 could be validly derived neither from the parent application from which the present patent is a division, nor

directly from the grandparent application itself.

- 4.1 Deriving the filing date of 1 April 1987 from the parent application
- 4.1.1 The only independent claim of the parent application as actually filed on 16 July 1993 reads:

"1. Apparatus for forming an image on a record medium comprising a housing (23, 25); transport means (10, 13) for causing a record medium to be transported along a transport path, within the housing (23, 25) so as to be discharged therefrom face down; and image-imparting means (1-7, 11), including a rotary image-receiving member (1), within the housing (23, 25) for imparting the image to the record medium while the latter is on the transport path characterised in that the housing (23, 25) has an immovable part (25) and a movable part (23), the latter being pivotable about an axis parallel to that of the image-receiving member (1) so that the movable part (23) can be moved between open and closed positions in which access to the interior of the housing (23, 25) is respectively permitted and prevented, the arrangement being such that, when the movable part (23) is in the closed position, the transport path runs between the movable part (23) and the immovable part (25)."

This claim thus does not comprise any explicit or implicit reference to an insertion opening or region of the casing for the feeding of sheets of paper or other

recording media to the transport path within the casing, considered to be an essential feature of the invention disclosed originally in the grandparent application (see point 3 above).

The absence of such reference thus conveys the additional teaching, which was not comprised in the documents of the grandparent application as originally filed, that the arrangement set out in the claim may also be used in conjunction with apparatuses devoid of any insertion opening for the direct feeding of record media to the transport path, and in which for instance a roll of paper could simply be mounted into the casing through the pivotable door also defined in the claim, to be stored therein.

Neither did the independent claims of any of the requests presented by the respondent in the course of the appeal proceedings T 905/97 make such reference, which resulted in the revocation of the corresponding patent, under Article 100(c) EPC for the claims as granted and under Article 76(1) EPC for the claims as amended.

- 4.1.2 The parent application thus **never** met the requirement of Article 76(1) EPC with respect to the grandparent application, and it therefore **never** validly benefited from the latter's filing and priority dates. Neither, in consequence, could it have transferred any such inexistent benefits to any subsequent divisional application.

The EPO did not in the course of the examining procedure object to the compliance of the parent

application with the requirements of Article 76(1) EPC, and it actually granted a patent, which was eventually revoked by decision T 905/97. It is indeed questionable whether any rights at all could have been derived from such invalid parent application by a subsequent application filed as a divisional. In any case, even if this was admitted, in particular for the sake of the protection of the legitimate expectations of the patentee, the earliest filing date which such divisional could claim - and transmit to any further division - is the date of the actual filing of its parent application, i.e. the 16 July 1991.

The Board cannot in this respect endorse the respondent's reasoning to the effect that the present divisional application and its right to the benefit of the filing date of the grandparent application were to be considered independently of the actual status of the parent application. This would lead to the unacceptable result that the mere filing of a parent application comprising subject-matter extending beyond the contents of the grandparent application could, as such, open the possibility of any subsequent divisional application benefitting, for the same additional subject-matter, from a filing date at which it had not yet been disclosed.

#### 4.2 Deriving the filing date directly from the grandparent application

Since the present divisional application thus cannot derive the right to the filing date of the grandparent application from its filing as a division from the parent application, it remains to be considered whether

it might have derived it directly from the grandparent application itself.

Taking into account that, contrary to the provisions of Rule 25 EPC, at the actual filing date of the present application (25 June 1993) approval of the text, in accordance with Rule 51(4) EPC, in which the European patent corresponding to the grandparent application was to be granted had already been given (on 4 August 1992), the Board has doubts that the present application could be treated as if it had been divided directly from the grandparent application. However, even if this were admitted e.g. for the sake of the protection of the legitimate expectations of the patentee who was actually granted a patent on his application, it has to be considered that the main claims of the respondent's various requests also comprise subject-matter which was not disclosed in the grandparent application as originally filed. These claims too do not, for the following reasons, comprise any explicit or implicit reference to the essential feature of the grandparent application as originally filed of an insertion opening or region of the casing for the feeding of sheets of paper or other recording media to the transport path within the casing.

Thus, it would in the Board's view run against generally accepted principle of patent law if the present patent nevertheless benefitted from the filing date of the grandparent application.

