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D E C I S I O N
of 4 April 2006

Case Number: T 0707/04 - 3.5.02

Application Number: 94927924.4

Publication Number: 0714541

IPC: G08B 17/107

Language of the proceedings: EN

Title of invention:

Self-diagnostic smoke detector and method of verification thereof

Patentee:

Interlogix, Inc.

Opponent:

Hochiki Corporation

Headword:

-

Relevant legal provisions:

EPC Art. 100(c), 111(1)

EPC R. 64(a), 65(2)

Keyword:

"Name of the appellant, grounds of appeal sufficient, appeal admissible (yes)"

"Admissibility of a fresh ground of opposition (yes)"

"Remittal to the department of first instance (yes)"

Decisions cited:

T 0097/98, G 0009/91, G 0010/91

Catchword:

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Case Number: T 0707/04 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 4 April 2006

Appellant: Interlogix, Inc.
(Proprietor of the patent) 2266 Second Street North
North Saint Paul, MN 55109 (US)

Representative: Körber, Martin Hans
Mitscherlich & Partner
Patent- und Rechtsanwälte
Postfach 33 06 09
D-80066 München (DE)

Respondent: Hochiki Corporation
(Opponent) 10-43, Kamiosaki
2-Chome, Shinagawa-Ku
Tokyo (JP)

Representative: Koch, Thomas
Hoffman Eitle,
Patent- und Rechtsanwälte
Arabellastrasse 4
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 5 April 2004
revoking European patent No. 0714541 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: M. Rognoni
Members: M. Ruggiu
E. Lachacinski

Summary of Facts and Submissions

- I. This case concerns an appeal of the proprietor against the decision of the opposition division to revoke European patent No. 0 714 541.
- II. The independent claims 1 and 20 of the patent in suit as granted read as follows:
1. "A self-diagnostic smoke detector, comprising a signal sampler (24, 28, 202) cooperating with a radiation sensor (28) to produce signal samples indicative of periodic measurements of a smoke obscuration level in a spatial region; and a processor (200) receiving and processing the signal samples and comparing the signal samples to multiple threshold values, characterised by one of the threshold values being based on a fixed standard and representing a smoke obscuration alarm level and another of the threshold values being based on a fixed standard and representing a tolerance limit for the radiation sensor, and the processor determining from the signal samples corresponding to smoke obscuration levels that exceed the alarm level and from signal samples corresponding to smoke obscuration levels that exceed the tolerance limit whether the signal samples are indicative of an alarm condition or an out-of-calibration condition of the detector."
 20. "A method of implementing continual, automatic verification of whether a smoke detector is operating within calibration limits in its measurement of ambient smoke-obscuration levels,

the smoke detector including a signal sampler (24, 28, 202) cooperating with a radiation sensor (28) to produce signal samples indicative of periodic measurements of a smoke obscuration level in a spatial region and processing circuitry (200) operating in response to the signal samples to determine whether they correspond to a smoke obscuration level that exceeds an alarm level, comprising the step of continually acquiring signal samples each of which is indicative of periodic measurement of an actual smoke obscuration level in the spatial region, the method being characterized by the steps of: establishing a reference level based on a fixed standard representing an ambient smoke obscuration level;

establishing upper and lower limits representing smoke obscuration levels respectively greater than and less than the reference level to provide a specified sensitivity range of smoke detector operation;

determining whether the acquired signal samples represent a measured ambient smoke obscuration level that falls within the upper and lower limits to thereby ascertain whether operational conditions have changed such that the measured ambient smoke obscuration level has drifted out of calibration for either under- or over-sensitivity;

and

providing an out-of-calibration signal whenever the measured ambient smoke observation level has drifted out of calibration."

III. In the opposition proceedings, the proprietor of the patent was represented by Mr Martin Körber of Mitscherlich & Partner. The contested decision indicates that the patent has been revoked because the opposition division considered the subject-matter of claim 1 in accordance with the main request not to be new and the subject-matter of claim 1 in accordance with first and second auxiliary requests not to involve an inventive step. The contested decision also gives reasons why the opposition division did not admit into the proceedings the ground of opposition under Article 100(c) EPC, which had been submitted by the opponent in a letter of 15 December 2003, after expiry of the nine month period specified in Article 99(1) EPC.

IV. On 4 June 2005, the EPO received a letter of 3 June 2004 signed by Mr Körber and bearing the heading of Mitscherlich & Partner. The letter has the following content:

"European Patent EP 0 714 541 B1
Interlogix, Inc.
Opposition filed by HOCHIKI Corp.
Our File: P27437EP

In response to the decision of revoking the European Patent in the above matter dated April 5, 2004 an

Appeal

is hereby filed in the name of the Opponent HOCHIKI Corp., Shinagawa-ku, Tokyo, Japan. The appeal fee is paid by enclosed cheque and voucher.

