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**Datasheet for the decision
of 11 May 2009**

Case Number: T 2321/08 - 3.5.02

Application Number: 06024212.0

Publication Number: 1793502

IPC: H03M 13/11

Language of the proceedings: EN

Title of invention:

Apparatus and method for transmitting/receiving signal in a communication system

Applicant:

Samsung Electronics Co., Ltd., et al

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 78, 94(3), 111(1), 123(1),(2)
EPC R. 42(1)(b), 71(1), 103(1)(a), 137(3)

Relevant legal provisions (EPC 1973):

EPC Art. 96(2)
EPC R. 27(1)(b), 67

Keyword:

"Applicability of Rule 42(1)(b) - (no)"
"Rule 27(1)(b) - incorrect application - (yes)"
"Right to amend - violation (yes)"
"Remittal for further prosecution (yes)"
"Reimbursement of the appeal fee - (yes)"

Decisions cited:

G 0001/03, G 0001/05, J 0010/07, T 0011/82, J 0008/95

Catchword:

1. Rule 27(1)(b) EPC 1973, or equivalent Rule 42(1)(b) EPC 2000, does not put a stringent obligation on the applicant to acknowledge prior art known to him, and to cite documents known to him reflecting this prior art, already at the time of filing the application.

2. No requirement of the EPC prohibits amending an application in order to meet the provisions set out in Rule 27(1)(b) EPC 1973 or Rule 42(1)(b) EPC 2000.



Case Number: T 2321/08 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 11 May 2009

Appellant: Samsung Electronics Co., Ltd., et al
416 Maetan-Dong
Yeongtong-Gu
Suwon-si, Gyeonggi-Do (KR)

Representative: Grünecker, Kinkeldey
Stockmair & Schwanhäusser
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 16 July 2008
refusing European application No. 06024212.0
pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: M. Ruggiu
Members: J.-M. Cannard
P. Mühlens

Summary of Facts and Submissions

- I. The appellant contests the decision of the examining division to refuse European patent application No. 06 024 212.0, which had been filed on 22 November 2006.

- II. With an opinion annexed to the European search report dated 7 May 2007 and with a communication dated 30 January 2008 annexed to summons to attend oral proceedings, the examining division objected that the application did not comply with Rule 27(1)(b) EPC 1973, respectively Rule 42(1)(b) EPC 2000, because no prior art document relating to punctured LDPC codes was cited in the application as originally filed, although the applicant was aware of such prior art as appeared from documents D1 to D7 cited in the search report. With a letter dated 19 May 2008, the applicant filed amended pages 1, 2, 2a, 4 and 10 of the description citing documents D1 to D7 to overcome this objection. In the course of the oral proceedings held on 16 June 2008, in which the objection under Rule 42(1)(b) EPC 2000 was discussed, the applicant was informed, for the first time, that it was not possible to remedy this objection, and the application was refused.

- III. The reason for the refusal was that the application as originally filed did not acknowledge the relevant prior art on punctured LDPC of which the applicant was aware, and thus was contrary to Rule 42(1)(b) EPC 2000. Furthermore, the German version of Rule 42(1)(b) EPC 2000 showed "that the applicant *should* cite relevant prior art documents in the application as originally filed if this is possible". The acknowledgement of the

cited prior art added in the description, which had been filed with the letter of 19 May 2008, was not sufficient to overcome the objection under Rule 42(1)(b) EPC 2000 because "relevant prior art known to the applicant at the filing date must be acknowledged in the application as originally filed", and not after the European search report had been issued (see Reasons for the decision, point 1).

- IV. In the notice of appeal dated 26 September 2008, the appellant requested that the decision under appeal be set aside, that the case be remitted to the first instance for further prosecution, that the appeal fee be reimbursed and subsidiarily that oral proceedings before the Board be scheduled. A new set of claims 1 to 30 was filed with a letter dated 21 November 2008 stating the grounds of appeal.
- V. The arguments of the appellant submitted with the statement of grounds of appeal can be summarized as follows, whereby the appellant stated that it adhered to the numeration of Articles and Rules according to EPC 2000.

Since a filing date had been assigned to the application, it was clear that the requirements laid down in Article 78 EPC and in the corresponding Implementing Regulations, which included Rule 42 EPC, were fulfilled. It was generally accepted, in particular in view of Rule 42(1)(b) EPC, that the applicant could not be expected to know all the prior art documents on the date of filing of an application, and that the description could be corrected to remove any wrong citations or to add citations of prior art.

According to Article 94(3) EPC, the examining division should invite the applicant, as often as necessary, to file his observations and, subject to Article 123(1) EPC, to amend the application if the examination revealed that the application did not meet the requirements of the EPC. According to Article 97(2) EPC, the application should then be refused only if it still did not meet the requirements of the EPC.

Rule 42 EPC was directed to regulations that were to the disposition of the parties and any defects of the description in compliance with said rule were remediable. Of course, the examining division should invite the applicant to provide remedies to overcome the objections raised.

