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D E C I S I O N
of 12 September 2002

Case Number: T 0587/02 - 3.5.1

Application Number: 99966434.5

Publication Number: 1142307

IPC: H04N 5/00, G06F 9/46

Language of the proceedings: EN

Title of invention:
Method and apparatus for operating system kernel operations

Applicant:
PowerTV, Inc.

Opponent:
-

Headword:
Kernel operations/POWERTV

Relevant legal provisions:
EPC Art. 113(1)
EPC R. 51(3), 67

Keyword:
"Substantial procedural violation (yes); refund of appeal fee (yes)"
"International Preliminary Examination Report sufficiently reasoned (no)"

Decisions cited:
T 0802/97, T 0275/99

Catchword:

If the only communication preceding the decision to refuse an application merely draws attention to an International Preliminary Examination Report (IPER), the requirements of Article 113(1) EPC are met provided the IPER constitutes a reasoned statement as required by Rule 51(3) EPC, using language corresponding to that of the EPC; in the case of an inventive step objection this will require a logical chain of reasoning which can be understood and, if appropriate, answered by the applicant.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0587/02 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 12 September 2002

Appellant: PowerTV, Inc.
20833 Stevens Creek Boulevard
Suite 100
Cupertino
CA 95014-2154 (US)

Representative: Balsters, Robert
Novagraaf International SA
25, Avenue du Pailly
CH-1220 Les Avanchets - Geneva (CH)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 7 March 2002 refusing European patent application No. 99 966 434.5 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: S. V. Steinbrener
Members: A. S. Clelland
P. H. Mühlens

Summary of Facts and Submissions

I. This is an appeal against the decision of the examining division to refuse application No. 99 966 434.5 on the ground of lack of inventive step.

II. The application, claiming the priority of a US application, was filed as an international application and, following an International Search Report (ISR) established by the European Patent Office, published under the number WO 00/40006. The application as filed and published included 30 claims of which claims 1, 12 and 23 were independent claims, claim 1 being directed to "A computer-implemented thread for communicating with other threads in a set-top box environment", and claims 12 and 23 to "A computer-implemented apparatus for swapping threads within a central processing unit (CPU) in a set-top box environment".

III. Subsequently an International Preliminary Examination Report (IPER) was drawn up by the USPTO, acting as International Preliminary Examining Authority. In the IPER an objection of lack of inventive step was raised against all 30 claims on the basis of a document cited in the ISR in combination with a newly introduced document. The IPER included a reasoned statement in accordance with Article 35(2) and Rule 70.8 PCT, given in full below without amendment:-

"2. citations and explanations (Rule 70.7)

1- Claims 1-30 lacks an inventive step under PCT Article 33(3) as being obvious over Cutler et al. in view of "REGISTER MASK MICROPROCESSOR CONTEXT SWITCHING", RESEARCH DISCLOSURE, GB, INDUSTRIAL

OPPORTUNITIES LTD. HAVANT, no 318, 1 October 1990 (from here on, disclosure 318).

Regarding claims 1, the reference of Cutler teaches:

- a stack for data storage for the threads (saving g thread information by pushing into kernel mode stack pointer, col. 11, lines 32-44);

- a thread control block for storing context information (kernel thread object that contain the current state of a thread, col. 9, lines 59-68, continued on col. 10, lines 1-14);

- a queue object for providing the communication between the thread and another thread (Queue object for maintaining the concurrency level and interaction between threads, col. 4, lines 16-50, and col. 12, lines 43-52).

The reference of Cutler fails to teach of a set-top box (real-time) environment. Disclosure 318 teaches of a microprocessor context switching system in a real time environment in which the context of the interrupted process is being saved in order for the compiler to be aware of the state of the processe's context at anytime. Therefore, it would have been obvious for one ordinary skill in the art at the time the invention was made to use the real-time context switching system of disclosure 318 in the Queue Object concurrency method of Cutler.

Regarding claims 2-11, and 29 and status information such as run-time and priority level of the threads, of the threads the reference of

Cutler teaches of attributes of the "process object" in col. 8, lines 48-68, continued on col. 9, lines 1-22.

regarding type detector and register recorder in claims 12-22, 23-28 and 30, the reference of Cutler teaches of "object type", and "status register" in col. 8, lines 38-46 and col. 11, lines 32-44 respectively.

----------NEW CITATIONS----------

US 5,752,031 A (CUTLER et al.) 12 MAY 1998, see column 3, lines 40-53, col. 4, lines 25-68, continued on col. 5, lines 1-17, col. 13, lines 5-22, 54-68, col. 15, lines 15-48."

IV. The application then entered the regional phase and an official communication was issued by the examining division. This communication started off by referring to five documents, including "disclosure 318" and the Cutler patent mentioned above. Objection was then raised that the presence of three independent claims of similar or overlapping scope did not meet the conciseness requirement of Article 84 EPC and that the claims were unclear. It was stated that the category of claim 1 was not clear from the wording and reference made to the exclusion from patentability of software. The communication went on to raise objection of lack of inventive step against all the claims, in the following terms:-

"Prior art:

An international preliminary examination report has been drawn up for the present application in accordance

with the PCT by the USPTO. The deficiencies mentioned in that report give rise to objections under the corresponding provisions of the EPC.