It is requested

(a) to set aside the above mentioned decision and to

maintain the European Patent EP 0 714 541 as granted,
(b) in an auxiliary request, to schedule for Oral
Proceedings.

The written statement setting out the grounds of appeal
will be filed within the given term."

- V. A letter dated 18 June 2004 from the respondent
opponent requested that the appeal against the decision
be rejected and alternatively a hearing be arranged.
That letter did not question the admissibility of the
appeal.
- VI. On 30 August 2004, the board issued a communication
pursuant to Article 108 and Rule 65(2) EPC. The
communication indicated that the notice of appeal of
3 June 2004 contained neither the name, nor the address
of the appellant and requested that this deficiency be
remedied within two months from notification of the
communication. Mr Körber replied to the communication
by a letter received at the EPO on 16 September 2004.
The letter stated that the name of the appellant was
Interlogix, Inc. and gave the address of the appellant.
- VII. The respondent contested the admissibility of the
appeal in a letter of 30 December 2004.
- VIII. Following summons to attend oral proceedings, in which
the board expressed the provisional view that the
appeal was admissible, the proprietor of the patent
submitted, with a letter of 3 March 2006, sets of
claims in accordance with a first, a second and a third
auxiliary request.

The oral proceedings before the board took place on 4 April 2006.

The appellant (proprietor of the patent) requested that the decision under appeal be set aside and that the patent be maintained as granted, or alternatively the patent be maintained on the basis of:

- claims 1 to 26 of the first auxiliary request,
- claims 1 to 26 of the second auxiliary request,
- claims 1 to 25 of the third auxiliary request,

all these three auxiliary requests filed with letter of 3 March 2006.

As a further auxiliary request, the proprietor requested that the case be remitted to the department of the first instance for further prosecution.

The respondent (opponent) requested that the appeal be rejected as inadmissible or, if considered admissible, that it be dismissed, or as auxiliary request that the case be remitted to the department of the first instance for further prosecution.

- IX. The arguments of the proprietor of the patent, as far as they are relevant for the present decision, can be summarised as follows:

The wrong name of the appellant in the notice of appeal was an obvious mistake. Any kind of mistake in the elements recited in Rule 64(a) could be corrected under

Rule 65 EPC; only the elements recited in Rule 64(b) could not be corrected. The grounds of appeal were explicit and complete. Thus, the appeal was admissible.

The discussion of the ground of opposition under Article 100(c) before the opposition division was in relation to its admissibility, not in relation to the substance of the matter. The decision under appeal stated that the ground of opposition under Article 100(c) EPC was late filed and not admissible. The proprietor did not agree with the introduction of this ground of opposition. It was not possible to discuss the meaning of the term "based on a fixed standard" because this would have been tantamount to discussing the substance of the ground under Article 100(c) EPC.

- X. The arguments of the respondent, as far as they are relevant for the present decision, can be summarised as follows:

The letter of 3 June 2004 gave no indication that "Mitscherlich & Partner" intended to file the appeal in the name of the proprietor Interlogix Inc. Hochiki Corporation always appeared in the file as the opponent. A change of representative of the opponent could have taken place. Rule 65 provided the possibility of improving the notice of appeal, but did not go so far as to allow changing a completely wrong name. Decision T 97/98 had held that an appeal was admissible if the name of the person filing the appeal could be derived with a sufficient degree of probability from the information in the notice of appeal, if necessary with the help of other information on file. This was not the

case here. Nothing in the notice of appeal or in the file indicated that the patentee Interlogix Inc. desired to file an appeal, so that the appeal had to be rejected as inadmissible.

The opposition division had considered that the subject-matter of claim 1 as granted lacked novelty in view of the prior art disclosed in document D3 (US-A-4 556 873). The main argument of the opposition division was that the disclosure in D3 of a fixed value of 5%, 10% and 15% and of fixed values for UT, LT was identical to "being based on a fixed standard" as recited in claim 1 as granted. Hence, the reasons given in the decision under appeal had no relationship with the determination of the threshold values, which was the proprietor's main argument in the statement of grounds of appeal. Thus, some core issues of the contested decision were not considered in the grounds of appeal, so that the grounds of appeal did not clearly and concisely enable the board and the other party to understand immediately why the decision was alleged to be incorrect. The respondent had a right to know the grounds of appeal on the core issues of the contested decision. Since the grounds of appeal did not deal sufficiently with the reasons given in the decision under appeal, the appeal was inadmissible.

At first glance, there was no direct and unambiguous disclosure in the application as filed (WO-A-95/05648) of the feature "based on a fixed standard", which was part of claim 1 as granted. The application disclosed fixed values rather than the idea of "standards". Thus, "based on a fixed standard" had definitely a broader meaning than what was disclosed in the application as

filed. Therefore, the principles laid down in G 9/91 and G 10/91 were fulfilled and the opposition division should have admitted the ground of inadmissible extension into the proceedings.

