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D E C I S I O N
of 28 January 2003

Case Number: T 0123/01 - 3.5.1

Application Number: 93306180.6

Publication Number: 0583920

IPC: H04L 12/26, H04L 12/56

Language of the proceedings: EN

Title of invention:
Asynchronous transfer mode (ATM) transmission test cell generator

Patentee:
AT&T Corp.

Opponent:
TEKTRONIX Berlin GmbH & Co. KG

Headword:
Test cell generator/AT&T

Relevant legal provisions:
EPC Art. 123(3)
EPC R. 57a

Keyword:
"Remittal to the first instance"

Decisions cited:
-

Catchword:
-



Case Number: T 0123/01 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 28 January 2003

Appellant: AT&T Corp.
(Proprietor of the patent) 32 Avenue of the Americas
New York, NY 10013-2412 (US)

Representative: Buckley, Christopher Simon Thirsk
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Respondent: TEKTRONIX Berlin GmbH & Co. KG
(Opponent) Wernerwerkdam 5
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Representative: Schurack, Eduard F.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 8 December 2000
revoking European patent No. 0 583 920 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. S. Wibergh
E. Lachacinski

Summary of Facts and Submissions

- I. This is an appeal by the proprietor of European Patent no. 0 583 920 against the decision of the Opposition Division to revoke the patent.
- II. The respondent opposed the patent on the ground that the invention did not involve an inventive step. In the first-instance proceedings, after the Opposition Division had summoned the parties to oral proceedings in order to discuss this ground of opposition, the patent proprietor filed new claims 1, 4 and 11 and requested, as only request, that the patent be maintained on the basis of these claims. It was explained in the accompanying letter (dated 12 September 2000) that the claims had been amended "in order to correct an apparent inconsistency with Fig.1".
- III. With fax dated 6 October 2000 the patent proprietor's representative informed the Opposition Division that he would not be attending the oral proceedings and requested that the proceedings be determined on the basis of the written submissions.
- IV. Oral proceedings before the Opposition Division were held on 13 October 2000 in the absence of the patent proprietor. The Opposition Division decided to revoke the patent because the amendments to claim 1 had caused the protection conferred to be extended, contrary to Article 123(3) EPC.
- V. The patent proprietor (appellant) lodged an appeal against this decision. Together with the statement setting out the grounds of appeal (dated 21 March 2001) new versions of claims 1, 4 and 11 according to a main

and an auxiliary request were filed.

The claims according to the main request were said to be formulated with a view to eliminating any confusion which may have been caused by inconsistencies in the claims on which the decision under appeal was based, and were "consistent with the claims originally granted and comport with the description of the invention as included in Figure 1".

The claims according to the auxiliary request were said to include identical language to that of the claims originally granted with the exception that certain reference numerals had been amended in order to clarify inconsistencies.

- VI. In a letter dated 25 September 2001 the respondent (opponent) argued that the claims according to the appellant's main request infringed Article 123(3) EPC and that the changes to the reference signs caused confusion and were not supported by the description, contrary to Article 84 EPC.

- VII. In a communication pursuant to Article 110(2) EPC the Board expressed its preliminary opinion that none of the amendments to the granted claims was "occasioned by grounds of opposition", as required by Rule 57a EPC. Therefore, neither the claim formulation according to the patent proprietor's main request nor according to the auxiliary request could serve as a basis for consideration by the Board. It was however pointed out that the situation would change if the appellant were to request consideration of the patent in the granted version.

VIII. By letter dated 7 January 2003 the appellant requested that the patent be considered in the granted version.

IX. The respondent requested with letter dated 25 September 2001 that the appellant's then valid main and auxiliary requests be refused. The respondent's request is now understood by the Board as aiming at the dismissal of the appeal.

Reasons for the Decision

1. The appellant requests that the patent be considered in the version as granted. The decision based on the Opposition Division's finding that the scope of protection has been extended must therefore be set aside.
2. Since the Opposition Division has not yet decided on the grounds of opposition invoked by the respondent, the case is remitted to the Opposition Division for further prosecution.

Order

For these reasons, it is decided that:

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

The Registrar:

The Chairman:

D. Sauter

S. Steinbrener