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**Datasheet for the decision
of 25 August 2006**

Case Number: T 1123/04 - 3.4.02

Application Number: 01110557.4

Publication Number: 1124148

IPC: G02B 6/32

Language of the proceedings: EN

Title of invention:
Apparatus for altering a light signal

Applicant:
Agilent Technologies, Inc.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 113(1)
EPC R. 68(2)

Keyword:
"Right to be heard (no) "
"Decision reasoned (no) "

Decisions cited:
T 0508/01

Catchword:
-



Case Number: T 1123/04 - 3.4.02

D E C I S I O N
of the Technical Board of Appeal 3.4.02
of 25 August 2006

Appellant: Agilent Technologies, Inc. (a Delaware corporation)
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Decision under appeal: Decision of the Examining Division of the European Patent Office posted 11 May 2004 refusing European application No. 01110557.4 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. Klein
Members: A. Maaswinkel
C. Rennie-Smith

Summary of Facts and Submissions

I. The appellant lodged an appeal, received on 14 June 2004, against the decision of the examining division, dispatched on 11 May 2004, refusing the European patent application 01 110 557.4, which is a divisional application of application 96 301 763.7. The fee for the appeal was paid on 14 June 2004 and the statement setting out the grounds of appeal was received on 9 September 2004. In its decision the examining division objected that the set of claims was not allowable because its subject-matter did not involve an inventive step (Articles 52(1) and 56 EPC). Furthermore objections under Article 84 EPC were raised.

II. In its first communication the examining division had cited the following documents in support of an objection of lack of inventive step against claim 1 as filed:

D1: JP-A-54 146 644 and English abstract;

D2: EP-A-0 640 853.

The wording of this claim 1 reads as follows:

"Apparatus for altering a light signal comprising first, second, third and fourth optical fibres (202-205), each said optical fibre adapted for conducting light to or from said apparatus; first, second, third and fourth optical elements (221-224) corresponding, respectively, to said first, second, third and fourth optical fibres (202-205); first, second, third and fourth lenses (2112-215) corresponding, respectively, to said first, second, third and fourth optical fibres (202-205); and a fifth optical element (225), wherein each said lens

is positioned with respect to said optical fibre corresponding to said lens such that light leaving said optical fibre and striking said lens from a first direction is collimated by said lens and collimated light entering said lens from a second direction is focused into said corresponding optical fibre, wherein said first (202) and third (204) optical fibres are positioned such that light entering said first optical fibre (202) traverses said first (221), third (223), and fifth (225) optical elements and is focused into said third optical fibre (204); wherein said second (205) and fourth (203) optical fibres are positioned such that light entering said second optical fibre (205) traverses said second (222), fourth (224), and fifth (225) optical elements and is focused into said fourth optical fibre (203); wherein said fifth optical element (225) is positioned such that a portion of the light leaving said first optical fibre (202) is reflected from the surface of said fifth optical element (225) into said fourth fibre (203) if said surface of said fifth optical element (225) is reflective, said portion depending on the degree of reflectivity of said surface of said fifth optical element (225), and wherein at least one surface of one of said optical elements includes a coating that alters the direction or composition of light striking said coating."

According to the opinion of the examining division as expressed in the first communication, document D1, considered as the closest prior art, disclosed an apparatus from which the subject-matter of claim 1 differed in that it additionally comprised first to fourth optical elements, corresponding to the first to fourth optical fibres, respectively. The problem to be

- solved was improving the function of the apparatus disclosed in D1. The solution proposed in claim 1 was obvious, since the introduction of additional optical elements for optimising the functioning of the apparatus was described in document D2.
- III. With a letter dated 17 February 2003 an amended claim 1 was submitted which, according to the applicant, had been amended "to clarify the relationships of the various claimed features". In this letter the applicant pointed out that the skilled person would not have considered combining the teachings of documents D1 and D2, and that in any case such a combination would not result in the subject-matter of claim 1. The applicant filed an auxiliary request for oral proceedings.
- IV. In a communication dated 10 February 2004 and annexed to a summons to oral proceedings the examining division raised objections under Article 84 EPC (embodiments in the description not falling under the scope of claim 1) and Article 123(2) EPC (concerning one expression in claim 1) and repeated its view that the subject-matter of claim 1 was obvious in the light of the disclosure of document D1. In reply to the applicant's objection that a combination of documents D1 and D2 would not result in the subject-matter of claim 1, the division explained in point in 3.2 of the communication that document D2 had been cited just as an example that it was common practice in the field of optical communication to associate different optical elements with optical fibres in apparatus for altering a light signal using optical fibres and that the skilled person would not necessarily have had to combine the teachings

