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**Datasheet for the decision
of 5 May 2010**

Case Number: T 1904/06 - 3.5.02

Application Number: 03716786.3

Publication Number: 1497923

IPC: H03L 7/099

Language of the proceedings: EN

Title of invention:

System with dual rail regulated locked loop

Applicant:

Rambus, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 113(1), 111(1)

EPC R. 103(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Substantial procedural violation - yes"

"Reimbursement of appeal fee - yes"

"Remittal for further prosecution"

Decisions cited:

-

Catchword:

-



Case Number: T 1904/06 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 5 May 2010

Appellant: Rambus, Inc.
4440 El Camino Real
Los Altos, CA 94022 (US)

Representative: Eisenführ, Speiser & Partner
Johannes-Brahms-Platz 1
D-20355 Hamburg (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 20 July 2006
refusing European application No. 03716786.3
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: M. Ruggiu
Members: M. Rognoni
H. Preglau

Summary of Facts and Submissions

I. The appellant (applicant) appealed against the decision of the examining division refusing European patent application No. 03 716 786.3.

II. In the course of the examination, the following documents were cited:

D1: WO-A-01/29680

D2: US-A-2001/033630

D3: US-A-6 125 157.

III. In the contested decision, the examining division came, *inter alia*, to the following conclusions:

- the subject-matter of claim 1 according to the main request filed with a letter dated 24 January 2006 was not new (Article 54 EPC),
- the subject-matter of claim 1 according to the auxiliary requests I and II filed with a letter dated 26 May 2006 was not new (Article 54 EPC),
- the subject-matter of claim 1 according to the auxiliary requests III and IV filed with the letter dated 26 May 2006 lacked an inventive step (Article 56 EPC).

IV. With the notice of appeal dated 1 August 2006, the appellant requested:

1. to put aside the decision under appeal and to grant a patent based on claims 1 to 31,

description and figures according to the main request submitted on 26 May 2006;

2. to reimburse the appeal fee according to Rule 67 EPC (1973);
3. as an auxiliary request, the appellant requested oral proceedings according to Article 116 (1) EPC;
4. as further auxiliary requests, the appellant requested to grant a patent according to the auxiliary requests I to IV submitted on 26 May 2006.

V. With a letter dated 9 September 2009, the appellant clarified the above requests as follows:

- "The auxiliary request based on Art. 116 (1) EPC (request 3 - oral proceedings) shall not apply, in case the Technical Board of Appeal decides to remit the case to the examining division for further examination, i. e. without taking a final decision about the request to grant the patent."

VI. The appellant's main request and auxiliary requests I to IV are identical to the corresponding requests considered in the contested decision, whereby the claims of the main request submitted on 26 May 2006 were actually filed with the letter dated 24 January 2006 and comprise claims 1 to 9.

VII. Claim 1 according to the main request reads as follows:

"An integrated circuit device comprising:

a select circuit (801) to provide a first offset value in a plurality of offset values;

a summing circuit (803) to sum the first offset value with a phase count value (756), the phase count value (756) indicating a phase difference between a reference clock signal and one of a first plurality of clock signals; and

a phase mixer (751) to combine the first plurality of clock signals with the sum of the first offset value and the phase count value (756) to generate an output clock signal."

Claim 1 according to the auxiliary request I differs from claim 1 of the main request in that it further comprises the following feature:

"a storage circuit having a plurality of storage elements to store the plurality of offset values, a first storage element in the plurality of storage elements storing the first offset value to output the first offset value to the summing circuit."

Claim 1 according to the auxiliary request II differs from claim 1 of the main request in that it further comprises the following feature:

"a storage circuit having a plurality of storage registers to store the plurality of offset values, a first storage register in a plurality of storage registers storing the first offset value to output the first offset value to the summing circuit (803)".

