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**Datasheet for the decision
of 24 May 2007**

Case Number: T 1698/06 - 3.5.03

Application Number: 00310081.5

Publication Number: 1104150

IPC: H04M 1/725

Language of the proceedings: EN

Title of invention:

Cordless telephone with MP3 player capability

Patentee:

LUCENT TECHNOLOGIES INC.

Opponent:

-

Headword:

Procedural violation / LUCENT

Relevant legal provisions:

EPC Art. 97(1), 84, 56, 123(2), 113(1)
EPC R. 29, 68(1) and (2), 67

Keyword:

"Decision reasoned in the sense of Rule 68(1) and (2) EPC
(no)"

"Substantial procedural violation (yes)"

"Reimbursement of appeal fee (yes)"

Decisions cited:

T 0897/03, T 0278/00, T 0425/97, T 0666/90

Catchword:

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Case Number: T 1698/06 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 24 May 2007

Appellant: LUCENT TECHNOLOGIES INC.
600 Mountain Avenue
Murray Hill, New Jersey 07974-0636 (US)

Representative: Williams, David John
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 8 June 2006
refusing European application No. 00310081.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: A. Ritzka
R. Moufang

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division dated 8 June 2006, refusing European patent application No. 00 310 081.5 under Article 97(1) EPC.
- II. The notice of appeal and a payment order for the appeal fee were submitted on 3 August 2006. In the grounds of appeal submitted on 9 October 2006 the appellant requested that the application be remitted to the examining division with the order that a patent be granted based on claims 1 to 12 submitted with the grounds of appeal, which were stated to be identical to claims 1 to 12 submitted on 10 April 2006 in the examination proceedings. A subsidiary request for oral proceedings was made.
- III. In a first communication of 1 April 2004 the examining division raised objections under Article 84 EPC and Rule 29 EPC that the application contained more than one independent claim in a particular category and that the subject-matter of the independent claims lacked an "essential feature". The examining division further took the view that the claims did not involve an inventive step.
- IV. With letter of 11 October 2004 a new set of claims 1 to 25 was filed replacing the set of claims on file. It was argued that these claims complied with the provisions of Rule 29(2)(a) EPC. Arguments regarding inventive step were also presented.
- V. In a second communication dated 21 February 2005 the examining division maintained its objections under

Article 84 EPC, Article 84 EPC in combination with Rule 29(2) EPC and under Article 56 EPC.

- VI. With letter of 18 August 2005 in response to the second communication the applicant filed amended claims 1 to 15 to replace the claims previously on file and presented arguments for inventive step.
- VII. In a communication dated 27 February 2006 accompanying a summons to oral proceedings on 8 May 2006 the examining division took the view that the subject-matter of the claims did not involve an inventive step.
- VIII. With its letter of 10 April 2006 the applicant submitted claims 1 to 12 replacing the claims previously on file and presented arguments for inventive step. The applicant expressed a wish to receive notification, in advance of the date set for oral proceedings, as to whether the examining division intended to maintain the objections.
- IX. A consultation by telephone between a member of the examining division and the applicant was held on 3 May 2006. According to the minutes sent to the applicant with a subsequent communication of 9 May 2006 the applicant was informed that features added to claims 1 and 4 extended beyond the content of the application as filed, contravening Article 123(2) EPC, and would therefore not be considered in the discussion of inventive step. A further comment regarding inventive step was made. Moreover, the applicant's attention was drawn to the possibility of requesting an appealable decision according to the state of the file.

The applicant informed the examiner that it would not attend the hearing on 8 May 2006 and that it would send a notice requesting a decision according to the state of the file.

- X. In a letter dated 3 May 2006 the applicant announced that it would not attend the oral proceedings on 8 May 2006 and requested a decision taking into account the written submissions of 10 April 2006. In an acknowledgement of receipt, prepared by the applicant and submitted with the letter of 3 May 2006, this letter is said to be "in response to summons to attend oral proceedings dated 27 February 2006". The file does not provide information as to whether the letter was submitted before or after the consultation by telephone was held.
- XI. The oral proceedings were held on 8 May 2006 in the absence of the applicant. According to the minutes sent to the applicant with communication of 2 June 2006, after deliberation of the examining division, the chairman announced the decision that the European patent application was refused. Regarding the reasons for the decision the chairman stated that the application did not meet the requirements of Article 123(2) EPC.
- XII. In the decision posted on 8 June 2006 the grounds for the decision read as follows:

"In the communication(s) dated 21.02.2005, 27.02.2006, 03.05.2006 the applicant was informed that the application does not meet the requirements of the

European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 03.05.2006.

The application must therefore be refused."

XIII. In a communication of 22 December 2006 the board raised the question of whether the decision complied with Rule 68(1) and (2) EPC and whether the applicant had had an opportunity to present its comments on the reasons on which the decision was based, Article 113(1) EPC.

XIV. In its letter of 18 April 2007 in response to the board's communication the appellant requested that the "Appeal decision" be set aside and the case remitted to the examining division for further prosecution. The board understands the "Appeal decision" as the appealed decision. The appellant further requested the reimbursement of the appeal fee.