of D1 with the particular teachings of D2 but rather would have used his "common sense".

- V. With its letter in reply of 17 March 2004 the applicant filed a new claim 1, which, in addition to the minor textual amendments already included in the previous claim and a further amendment to overcome the objection under Article 123(2) EPC (indicated below in italics), contained the following additional technical features at the end of the claim (underlined):

"...and wherein at least one surface of the said optical elements *is able to support* a coating that alters the direction or composition of light striking said coating; and a platform (200) comprising a top plate (112); a bottom plate (102) having a first set of alignment grooves therein (104), there being one groove corresponding to each optical fibre (202, 205) the alignment grooves being positioned such that the optical fibres will be in the predetermined positions with respect to one another when the optical fibres are forced against the bottom of the grooves by the top plate; and means for fastening the top and bottom plates such that the top plate forces the optical fibres against the grooves in the bottom plate."

In the letter the applicant argued, with reference to page 8 of the description of the application as filed, that the problem addressed by the claim related to alignment of optical fibres and optical elements for different applications. According to the applicant, in the prior art the optical fibres and elements had to be individually aligned after manufacture for each specific application. The solution covered by the

claims was to provide a configurable apparatus in which the optical fibres were pre-aligned with one another during mass production. Therefore the apparatus could be configured for a particular application, by coating the optical elements without the need to realign the optical elements, because the optical fibres were fixed to a platform in an arrangement whereby they could transmit light and receive light in a plurality of different manners and by providing a plurality of optical elements which could then be coated to produce the desired optical effects.

The applicant requested that the examining division expressed its opinion on the patentability of this claim before holding oral proceedings, and that any outstanding issues might preferably be discussed by telephone.

VI. In reply to this letter a short communication was issued on 29 March 2004 in which the examining division informed the applicant that oral proceedings would be conducted as scheduled. The examining division noted that although in its letter of 17 March 2004 the applicant referred to two sets of claims only one set of claims designated as "Main Request" had been filed. As to the patentability of claim 1 the following statement was made:

"Prima facie claim 1 of "Main Request" filed with the letter dated 17 Mar 2004 cannot be allowed for lack of inventive step in view of prior art documents D1 and D2".

VII. In its letter dated 13 April 2004 the applicant announced that it would not attend the scheduled oral proceedings, which therefore could be cancelled, and requested a decision according to the state of the file. In a reply sent by facsimile on 14 April 2004 the examining division informed the applicant that the oral proceedings were not cancelled.

VIII. Oral proceedings were held on 20 April 2004. At the oral proceedings the patent application was refused on the grounds of lack of inventive step according to Article 56 EPC. It was also noted that the requirements of Article 84 were not fully met.

IX. The corresponding decision was issued on 11 May 2004. From the Grounds for the Decision, the objections under Article 56 EPC can be summarised as follows:

"...since claim 1 only comprises additional features that are common knowledge to the skilled person, compared to claim 1 as objected in the communication of 10 February 2004, and as the arguments in the applicant's letter of 17 March 2004 are found to be unconvincing, the application is refused on the grounds mentioned in the communications of 10 February and 29 March 2004 according to which the requirements of Articles 52(1) and 56 are not met because the subject-matter of claims 1 and 2 lacks inventive step" (*point 1 of the Reasons*).

"Compared to claim 1 filed with the letter of 17 February 2003 and dealt with in the communication of 10 February 2004 under points 2.1 - 2.4 features were added that solve a completely different problem

(compare to point 2.2 of this communication), namely the problem of precisely aligning the optical elements chosen for the optical set-up.

