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D E C I S I O N
of 18 September 2002

Case Number: T 0726/01 - 3.5.1

Application Number: 95930610.1

Publication Number: 0777863

IPC: G01S 5/14

Language of the proceedings: EN

Title of invention:
Navigation information system

Patentee:
BRITISH TELECOMMUNICATIONS public limited company

Opponent:
Mannesmann AG

Headword:
Navigation system/BRITISH TELECOMMUNICATIONS

Relevant legal provisions:
EPC Art. 107, 108
EPC R. 65(1)

Keyword:
"Admissibility of appeals (no)"

Decisions cited:
T 0613/97, T 0349/00

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0726/01 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 18 September 2002

Appellant: (Opponent)
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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted 19 April 2002 concerning maintenance of European patent No. 0 777 863 in amended form.**

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. S. Wibergh
S. C. Perryman

Summary of Facts and Submissions

I. This decision is concerned with the appeals by the patent proprietor and the opponent against the interlocutory decision of the Opposition Division finding European Patent no. 0 777 863 in amended form to meet the requirements of the EPC.

II. Amended claim 1 as received with letter dated 14 March 2001 reads as follows:

"A navigation information system for providing information to one or more mobile users dependent on the locations of the mobile users, the system comprising:
a fixed part, being a mobile communications system (11-20) for providing information to one or more mobile users dependent on their locations, the fixed part comprising:
location determining means (14,15,17) for determining the location of a mobile unit requesting guidance data,
guidance data generation means (18,15,14) for generating data for guidance of the user of the mobile unit according to the present location of the mobile unit,
a communications system (11,13) for transmitting the guidance data so generated to the mobile unit,
receiver means (14,16) for receiving requests from the mobile unit relating to a specified destination,
wherein the guidance data generation means (14,15) further generates guidance data according to the specified destination, such that
guidance data dependent both on the present location and the specified destination of the mobile unit can be transmitted to the mobile unit,

means (16,14,13) for transmitting to the mobile unit an expected range of movement information,
and means (12,14,16) for receiving from the mobile unit movement measurements outside the expected range,
the fixed part being in combination with one or more mobile units (1-10) for communicating with the fixed part, each mobile unit including means (6,8,10,1) for transmitting to the fixed part a request for guidance data relating to a destination specified by the user of the mobile unit, and means (1,9,5,6) for receiving such guidance data from the fixed part,
characterised in that at least one mobile unit comprises means for measuring location and time to derive movement information, means to compare the movement information with the expected range received from a fixed part of the system, and means to automatically report to the fixed part of the system movement measurements outside the expected range".

Independent claims 4 and 8 relate to a corresponding mobile unit and a corresponding method of providing navigation data, respectively.

III. According to the decision under appeal (points 1.8 and 2.5), the patent proprietor's request at the oral proceedings before the Opposition Division held on 9 March 2001 was "to maintain the patent according to the revised main request or according to one of the auxiliary requests if the main request cannot be maintained", but also "to delete the non-allowable claims of the revised main request". The decision contains reasons (points 2.3, 2.4 and 3) why 17 of the 48 claims referred to as the "revised main request" filed on 6 March 2001 (cf. point 1.6 of the decision) were regarded as acceptable - and in particular why

their subject-matter involved an inventive step with respect to D1 (DE-A-41 39 581) - and the other claims not. On EPO form 2327 the listing of the documents on which the decision is based does not refer to this set of claims but to claims 1-17 received with the patent proprietor's letter dated 14 March 2001. This letter contains the following text: "Further to the Oral Proceedings held on 9 March 2001, I enclose a typed up copy of the amended specification as agreed during the Oral Proceedings". The letter is signed by the person who represented the patent proprietor at the oral proceedings.

IV. According to the minutes of the oral proceedings, point 3.6, the patent proprietor's final request was "to maintain the patent according to the amended revised main request". At point 3.7 it is stated that "a copy of the amended claims and description pages according to the Proprietor's final request is appended to the minutes". This copy consists of the "revised main request" with those claims which were not regarded as acceptable by the Opposition Division having been deleted by hand and the acceptable claims having been renumbered 1-17. The copy is not signed.

V. The patent proprietor lodged an appeal against the Opposition Division's decision. In the statement setting out the grounds of appeal (point 9) it was argued that the deletion of claims from the "revised main request" held unacceptable by the Opposition Division had been "at the instigation of the Opposition Division", not at the request of the patent proprietor. As the decision did not correspond to any request expressly made by the patent proprietor, the proprietor was adversely affected by it. The fact that the

decision contained reasoning against those claims of the "revised main request" which were held not acceptable proved that a decision adverse to the proprietor to reject these claims had been made (point 10).

VI. The opponent also lodged an appeal against the decision. In the grounds of appeal it was stated that the Opposition Division had found the most important features of all claims not to be inventive and that it was not understandable why the present main claim should be inventive, especially considering that it did not contain a true combination of features but merely a concatenation ("Aneinanderreihung"). Therefore, according to the opponent, the Board was justified in checking the brief grounds in favour of an inventive step given in the written decision.