- 4.2.1 The subject-matter of the patent in accordance with the respondent's main request



The only reference in claim 1 of the main request to the insertion of sheets of paper or other media is the indication at the end of the claim that the arrangement is "such that access space for insertion and discharge of the recording medium and the said access to the transport path (21), image-receiving member (1), transfer device (5) and fixing device (11) is only required at the front and top sides of the apparatus".

Although referring to an access space for the "insertion of the recording medium", the claim does not imply the feature, considered as an essential element of the apparatus originally disclosed in the parent application as filed, that the recording medium is fed from the outside through an opening in the casing for a sheet of paper. As a matter of fact the wording of the claim is still sufficiently general to encompass devices in which the recording medium is charged into a temporary storage tray within the housing, e.g. after having been inserted into the casing through the pivoted door also recited in the claim. However no such devices are disclosed in the grandparent application as filed.

The Board agrees to the appellant's submission that the deletion from the independent claims of the grandparent application as originally filed of the feature directed to an insertion opening in the casing conveys to the skilled reader the additional information that the casing may not only accommodate the transport means and the various components of the imaging means, with the recording media being fed from the outside as in the embodiments actually disclosed, but that it could also accommodate some kind of internal storage means for

unprinted recording media, thereby obviating the need for a paper insertion opening in the casing, at one end of the paper transport path.

This information cannot, in the Board's judgement, be considered to be supported by the original content of the grandparent application as filed, which discloses external feeding of paper sheets, envelopes or the like as an essential feature of the invention (see point 3, *supra*).

The respondent in this respect submitted that an insertion opening in the casing was a generic element of any imaging apparatus and that it was also necessary in an apparatus of the type comprising internally stored unprinted recording media, which still required some kind of access opening or door for the charging of the recording media into the housing. Such generic element did not need to be expressly recited in the claims.

In the Board's view, this argument misses the point insofar as it does not address the issue of whether an apparatus without an external feeding of the recording media through an insertion opening or region to the transport path was directly and unambiguously derivable from the grandparent application as filed. An *a posteriori* demonstration that the original claims, considered in isolation from the rest of the application documents, could possibly be construed in such a way as to **cover** a specific type of apparatus with an internal storage of the recording medium cannot provide convincing evidence that such specific apparatus was actually **disclosed** to the skilled person.

For these reasons claim 1 of the main request, corresponding to claim 1 as granted, extends beyond the content of the grandparent application as filed.

4.2.2 The subject-matter of the patent in accordance with the respondent's auxiliary request I

The additional limitation in claim 1 of auxiliary request I "that the record medium is discharged from the apparatus having moved from the transport means (13) after receiving the image about one centre of curvature only" neither specifies nor even concerns the way the recording media are inserted into the casing.

The claim in the so amended version does not therefore overcome the above objection as raised against claim 1 of the main request, that it extends beyond the content of the grandparent application as filed.

4.2.3 The subject-matter of the patent in accordance with the respondent's auxiliary request II

Claim 1 of the auxiliary request II further specifies that the transport path includes an opening in the said top and that the door includes the portion of the said top from the front to the said opening.

The claim thus refers to a single opening, without specifying whether said opening is actually provided for direct insertion of the recording media from the outside, rather than e.g. for the discharging of internally stored recording media. The version of claim 1 of auxiliary request II does not therefore overcome the above objections as raised against claim 1

of the main request.

- 4.2.4 The subject-matter of the patent in accordance with the respondent's auxiliary requests III and IV

The additional limitations introduced into claim 1 of auxiliary requests III and IV as compared to claim 1 of the main request, namely that the apparatus comprises a cartridge provided with the image-receiving member and the cleaning device (auxiliary request III), and that the access provided by the pivoted door is "direct" (auxiliary request IV) neither specify nor even concern the way the recording media are inserted into the casing.

The points made above in connection with claim 1 of the main request therefore equally apply to these auxiliary requests.

- 4.2.5 The respondent's auxiliary requests V to VIII

Claims 1 of the auxiliary requests V to VIII each recite the subject-matter of claim 1 of the main request, with various combinations of the additional features introduced into claim 1 of auxiliary requests I to IV.