As it is common practice for the skilled person to use a platform comprising a top plate and a bottom plate with alignment grooves therein corresponding to optical fibres, and as the skilled person is aware of the fact that the alignment grooves have to be positioned such that the optical fibres will be in predetermined positions with respect to one another when the optical fibres are forced against the bottom of the grooves by the top plate, these features are regarded as trivial juxtaposition to the features identified as difference to the prior art under point 2.1, last paragraph of the communication of 10 February 2004" (*point 2 of the Reasons*).

"The applicant's arguments presented in his letter of 17 March 2004, on page 2, third paragraph, are found to be unconvincing. It is a well-established technique in the field to pre-align fibers or other optical elements in grooves of a platform without the need to realign the elements during mass production or after some other process steps like coating. There is no technical feature in claim 1 which solves that problem differently than well-known pre-alignment techniques. Therefore the claimed solution as identified in paragraph 2 on page 2 of this letter cannot be regarded as involving an inventive step" (*point 4 of the Reasons*).

- X. The appellant filed an appeal against the decision refusing the application. In the statement of grounds of appeal it requested that the decision be set aside

on the basis of the main claim request or on the basis of the auxiliary request filed with the statement of grounds of appeal. The appellant further filed an auxiliary request for oral proceedings.

In the statement of grounds the appellant also made several observations on procedural matters and on the objections under Article 84 and 52(1) and 56 EPC. Insofar as these are relevant to the present decision they may be summarised as follows:

Concerning procedural matters, in its letter of 13 April 2004 the applicant had requested a decision according to the state of the file and indicated that it would not be present at the oral proceedings. Yet the examining division held the oral proceedings and made further deliberations at the oral proceedings, although such further examination should not have been carried out. For instance, a new objection under Article 84 EPC was raised which had not been put to the applicant previously and therefore had not been on the file.

Concerning the objections under Article 52(1) and 56 EPC the appellant, referring to page 8 of the description, presented similar arguments as in its letter of 17 March 2004 (*see Point V supra*). The appellant also pointed out that it was somewhat surprising to learn from the minutes of the oral proceedings that the examining division came to the conclusion that "no patentable subject matter can be found in the application" bearing in mind that two patents had already been granted on the basis of the subject matter in the present application.

XI. In a telephone conversation on 21 June 2006 with the representative of the appellant the rapporteur observed that, while provisionally the board did not concur with the appellant's arguments concerning "Procedural Matters" and "Article 84 EPC", it appeared doubtful whether in the decision the provisions of Article 113 and Rule 68(2) EPC had been respected, since the additional features of claim 1 submitted with the letter of 17 March 2004 had not been addressed in any detail. Therefore the board considered remittal of the case to the first instance for further prosecution, in which case the appeal fee should be reimbursed (Rule 67 EPC). The representative was asked whether under such circumstances the request for oral proceedings was maintained.

XII. With a letter dated 14 July 2006 the appellant requested remittal of the case to the first instance for further prosecution and refund of the appeal fee.

Reasons for the Decision

1. The appeal is admissible.

2. *Article 113(1) EPC*

2.1 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.

- 2.2 In the present case the decision refers to the communications of 10 February and 29 March 2004.
- 2.2.1 In the communication of 10 February 2004, addressing the set of claims of 24 February 2003, the objection under Article 56 EPC, previously based on documents D1 with the additional disclosure in D2, was now based on the disclosure in D1 and the skilled person's "common sense" (*Point IV supra*).
- 2.2.2 The communication of 29 March 2004 refers to the letter of the applicant of 17 March 2004 and to the claims of the "Main Request" submitted with that letter. The only reasoning concerning inventive step is a simple and unsubstantiated reference to documents D1 and D2 (*Point VI supra*).
- 2.2.3 However, with its letter of 17 March 2004 replying to the earlier communication the applicant had filed a new set of claims, in which claim 1 included substantial amendments including a platform for fixing the fibres and, in the same letter, the applicant also presented a detailed explanation in support of its arguments concerning inventive step (*see Point V supra*).
- 2.2.4 It is established jurisprudence of the boards of appeal that the opportunity to present comments and arguments guaranteed by Article 113(1) EPC is a fundamental principle of the examination, opposition and appeal procedures. As pointed out in the decision T 0508/01 of 9 October 2001, point 4, this is not just a right to present comments but also to have those comments duly considered.