VII. In a communication from the Board the preliminary view was given that neither appeal was admissible.

VIII. In reply to this communication the patent proprietor stated in a letter dated 9 April 2002 that it was content for the Board of Appeal's preliminary opinion to be made substantive and that if the Board found both appeals inadmissible, the patent proprietor would withdraw its previous request for oral proceedings before the Board.

The opponent, in its letter of reply dated 23 May 2002, maintained its view that its appeal was admissible. The decision under appeal was analysed in the light of the closest prior art.

IX. The Board cited the parties to oral proceedings. The

opponent then withdrew its previous request for a hearing, whereupon the Board cancelled the oral proceedings.

Reasons for the Decision

1. *Admissibility of the patent proprietor's appeal*

1.1 A party is entitled to appeal if "adversely affected" by a decision (Article 107 EPC). A patent proprietor is not considered to be adversely affected if an opposition division maintains the patent in amended form on the basis of the patent proprietor's main request (see eg T 0613/97, not published in OJ EPO; Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, p. 523).

1.2 The patent was maintained on the basis of 17 claims. The other claims of the set of 48 claims filed on 6 March 2001 and referred to in the decision under appeal as the "revised main request" were according to the decision (point 2.5) deleted at the patent proprietor's request. This is denied by the appellant proprietor who has submitted that the deletion was instead "at the instigation of the Opposition Division" and that the decision did "not correspond to any Request expressly made by the Proprietor".

1.3 Although not signed, as required by Rules 36(3) and 61a EPC, the set of claims numbered 1-17 annexed to the minutes of the oral proceedings before the Opposition Division were apparently filed by the patent proprietor at the hearing. This finding has not been contested by the patent proprietor. The presence of these claims on

the file is therefore taken to prove that the patent proprietor did request maintenance of the patent in this form at the oral proceedings. The fact that the patent proprietor filed a fair copy of these claims on 15 March 2001 with the remark "as agreed during the Oral Proceedings" also supports this conclusion. Nor is there any indication that these claims would merely have corresponded to an auxiliary request. On the contrary, according to the minutes (point 3.6) the patent proprietor's final request was indeed maintenance of the patent "according to the amended revised main request".

1.4 In the grounds of appeal, point 10, the patent proprietor argues that since the decision under appeal contains reasons for rejecting the claims contained in the "revised main request" as filed which were not held acceptable by the Opposition Division (ie all claims except those renumbered 1-17), the patent proprietor is adversely affected. This would however only be true if there were no other reasons to believe that these claims were not part of the patent proprietor's final main request. In the present case, however, such reasons do exist (see the preceding paragraph). Therefore, any reasoning pertaining to other claims than those renumbered 1-17 is irrelevant and no inferences can be drawn from its presence in the decision.

1.5 Thus the Board takes the view that the patent proprietor was not adversely affected by the decision under appeal and that for this reason its appeal is inadmissible (Article 107 with Rule 65(1) EPC).

2. *Admissibility of the opponent's appeal*

2.1 The opponent's grounds of appeal mainly consist in a reference to its previous submissions in the opposition proceedings and in the allegation that the features of the main claim are a mere concatenation, without inventive merit.

As a matter of principle, a general reference to earlier submissions cannot be considered to constitute a sufficient statement setting out the grounds. Such submissions can only be recognised as possible grounds for an admissible appeal under specific circumstances which do not exist in the present case (see eg T 0349/00, not published in OJ EPO).

2.2 It is mentioned in the minutes of the oral proceedings before the Opposition Division (point 3.3) that in the opponent's opinion D1 taught the feature that "time and geographical position of the mobile unit are measured outside an expected range". The Opposition Division decided however that D1 did not render the invention obvious since, according to the invention, "'expected range information' is transmitted from the fixed part of a navigation system to a mobile part" (decision, point 2.3). The difference between the invention and D1 was thus seen to reside in *the way* the position outside an expected range was measured, viz by transmitting expected range information to the mobile unit. This is more specific than the mere indication that a measurement *is* performed.

2.3 Thus, the grounds of appeal do not indicate clearly what previous arguments are relied on, nor explain why the Opposition Division's assessment of D1 should have been incorrect. As it is, the proprietor as well as the Board are left in the dark as to the reasons for the

opponent's criticism of the decision. This is, in the Board's opinion, the kind of situation that the requirement for setting out the grounds of appeal (Article 108 EPC) is intended to prevent.

2.4 In the letter to the Board dated 23 May 2002 the opponent has presented an analysis of the decision under appeal with reference to D1, claiming that certain statements in the decision are erroneous. However, arguments as to the merits of the invention which are filed outside the time limit allowed for filing the grounds of appeal have no bearing on the admissibility of the appeal.

2.5 The Board is consequently of the opinion that the opponent's appeal is inadmissible because grounds of appeal in the meaning of Article 108 EPC have not been filed in time.

Order

For these reasons, it is decided that:

The appeals are rejected as inadmissible.

The Registrar: The Chairman:

M. Kiehl S. Steinbrener