For the reasons indicated above none of these additional features clearly expresses the direct feeding from the outside of the casing of recording media consisting of sheets of paper, envelopes or the like through an insertion opening or region of the casing to a transport path extending within the casing, which is considered an essential element of the

subject-matter originally described and claimed in the grandparent application.

4.2.6 The respondent's auxiliary requests IX to XI

In these auxiliary requests it is requested that a patent be granted on the basis of the main request amended in particular by adding to claim 1 "any one or more of claims 2 to 13 as granted" (auxiliary request IX), or amended by the features of "any of Auxiliary Requests I to VIII and any one or more of Claims 2 to 13 as granted" (auxiliary request X), or amended by "adding the feature added by auxiliary request IV together with the features added by Claim 1 of any of the other auxiliary requests".

These requests generally refer to a huge number of unspecified possibilities. Admitting such auxiliary requests would pose undue difficulties to the appellant (opponent) in dealing properly with a high number of combinations of claims. Moreover, these request do not comprise any text submitted by the patentee which could be considered and decided upon by the Board pursuant to Article 113(2) EPC.

Thus the Board considers the filing of the unspecified auxiliary requests IX to XI contrary to proper procedure and decides to refuse them (for the allowability of unspecified requests see e.g. decision T 206/93, not published in the OJ EPO, point 11 of the Reasons).

4.2.7 For these reasons the grandparent application as originally filed on 1 April 1987 did not disclose all

of the subject-matter of the patent in suit, and the respondent cannot therefore in the Board's opinion avail himself, in respect of the patent in suit, of the filing and priority dates of the grandparent application.

5. *Patentability*

It results from the above considerations that the earliest filing date from which the patent in suit could benefit is the actual filing date of the parent application, which is the 16 July 1991 (see point 4.1.2 *supra*).

The grandparent application was published on 7 October 1987 and it is accordingly part of the state of the art within the meaning of Article 54(2) EPC.

5.1 The respondent's main request

Claims 1 of the respondent's main request and of his auxiliary requests I to VIII contain features of an apparatus which in the patent as maintained by the opposition division is illustrated by reference to specific embodiments, which are all also disclosed in the published grandparent application.

Figure 5 of the grandparent application as published in particular shows an apparatus for forming an image on a record medium as is defined in claim 1 of the main request, comprising transport means (10, 13) for causing a record medium to be transported along a transport path within the apparatus so as to be discharged therefrom; a rotatable image-receiving

member (1) for receiving the said image; a transfer device (5) adjacent the transport path for transferring the image from the image-receiving member (1) to the record medium; and a fixing device (11) adjacent the transport path for fixing the image on the record medium. The apparatus of Figure 5 is further provided on a front side thereof with a door (23) which, when open, provides access to the transport path (21), image-receiving member (1), transfer device (5) and fixing device (11) within the apparatus and which is pivoted around an axis parallel to that of the image-receiving member (1), the arrangement being such that access space for insertion and discharge of the record medium and the said access to the transport path (21), image-receiving member (1), transfer device (5) and fixing device is only required at the front and top sides of the apparatus.

Thus, Figure 5 of the published grandparent application shows all the features of claim 1 of the main request. The subject-matter of claim 1 of the main request therefore lacks novelty within the meaning of Article 54 EPC.

The respondent in this respect submitted that the subject-matter of claim 1 could not simultaneously be considered to extend beyond the scope of the content of the grandparent application, and lack novelty in view of it. This argument however overlooks that the extension objected to above consists in a generalisation of the originally disclosed subject-matter, resulting from the omission of the feature of the insertion opening. The test for the admissibility of such generalisations differs from the test for

novelty (see in particular the decision T 194/84; OJ EPO 1990, 59; point 2.4 of the Reasons).

## 5.2 The respondent's auxiliary requests

Devices as defined in claim 1 of the main request which further exhibit the additional features set out in claims 1 of the auxiliary requests I to IV or any of their combinations in accordance with the auxiliary requests V to VIII are also illustrated in the grandparent application as published, or result from obvious combinations of the embodiments disclosed there.