2.2.5 The written file does not contain, prior to the issue of the decision of 11 May 2004, any reasoning from the examining division why the objection pertaining to lack of inventive step against the former set of claims would still apply to the new set of claims, nor why the new evidence submitted by the applicant was not persuasive.

2.3 The only information which can be drawn from the file (*Point VI supra*) is that the examining division was at least aware of the existence of the documents filed with the letter of 17 March 2004. That the unsubstantiated statement in the communication of 29 March 2004 cannot form a "Basis of decisions" as required by Article 113(1) EPC needs no further explanation.

2.4 Therefore, the issue of a decision refusing the set of claims filed with the letter of 17 March 2004 without having provided the grounds and evidence to the applicant is in breach of the provisions of Article 113(1) EPC, which amounts to a substantial procedural violation (Rule 67 EPC). For this reason alone, the decision must be quashed.

3. *Rule 68(2) EPC*

3.1 Rule 68(2) EPC stipulates that decisions of the European Patent Office which are open to appeal shall be reasoned. The criteria for the "reasoning" are, for instance, elaborated in the Guidelines, Part E, Chapter X-5.

- 3.1.1 In point 1 of the Reasons for the Decision the examining division simply referred to its previous communications and added that "claim 1 only comprises additional features..." (*see Point IX supra*).
- 3.1.2 Concerning these additional features the examining division asserted in point 2 of the Reasons that "...it is common practice for the skilled person to use a platform..." and "...these features are regarded as trivial juxtaposition".
- 3.1.3 Finally, concerning the arguments of the applicant in the letter of 17 March 2004, the examining division expressed its view that "...it is a well-established technique..." and "...there is no technical feature in claim 1 which solves that problem differently than well-known pre-alignment techniques..." (*point 4 of the Reasons*).
- 3.2 Therefore, at least with respect to the further technical features added to the independent claim (*underlined in Point V supra*) the decision is not reasoned within the meaning of Rule 68(2) EPC and as explained in the Guidelines, since the only arguments put forward by the examining division are mere unsubstantiated assertions without any support (e.g. by citing documents from the European Search Report, further documents known to the examining division or general textbooks documenting the "common sense" or "general knowledge" in this technical field). In this respect the board also takes note that the appellant in the grounds of appeal was surprised to learn that the examining division could not identify any patentable subject-matter although two patents had evolved from

the parent application; at least the subject-matter of granted patent EP-B1-0 732 603 appears to be quite closely related to the additional (*underlined in Point V supra*) features in claim 1. Therefore, without going into the merits of this subject-matter which would not be appropriate for the purpose of the present appeal decision, the applicant (and the second instance) should at least have been presented with a conclusive reasoning based on adequate evidence why the claimed subject-matter, even with the additional features, did not involve an inventive step.

- 3.3 In this respect, reference is made again to the passage the Guidelines referred to in point 3.1 supra: the requirement in Rule 68(2) EPC for a "reasoned decision" is not only motivated by the basic legal principle that a party should be informed of the detailed grounds of a negative decision, but that such reasoning and grounds should be comprehensible to those conducting a later judicial review (Rule 68(2) EPC: "Decisions ..which are open to appeal"). It should not be necessary for a board of appeal to have to reconstruct or even speculate as to the possible reasons for a negative decision in the first instance proceedings. In principle a decision referred to in Rule 68(2) EPC should be complete and self-contained.

4. *Further prosecution*

- 4.1 The decision under appeal is defective in that Article 113(1) and Rule 68(2) EPC have not been respected, amounting to a substantial procedural violation. It is therefore considered appropriate to remit the case to the first instance to resume the

examining procedure. Furthermore, since the appeal is allowable the appeal fee shall be reimbursed (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 shall be reimbursed.

The Registrar:

The Chairman:

M. Kiehl

A. Klein