Reasons for the Decision

1. *Procedural violations*

1.1 Rule 68(2) EPC

According to Rule 68(2) EPC, decisions which are open to appeal shall be reasoned. Only if a decision is

adequately reasoned is a party adversely affected by a decision of the department of first instance or a board of appeal able to examine whether the decision was justified. As stated in the decision T 0897/03, pursuant to the established jurisprudence of the boards of appeal a decision of any of the departments of the first instance of the European Patent Office must contain, in logical sequence, those arguments which justify the tenor. Further, a decision which leaves it to the board and the appellant to speculate as to which of the reasons given by the examining division in its communications might be essential to the decision to refuse the application does not comply with Rule 68(2) EPC. In accordance with established case law (see e.g. T 0897/03 and T 0278/00) a violation of Rule 68(2) EPC is considered as a substantial procedural violation.

Although in the present case it is not clear whether the applicant's request for a decision taking into account the written submissions of 10 April 2006 was intended to be a request for an appealable decision "according to the state of the file" as suggested by the examiner in the minutes of the consultation by telephone (see facts and submissions, points IX and X above), the board observes that the EPC makes no provision for special decisions "according to the state of file" and that Rule 68(2) EPC has to be fulfilled by any decision of a department of first instance.

In the present case, the appealed decision fails to state on which claims the decision was based. The minutes of the oral proceedings refer to the applicant's request dated 3 May 2006. In its letter of 3 May 2006 the applicant requested a decision taking

into account the written submissions dated 10 April 2006. Thus, the decision was presumably based on the claims submitted on 10 April 2006.

Two of the communications the decision refers to were issued before the claims on which the appealed decision was based were submitted. It therefore remains wholly unclear to the board whether and to what extent the various objections and arguments contained in these communications form part of the appealed decision.

Thus, the written grounds of the decision lack a clear and unambiguous reasoning, violating Rule 68(2) EPC. The board considers this as a substantial procedural violation.

1.2 Rule 68(1) EPC

According to Rule 68(1) EPC, where oral proceedings are held before the European Patent Office, the decision may be given orally. Subsequently the decision in writing shall be notified to the parties. In accordance with established case law (see e.g. T 0425/97 and T 0666/90) any substantive deviation of the decision as notified in writing from the decision taken at the oral proceedings and given orally amounts to a procedural violation.

According to the minutes of the oral proceedings, the decision was based merely on an objection under Article 123(2) EPC. However, the reasons of the written decision refer inter alia to the communications of 21 February 2005 and 27 February 2006. Both of these communications contain objections, but none under

Article 123(2) EPC. It is thus apparent that the written decision was based not only on Article 123(2) EPC, but also on further objections. Thus, the decision as notified in writing substantively deviates from the decision taken at the oral proceedings. This amounts to a further substantial procedural violation.

1.3 Article 113(1) EPC

Under Article 113(1) EPC a decision may only be based on grounds on which the party concerned has had an opportunity to present its comments. This procedural right is intended to ensure that no party is caught unawares by reasons given in a decision. In the consultation by telephone on 3 May 2006 the applicant was informed that a specific added feature in amended claims 1 and 4 extended beyond the content of the application as filed and contravened Article 123(2) EPC; it would therefore not be considered in the discussion of the inventive step of claims 1 and 4. Claims 1 and 4 were then said not to involve an inventive step. Thus, the board understands that during the telephone conversation the discussion was based on an objection of lack of inventive step to which the objection under Article 123(2) EPC was raised only as a preliminary.

It might therefore have come as a surprise to the appellant that the decision announced at the oral proceedings on 8 May 2006 was based on the ground of non-compliance with Article 123(2) EPC rather than on the objection under Article 56 EPC. This leads to considerable doubts as to whether the applicant had been given sufficient opportunity to present its comments on the reasons on which the decision was based.

However, since the decision has to be set aside already for the reasons set out under points 1.1 and 1.2, there is no need to come to a final conclusion with regard to the issue of a possible violation of Article 113(1) EPC.

2. *Remittal*

The substantial procedural violations set out in points 1.1 and 1.2 above require that the decision be set aside and the case remitted to the department of first instance for further prosecution on the basis of the claims submitted with the grounds of appeal.

3. *Reimbursement of the appeal fee*

The appeal being deemed allowable, it has to be considered as to whether it would be equitable by reason of the substantial procedural violations incurred to reimburse the appeal fee, Rule 67 EPC.

The fact that the appellant, in its grounds of appeal, only addresses the objection of lack of inventive step might indicate that the appellant was not aware of the real grounds of the decision. This was a consequence of the lack of an adequate reasoning.

Neither is it clear to the board on which grounds the appealed decision was based (see point 1.1 above). Thus, the board is not in a position to examine whether the decision was justified or not.

Therefore, the board considers that a reimbursement of the appeal fee is equitable, since the first substantial procedural violation is such that a

substantive examination as to whether the appeal is allowable is not possible.

4. *Oral proceedings*

As the appellant's request that the appealed decision be set aside has been granted, there is no need to hold oral proceedings before the board in accordance with the appellant's subsidiary request.

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 on the basis of claims 1 to 12 as submitted with the statement of grounds of appeal.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland