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D E C I S I O N
of 29 February 2000

Case Number: T 0783/98 - 3.5.1

Application Number: 90902732.8

Publication Number: 0456704

IPC: G06K 7/10

Language of the proceedings: EN

Title of invention:

Scanning system with array of laser scanner modules to produce complex scan pattern

Patentee:

METROLOGIC INSTRUMENTS, INC.

Opponent:

Erwin Sick GmbH Optik-Elektronik

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 84, 111(1)

Keyword:

"Amendment - added subject-matter - (after amendment: no)"
"Claims - clarity (after amendments: yes)"
"Decision re appeals - remittal (yes)"

Decisions cited:

-

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0783/98 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 29 February 2000

Appellant: METROLOGIC INSTRUMENTS, INC.
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Respondent: Erwin Sick GmbH Optik-Elektronik
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Representative: Mantiz, Finsterwald & Partner
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 29 May 1998
revoking European patent No. 0 456 704 pursuant
to Article 102(1) 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. 0 456 704 granted on the basis of European patent application No. 90 902 732.8 (International publication number WO 90/09006), the mention of the grant having been published on 8 June 1994.

Patent claim 1 is directed to a scanning system for reading a bar code on an object, the system comprising "plural laser scanner modules" for producing "a complex scan pattern (...) formed of plural scan lines (...), each of said lines being produced by a respective one of said laser scanner modules".

- II. Against the patent, an opposition was filed on 8 March 1995, invoking the grounds of opposition set out in Article 100(a) EPC and requesting revocation of the patent in its entirety. In the course of the opposition proceedings, the patent proprietor amended claim 1, replacing the expression "plural laser scanner modules" by the definition "plural multiple laser scanner modules".

After having raised objections against this definition in several communications, the opposition division, in a decision posted on 29 May 1998, revoked the patent finally on the basis of Articles 84 and 123(2) EPC for the reasons of lack of clarity and added subject-matter.

- III. Against the revocation of the patent, the appellant filed a notice of appeal on 7 August 1998, requesting reversal of the decision. The appeal fee was paid the

same day; the grounds of appeal were subsequently filed on 7 October 1998.

With the grounds of appeal, the appellant filed two sets of amended claims. In claim 1 of the main request the objected expression was replaced by the definition "multiple laser scanner modules", in claim 1 of the auxiliary request by the definition "multiple single-line laser scanner modules". Oral proceedings were requested as a subsidiary measure.

The respondent again raised objections on grounds of lack of novelty and inventive step. With respect to the auxiliary request, however, the respondent proposed amendments to claim 1 and indicated that against a claim amended as proposed no further objections would be raised; when the appellant agreed on such a claim, the request for oral proceedings would be withdrawn.

In a subsequent letter dated 29 September 1999, the appellant filed, under the title "NEW AUXILIARY REQUEST" a set of amended claims and amended pages 1, 3, 3a and 4 of the description, the amendment of claim 1 following the proposal made by the respondent. This new auxiliary request still uses the definition "multiple single-line laser scanner modules" of the former auxiliary request. Regarding these requests, the letter reads as follows:

"We would be willing in the interest of efficiency to withdraw the main request if the Board of appeal indicates that it is prepared to allow the new auxiliary request. We would also withdraw the request for oral proceedings if the auxiliary request is

allowed."

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. As to the requests on file, it is noted that the appellant subjects the fate of the "main request" to the allowability of the "new auxiliary request". Therefore, the "new auxiliary request" is actually the new main request to which the former main request as filed with the statement of grounds is subordinated as auxiliary request.

3. When compared with claim 1 as granted, both requests replace, in the definition of the laser scanner modules, the term "plural" by the term "multiple". Having regard to the ordinary meaning, these two terms are synonymous expressions indicating the involvement of more than one element, part etc. In the field of scanning devices and systems, although the term "multiple" is more in current use, neither of these terms has a special meaning which would imply a technical difference concerning the definition of the laser scanner modules. Therefore, in the present case replacing the one by the other term does neither change the technical meaning nor the scope of the claims and is thus allowable under Article 123(2) and (3) EPC.

The amendments also remove the double definition "plural multiple" objected to for grounds of lack of

clarity in the decision under appeal.

4. Therefore, the objections on which the revocation is based are now unfounded. However, both requests include further amendments of the claims which have still to be examined as to their compatibility with the requirements of the EPC. In addition, the grounds of opposition, essentially lack of novelty and inventive step, have not yet found a final assessment in the first-instance decision. Therefore, the Board considers it appropriate to remit the case to the opposition division for further prosecution on the basis of the present main and auxiliary requests.

Considering that the case will have to receive full consideration in the first instance and the right to be heard in oral proceedings before the competent body, i.e. in the first instance the opposition division, is preserved, the present requests for oral proceedings before the Board are refused.

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