Hence, the subject-matter of claims 1, 12 and 23 lacks an inventive step under EPC Art. 56 as being obvious over document D5 in view of document D1."

D1 is "disclosure 318" and D5 the Cutler Patent.

V. In response to this communication the applicant filed a revised set of claims numbered 1 to 19, deleting original claims 1 to 11 and retaining claims based on original claims 12 to 30. It was argued that the revised claims were novel and inventive, particularly with respect to the teaching of the Cutler Patent.

VI. The examining division thereafter refused the application for lack of inventive step, based on the disclosure of the two documents cited in the IPER.

VII. The applicant (appellant) has appealed on the ground that the impugned decision violates the right to be heard, Article 113(1) EPC, because the first substantiated objection under the EPC is contained in the decision to refuse the application. It is argued that a substantial procedural violation has been committed, justifying the cancellation of the decision and a refund of the appeal fee.

Reasons for the Decision

1. The appeal complies with the conditions mentioned in Rule 65(1) EPC; it is accordingly admissible.

2. Article 113(1) EPC states that the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. In the present case the appellant argues that the objection which resulted in refusal of the claims for lack of inventive step was formulated for the first time in the impugned decision.

3. The Board notes that the communication preceding the decision merely draws attention to the IPER drawn up by the USPTO and asserts that "The deficiencies mentioned in that report give rise to objections under the corresponding provisions of the EPC". It is also noted that the Guidelines, see Part E, Chapter IX, paragraph 6.4.3 state that "If the international preliminary examination report has been drawn up by the EPO (emphasis added by the Board), that report is to be regarded as an opinion for purposes of examination and generally the first communication will only refer to the opinion expressed in the IPER". This issue was considered by the boards of appeal in decision T 275/99 (not published), which held that Article 113(1) EPC could be met by the incorporation, by way of reference, of an IPER in an official communication from an examining division. In that particular case it was found that the appealed decision was entirely based on the grounds, facts and evidence which were already known to the appellant from the extensive IPER which had been drawn up for the description and claims of the international application, which corresponded exactly to the European application refused (see point 5.4 of the reasons).

4. Although this decision does not state whether the IPER

was drawn up by the EPO or another International Preliminary Examining Authority, the present Board sees no objection to citing an IPER from an International Preliminary Examining Authority other than the EPO, provided that it constitutes a reasoned statement as required by Rule 51(3) EPC, using language corresponding to that of the EPC; in the case of an inventive step objection this will require a logical chain of reasoning which can be understood and, if appropriate, answered by the applicant. The Board would nevertheless like to add that it considers the restriction in the Guidelines to IPERs issued by the EPO to be a reasonable matter of precaution since it cannot be expected that an IPER from an IPEA other than the EPO will meet specific EPC requirements.

5. It is accordingly necessary to consider the wording of the IPER to see whether the objections giving rise to refusal and their basis in the EPC can be identified.

6. In the Board’s view the IPER fails to meet this test. Almost the entire discussion is taken up with the cancelled original claim 1 and the claims appendant to it. Only a single sentence in the document refers to the claims corresponding to the present independent claims; this sentence identifies two of the features of present claim 1 as known from one of the cited documents, the document discussed by the appellant in the response to the examining division’s communication. The remaining features of claim 1 are not identified in the prior art whilst only one of the features of present claim 12 is identified. Although passages in the two cited documents are mentioned it is not made clear how these are relevant to the features of the present claims. There is accordingly no logical chain

of reasoning which would have permitted the appellant to understand and deal with the objections, either by amendment or counter-argument. Indeed, specifically for the purposes of the claims now presented the IPER does little more than identify two documents and cite two passages which are said to render all the claims obvious. Even by careful analysis on the part of the reader an argument to be answered could only be constructed with difficulty. A logical chain of reasoning was given for the first time in the impugned decision, using the problem-solution approach and referring to a comprehensive selection of prior art passages differing from those mentioned in the IPER for the original claims.

7. The deficiencies of the IPER could have been met by supporting reasoning in the communication but this was not done. Indeed, the communication confuses matters further by mentioning 5 documents in the introductory paragraph but only citing the two referred to in the IPER, in the context of claim delimitation and prior art acknowledgment and without discussion of their contents.

8. The Board would also observe that the refusal of the application after one action implies that the appellant made no real effort to deal with the examining division’s objections (see Guidelines, part C, Chapter VI, paragraph 2.5 and decision T 802/97 (not published in OJ EPO)). Given that the appellant deleted claims 1 to 11 and presented arguments, even though no clear case to be answered had been made, this is patently not the case.

9. In the circumstances of the case, the Board takes no

position on the inventive step objection resulting in refusal of the application and remits the case to the department of first instance for a full substantive examination on the basis of the EPC. In order to guarantee a fair conduct of the further proceedings a different composition of the examining division should be considered by the first instance.

10. Since the applicant’s right to be heard has been violated a substantial procedural violation has been committed; the Board therefore considers it equitable to refund the appeal fee in accordance with Rule 67 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside

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

3. The appeal fee is refunded

The Registrar: The Chairman:

M. Kiehl S. V. Steinbrener