Claim 1 according to the auxiliary request III differs from claim 1 of the main request in that it further comprises the following features:

"a storage circuit to store the plurality of offset values, the storage circuit comprising

a plurality of rows of storage elements, each row in the plurality of rows to store a respective one of the plurality of offset values;

a plurality of bit lines, each bit line in the plurality of bit lines coupled to a respective column of the storage element; and

a plurality of enable lines coupled respectively to the plurality of rows of storage elements to output the plurality of offset values on the plurality of bit lines".

Claim 1 according to the auxiliary request IV differs from claim 1 of the main request in that the "select circuit" includes a "multiplexer". Thus, the first feature of the claim reads as follows:

"a select circuit (801) including a multiplexer to provide a first offset value in a plurality of offset values".

VIII. The appellant's arguments relevant to the present decision may be summarized as follows:

The examining division had brought the facts underlying the refusal of the application to the applicant's attention only in the written reasons of the contested decision. Thus, the applicant had no opportunity to

provide his own arguments with regards to the new facts and grounds for the refusal.

In particular, the examining division cited in the contested decision new passages relating to new facts and arguments, to which the applicant had no opportunity to reply.

Furthermore, the examining division raised entirely new objections in its written opinion accompanying the summons to oral proceedings. As these new objections were neither substantiated, nor comprehensive, the applicant was not in a position to prepare for oral proceedings.

As the examining division had failed to inform the applicant of new objections and to invite him to file further observations, it had violated the applicant's right to be heard according to Article 113 (1) EPC.

Reasons for the Decision

1. The appeal is admissible.
2. The essential question to be decided in the present appeal is whether the examination proceedings were in compliance with the applicant's right to be heard guaranteed by Article 113(1) EPC.
 - 3.1 The proceedings before the department of first instance can be summarized as follows:
 - 3.2 With a letter dated 21 December 2004, the appellant filed a new claim 1 relating to an "integrated circuit device" and comprising the following features:

- a select circuit to select one of a plurality of offset values as a selected offset;
- a summing circuit to sum the selected offset with a phase count value, the phase count value indicating a phase difference between a reference clock signal and one of a first plurality of clock signals; and
- a phase mixer to combine the first plurality of clock signals in accordance with the sum of the selected offset and the phase count value to generate an output clock signal.

3.3 In a communication dated 3 August 2005, the examining division stated that the subject-matter of claim 1 was not new over D1. In particular, D1 disclosed on page 11, line 13 to page 16, line 10 and in Figure 11 an integrated circuit comprising all the features of claim 1.

The examining division also pointed out that a novelty objection could also be based on D2 and D3, and that in view of the prior state of the art given by documents D1 to D3, it would appear that the remaining dependent claims did not contain any additional features which could form subject-matter which was new or which involved an inventive step.

In the same communication, the examining division raised some further objections concerning the clarity of the claims and pointed out that claim 1 did not comprise a feature which was "necessary under

Article 83 EPC" because the application did not contain sufficient disclosure of a circuit not having this feature.

3.4 In reply to the examining division's communication, with a letter dated 24 January 2006, the appellant filed, *inter alia*, a new claim 1 relating to an "integrated circuit device comprising":

- a select circuit to provide a first offset value in a plurality of offset values;
- a summing circuit to sum the first offset value with a phase count value, the phase count value indicating a phase difference between a reference clock signal and one of a first plurality of clock signals; and
- a phase mixer to combine the first plurality of clock signals with the sum of the first offset value and the phase count value to generate an output clock signal.

With reference to Figure 32 of the application, the applicant argued essentially that the select circuit 801 was coupled to receive the transmit and receive offset values from the storage circuits 761 and 765, respectively. The select circuit 801 selected one of the phase offset values according to the state of the direction signal 768. This arrangement was not comparable with the embodiment shown in Figure 11 of D1. The latter showed an offset register 126 which was not described to provide a first offset value in a plurality of offset values.

Furthermore, the appellant refuted the clarity objections raised by the examining division.