Rule 42(1)(b) EPC only stated that the description should indicate the background art which, as far as it was known to the applicant, could be regarded as useful to understand the invention, to draw up the European search report and to examine the application. In the present case, the invention had been understood by the examining division, and the background art mentioned in the description had helped in drawing up the search report, as was apparent from the number of relevant documents cited. The objections raised in view of clarity, novelty and inventiveness showed that it was possible to examine the application. Moreover, Rule 42(1)(b) EPC referred to the applicant, but not to the inventor.

This was confirmed by decisions of the Boards of Appeal or the Enlarged Board of Appeal, in particular G 1/03 or

G2/03 which required that the description be amended to indicate prior art on which a disclaimer was based.

The request to set aside the appealed decision was thus justified. As the decision was based on a substantial procedural violation, the request to reimburse the appeal fee was equitable.

Reasons for the Decision

1. The appeal is admissible.
2. Essentially, the decision under appeal considers that Rule 42(1)(b) EPC 2000 puts an obligation on the applicant to acknowledge prior art known to him already when filing the application as filed, and that failure to do so cannot be cured by amending the application after the European search report is issued.

Applicability of Rule 27(1)(b) EPC 1973

3. Rule 27(1)(b) EPC 1973, and not Rule 42(1)(b) EPC 2000, should be considered in the present case which relates to an application filed before the entry into force of the EPC 2000.
 - 3.1 According to Article 2 of the Decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the EPC 2000: "The Implementing Regulations to the EPC 2000 shall apply to all European patent applications, ..., in so far as the foregoing are subject to the provisions of the EPC 2000". Rule 42(1)(b) EPC 2000 more precisely specifies the

content of the description of an European patent application referred to in Article 78 EPC 2000 and therefore applies to the present application in so far as it is subject to the provisions of Article 78 EPC 2000.

- 3.2 Article 1 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 does not mention Article 78 EPC 2000 as an article which applies to the European patent applications pending at the time of its entry into force. Therefore, according to Article 7 of the Act revising the EPC of 29 November 2000, new Rule 42(1)(b) EPC 2000 is not applicable to the present application which was filed before 13 December 2007.
4. In any case, the new Rule 42(1)(b) EPC 2000 and the old Rule 27(1)(b) EPC 1973 taken in each of the three languages texts of the EPC only differ from each other in some minor respects of their wording and the Board cannot see any difference of substance between the new and old versions in each of the three official languages. It should thus be examined whether the reasons given in the appealed decision for refusing the application under Rule 42(1)(b) EPC 2000 could justify a refusal of the application under the equivalent Rule 27(1)(b) EPC 1973.

Obligation under Rule 27(1)(b) EPC 1973 to cite prior art known to the applicant in the application as originally filed

5. As regards the question of whether Rule 27(1)(b) EPC 1973 requires that prior art known to the applicant be

acknowledged in the application already at the time of filing it, the Board is of the following opinion.

6. The first part of Rule 27(1)(b) EPC 1973 (in the three languages) states that the application shall "indicate the background art which, as far as known to the applicant, **can be regarded as useful** for understanding the invention, for drawing up the European search report and for the examination" (emphasis added by the Board). Rule 27(1)(b) EPC 1973 does not specify which background art should objectively "be regarded as useful ... for drawing up the European search report ". Thus, the wording of the first part of Rule 27(1)(b) EPC 1973 appears to give the applicant some discretion in indicating in the description the background art known to him when filing an application. This latitude is consistent with the second part of the English and French versions of the rule according to which the description shall **preferably** cite the documents reflecting such art.

6.1 The provisions of Rule 27(1) EPC 1973 apply to the content of the description in general and not only to the content of the description as originally filed. This is clear from Rule 36(1) EPC 1973, from Rule 27(1)(c) EPC 1973 according to which the description shall disclose the invention as claimed, or from the fact that the EPC explicitly refers to the content of the application as originally filed when its original content is concerned, as for instance in Article 123(2). Moreover, decision G 1/03 (OJ 2004, 413, point 3 of the reasons) of the Enlarged Board of Appeal requires that the description be amended to indicate the prior art on which a disclaimer is based. Furthermore, Rule 27(1)(b)

EPC 1973 does not contain the term "relevant prior art" quoted in the appealed decision and it cannot retrospectively be established to which extent such art or documents correspond to those reflecting the subjective background art which "can be regarded as useful for understanding the invention, for drawing up the European search report and for examination" by the applicant at the time of filing.

6.2 Thus, the first part of Rule 27(1)(b) EPC 1973 does not appear to put a stringent obligation on the applicant to acknowledge prior art known to him already at the time of filing the application.

7. According to the decision under appeal, the German version of Rule 42(1)(b) EPC 2000, which states "es sollen auch die Fundstellen angegeben werden, aus denen sich dieser Stand der Technik ergibt", showed that "the applicant *should* cite relevant prior art documents in the application as originally filed if this is possible". The application was refused because the examining division considered that this requirement was not met. The above statement is also contained in the German version of Rule 27(1)(b) EPC 1973.