Reasons for the Decision

1. *Admissibility of the appeal*

- 1.1 The admissibility of the present appeal hinges on whether it was apparent that the letter of 3 June 2004 (received at the EPO on 4 June 2004) erroneously referred to the opponent as the appellant instead of the proprietor of the patent. There is no doubt that the letter of 3 June 2003 originates from Mr Körber of Mitscherlich & Partner. The letter purports to file an appeal in the name of an opponent and, at the same time, requests that a revoked patent be maintained as granted. It is therefore immediately apparent that the details given in the letter of 3 June 2004 are inconsistent. It appears from the file of the patent in suit that Mr Körber assumed representation of the patent proprietor with a letter received at the EPO on 2 January 2003. Nothing in the file suggests that on 3 June 2004 Mr Körber would not have represented the proprietor of the patent. Since the contested decision had revoked the patent in suit as requested by the opponent, the opponent was not adversely affected by the decision and, therefore, was not entitled to appeal. In the judgment of the board, this fact, in conjunction with the fact that Mr Körber is the representative of the proprietor, shows with a relatively high degree of confidence that it was the intention of Mr Körber to

file an appeal in the name of the proprietor of the patent. Thus, from the information in the letter of Mr Körber and in the file on 3 June 2004, it was possible to derive with sufficient probability who was the appellant. In line with case T 97/98 (OJ 2002, 183) (point 1.3 of the reasons), the board takes the view that the indication of a wrong name for the appellant in circumstances which allow the true appellant to be determined with sufficient probability constitutes a deficiency that can be corrected under Rule 65(2) EPC. By its letter of 16 September 2004, the appellant has remedied this deficiency and also corrected the address of the appellant.

- 1.2 The contested decision holds that the patent cannot be maintained as granted because the subject-matter of claim 1 as granted is not novel with respect to the prior art disclosed in document D3 (US-A-4 556 873). The statement of grounds of appeal of 12 August 2004 discusses document D3 and also document D1 (JP-Y2-58 28316 and its English translation) and explains why, in the view of the appellant, some specific features of claim 1 as granted are not disclosed in D3 or D1 and why the differences over the prior art involve an inventive step. Thus, the grounds of appeal are sufficient to enable the board and the respondent to understand why the decision is alleged to be incorrect, and on what facts the appellant bases his arguments, without forcing the board and the respondent to make investigations of their own.

- 1.3 Therefore, the appeal is admissible.

2. *Admissibility of the ground of opposition under Article 100(c) EPC*

Opinion G 10/91 (OJ 1993, 420), whose reasons are identical to the reasons given in decision G 9/91 (OJ 1993, 408), sets out a test for determining when to consider grounds not properly covered by the statement pursuant to Rule 55(c) EPC. Fresh grounds of opposition should be admitted in proceedings before the opposition division only "in cases where, *prima facie*, there are clear reasons to believe that such grounds are relevant and would in whole or in part prejudice the maintenance of the European patent" (see point 16 of the reasons in G 10/91). Furthermore, point 2 of the order in G 10/91 states that "Exceptionally, the Opposition Division may in application of Article 114(1) EPC consider other grounds for opposition which, *prima facie*, in whole or in part, would seem to prejudice the maintenance of the European patent." In the view of the board, a fresh ground of opposition does not pass this *prima facie* test when at first glance there can be no doubt that the fresh ground is not relevant or cannot possibly imperil the maintenance of the patent. This is not the case here because the application as filed (WO-A-95/05648) does not contain explicitly the term "based on a fixed standard", which is part of the independent claims 1 and 20 of the patent in suit as granted and of every independent claim of the first, second and third auxiliary requests of the proprietor. It is therefore apparent at first glance that this term could be subject-matter that extends beyond the content of the application as filed, which is a ground of opposition under Article 100(c) EPC. Since the term in question is part of the independent claims of the patent, it is

further apparent at first glance that if it were established that it extended beyond the content of the application as filed, it would seem to prejudice the maintenance of the patent in suit as granted. Even if, as suggested in the contested decision (see the second paragraph of page 8 and the paragraph bridging pages 8 and 9), the term "based on a fixed standard" can be construed as a generalisation of terms used in the application as filed, this, in principle, does not exclude the possibility that this generalisation might extend beyond the content of the application as filed. In the judgment of the board, there are therefore clear reasons to believe that the conditions of the test set out in G 10/91 are fulfilled in this case. It follows that the opposition division should have admitted into the proceedings the ground of opposition under Article 100(c) EPC raised by the opponent after the nine month opposition period.

3. Therefore, the board considers it appropriate to make use of its power under Article 111(1) to remit the case to the opposition division for further prosecution, in particular for admitting the ground of opposition under Article 100(c) EPC and examining it on its merits.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

U. Bultmann

M. Rognoni