3.5 In a communication dated 1 March 2006 annexed to the summons to oral proceedings, the examining division stated that the objections of lack of novelty and lack of clarity raised in the communication of 3 August 2005 were fully maintained. Furthermore, in addition to the outstanding objections of the first communication, the examining division wished to discuss the requirements of Article 83 EPC in combination with Article 84 EPC in respect of claim 1, which was not supported over its whole breadth.

3.6 In a letter dated 26 May 2006, the applicant filed four new sets of claims by way of auxiliary requests I to IV and complained that the last communication of the examining division lacked substantial reasoning for the maintenance of the objections and was considered to deprive the applicant of a fair granting procedure. Furthermore, objections referring to a pretended insufficiency of disclosure and lack of clarity had been raised for the first time in the last communication so that the appellant had not yet had an opportunity to counter them. In the same letter the appellant made extensive submissions relating to Article 83 and 84 EPC and on the novelty of the subject-matter of claim 1 over D1.

3.7 With a letter dated 16 June 2006, the applicant requested to cancel the oral proceedings and to continue the examination by providing a second examination report in accordance with Article 96 (2)

EPC 1973, since it was entirely unclear for the applicant for what reasons the objections listed in section 2 of the annex to the summons to oral proceedings were "fully maintained". The objection raised in section 4 of the annex had not been mentioned previously and even in the annex this objection had not been explained.

3.8 On 19 June 2006 the examining division was informed that the applicant had withdrawn his request for oral proceedings.

3.9 With a brief communication dated 23 June 2006, the appellant was informed that the date of the oral proceedings on 27 June 2006 was maintained.

3.10 Oral proceedings were held in the absence of the appellant on 27 June 2006.

3.11 In the decision under appeal, the examining division gave the following reasons for rejecting the applicant's request to cancel the oral proceedings and to continue the examination in accordance with Article 96 (2) EPC 1973:

- the objection raised in the first communication dated 3 August 2005 that the subject-matter of claim 1 was not new with respect to D1 was fully maintained in the summons issued on 1 March 2006, after due consideration of the applicant's response dated 24 January 2006;
- the examining division took the view that there were no substantial amendments to claim 1 and that

the same grounds, facts, evidence and arguments still applied;

- the summons to oral proceedings would provide the applicant with a second opportunity to present comments or amendments;
- the oral proceedings would give the applicant a third opportunity to present arguments or amendments.

Furthermore, the examining division considered for the first time in the contested decision the appellant's auxiliary requests I to IV and concluded that the auxiliary request I and II lacked novelty, whereas the requests III and IV did not involve an inventive step.

- 4.1 Under Article 113 (1) EPC, the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.
- 4.2 From the above, it appears that, before issuing an adverse decision, the examining division had not informed the applicant about its reasons for not granting a patent on the basis of one of the auxiliary requests I to IV.

In the present case, the fact that the applicant chose not to avail himself of the opportunity to take part in oral proceedings before the examining division did not imply that he wished to forfeit his right to be heard given by Article 113(1) EPC, all the more so as the appellant had explicitly requested with the letter

dated 16 June 2006 that the examination be continued in writing.

4.3 By not affording the applicant an opportunity to present comments on the factual reasoning which led to the refusal of the present application, the examining division did not comply with the requirements of Article 113 (1) EPC.

According to the case law of the boards of appeal, the violation of the principle of the right to be heard is considered as a fundamental deficiency of first instance proceedings.

5.1 For the above reasons, the Board decides to set aside the decision under appeal and, in the exercise of its power under Article 111(1) EPC, to remit the case to the department of first instance for further prosecution.

The appellant has agreed that it is not necessary to hold oral proceedings before the Board, if the case is remitted to the examining division.

5.2 As the decision, which gave rise to the present appeal, is marred by a substantial procedural violation, it is equitable to order the reimbursement of the appeal fee pursuant to Rule 103 (1) (a) EPC.

Order

For the above reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

U. Bultmann

M. Ruggiu