Figure 5 of the published grandparent application, which discloses the features of claim 1 of the main request (see point 5.1 above) also illustrates the discharging of the record medium from the transport means 13 having moved after receiving the image about one centre of curvature only, as is set out in the additional feature of claim 1 of auxiliary request I, the cartridge 26 with the image receiving member and the cleaning device defined in the additional limitation brought to claim 1 of the auxiliary request III (see also the corresponding description, column 13, lines 29 to 37 of the published grandparent application), and the "direct" access through the door 23 to the transport path, image-receiving member, transfer device and fixing device as set out additionally in claim 1 of the auxiliary request IV. The subject-matter of claims 1 of auxiliary requests I, III and IV therefore also lacks novelty within the meaning of Article 54 EPC.



The additional limitation of claim 1 of auxiliary request II referring to an opening in the top surface of the apparatus, the door including the portion of the said top from the front to the said opening, results from the straightforward use of the door and casing design illustrated in Figure 5 of the grandparent application with the apparatus exhibiting the inner structure shown in Figures 3 or 4, with a view to providing an easy access to said inner structure. The subject-matter of this claim therefore lacks an inventive step within the meaning of Article 56 EPC.

The respondent's auxiliary requests IX to XI need not be considered further (see point 4.2.6 above)

5.3 For these reasons the grounds of opposition mentioned in Article 100(a) EPC prejudice the maintenance of the patent in suit, which must be revoked, accordingly (Article 102(1) EPC).

6. *Referral of questions to the Enlarged Board of Appeal*

6.1 The respondent in his auxiliary requests A and B requested that two questions be referred to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC (see the two last paragraphs of point VIII of the Summary of Facts and Submissions).

6.1.1 The first part of the question in accordance with auxiliary request A is related to the respondent's argument that in the case of a patent granted on an application filed as a division of an earlier application, only the second part of Article 100(c) EPC actually applied, i.e. that the subject-matter of the

patent was only required not to extent beyond the content of the earlier application as filed, possible extensions beyond the content of the divisional application as filed being however of no consequences.

The Board however needs not, in its reasoning, consider the specific issue of the subject-matter of the patent extending beyond the content of the **divisional application** as originally filed, so that this part of the question is irrelevant to the present decision. Moreover this question has already been considered by the Boards of Appeal. In decision T 434/97 (not published in the OJ EPO) the Board *inter alia* ruled that in the case of a patent granted on the basis of a divisional application the grounds for opposition under Article 100(c) EPC had to be interpreted to the effect that the patent shall extent neither beyond the content of the parent application as filed, nor beyond that of the divisional application as filed (see point 3.1 of the Reasons). The respondent did not identify any decision of the Boards of Appeal of the EPO in support of a different interpretation.

- 6.1.2 The second part of the question in accordance with auxiliary request A, and the question in accordance with auxiliary request B relate to the admissibility of divisional applications filed from still earlier divisional applications, and to the proper application of Article 100(c) and Rule 25 EPC in such case.

These questions may indeed be of a general interest, and the responses to them could have been essential to the decision, had the parent application, from which the second-generation divisional application was

divided, constituted itself a genuine divisional application of the grandparent application.

This is not however the case here, and for the reasons set out above the patent cannot possibly have benefitted from the filing date of the grandparent application, whatever the correct answers to the questions formulated by the respondent might be, with the consequence that the claimed subject-matter is not patentable in view of the prior art constituted by the publication of the grandparent application.

6.1.3 Thus, the specific circumstances of the present case are such that no decision by the Enlarged Board of Appeal is required in respect of the questions in accordance with the respondent's auxiliary requests A and B. These auxiliary requests must be rejected, accordingly.

6.2 The question which the appellant requested to be referred to the Enlarged Board of Appeal relates to the admissibility under Article 123(2) EPC of an amendment consisting in deleting description parts and drawings and combining the remaining drawings to embodiments not originally disclosed in a divisional application (see the point VII of the Summary of Facts and Submissions).

This specific question is of no relevance either to the reasons of the present decision as set out above.

Moreover, referral to the Enlarged Board of Appeal was requested by the appellant as an auxiliary request only and thus need not be considered as his main request that the patent be revoked is allowed.

**Order**

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

1. The decision under appeal is set aside.
2. The European patent No. 0 562 648 is revoked.

The Registrar:

The Chairman:

P. Martorana

E. Turrini