7.1 The passages of the English and French texts of Rule 27(1)(b) EPC 1973 corresponding to the passage of the German version quoted in the decision respectively read "and, preferably, cite the documents reflecting such art" and "les documents servant à refléter l'état de la technique antérieure doivent être cités de préférence". It is thus clear from the English and French versions that citing documents reflecting the background art or the prior art (which terms have the

same meaning, see T 11/82, OJ OEB 1983, 479) is not to be understood as mandatory, but as a simple recommendation. This is consistent with the use of the verb "sollen" in the German version of the rule which does not express a stringent obligation. Moreover, the German version of the second part of Rule 27(1)(b) EPC 1973 ("es sollen auch die Fundstellen angegeben werden, aus denen sich dieser Stand der Technik ergibt") cannot be interpreted as giving the applicant less discretion when citing documents reflecting background art known to him than when indicating such art.

7.2 According to J8/95 (not published; points 5.1 and 5.2 of the reasons), even if one language version were found to differ from, and be more restrictive than, the other two versions, no legal consequences could be derived from a provision of that version (here the German one) other than those which could be derived from the other two versions. A difference in the wording of the first version has to be considered only in so far as it could form an element of the interpretation. Following J 8/95, the Board concludes that, according to Rule 27(1)(b) EPC 1973 (and for the same reasons according to Rule 42(1)(b) EPC 2000), the description shall **preferably** cite documents reflecting the background art known to the applicant at the time of filing.

7.3 Thus, the Board comes to the conclusion that the second part of Rule 27(1)(b) EPC 1973 does not put a stringent obligation on the applicant to cite documents reflecting prior art known to him already at the time of filing the application.

*Amending the application to meet the provisions set out in
Rule 27(1)(b) EPC 1973*

8. As regards the question of whether failure to acknowledge prior art known to the applicant already at the time of filing the application can be cured by amending the application after the European search report is issued, the Board is of the following opinion.

8.1 As Rule 27(1)(b) 1973 EPC recommends citing the prior art useful for understanding the invention in the application, and not only in the application as originally filed, this rule cannot be construed as prohibiting any further acknowledgement of relevant prior art at a later stage of the examination.

8.2 During examination of a patent application, the right to present comments and to amend the application is governed by Article 94(3) EPC 2000 which is applicable in the present case. According to this article, if the examination reveals that an application "does not meet the requirements of this Convention, the Examining Division shall invite the applicant, as often as necessary, to file his observations and, subject to Article 123, paragraph 1, to amend the application". Rule 71(1) EPC 2000 which refers to Article 94(3) EPC 2000 states that "the Examining Division shall, where appropriate, invite the applicant to correct any deficiencies noted and to amend the description, claims and drawings". Moreover, according to Article 123(1) EPC 2000: "In any event, the applicant shall be given at least one opportunity to amend the application of his own volition".

8.3 Further, it is generally accepted in the case law of the Boards of Appeal, that failure to meet requirements of the EPC at the time of filing the application can be cured by amendments at the examination stage (within the limits set out in Article 123 EPC). In particular, decision G 1/05 of 28 June 2007 (OJ 2008, 271) states the following (whereby Article 96(2) EPC 1973 corresponds in substance to Article 94(3) EPC 2000): "For all applications it is an important principle under the EPC that the question whether or not an application complies with the substantive requirements of the EPC is to be decided on the text finally submitted or agreed by the applicant after any objections have been drawn to his attention and he has been afforded an opportunity to comment and also an opportunity to overcome the objection by means of an amendment" (point 3.2. of the reasons), and "Not complying with a provision cannot raise an automatic presumption that the application is to be refused without any prior possibility of amendment being afforded to the applicant. Rather, the general principle enshrined in Article 96(2) in conjunction with Article 123(1) EPC allowing amendments applies" (point 3.4 of the reasons).

8.4 The Board is not aware of any requirement of the EPC that would prohibit amending the application in order to meet the provisions set out in Rule 27(1)(b) EPC 1973. Thus, in the view of the Board, the foregoing provisions of the EPC give the applicant the right to amend the description, claims and drawings in order to correct deficiencies and, in the present case, the applicant should have been given at the examination stage at least one opportunity to acknowledge relevant prior art

documents in the description following the objection raised by the examining division.

9. Therefore, the Board judges that the examining division had no right to refuse the incorporation in the description of the acknowledgments of the cited prior art filed with the letter dated 19 May 2008 on the reason that these acknowledgements were "not sufficient to overcome the objection, as these acknowledgments have been made after the European search report".

Remittal to the department of first instance

10. Since examination of the questions of novelty and inventive step by the department of first instance does not seem to be completed, and since fresh claims have been filed with the letter of 21 November 2008, the Board finds it appropriate to remit the case to the department of first instance for further prosecution (Article 111(1) EPC).

Substantial procedural violation - Reimbursement of the appeal fee

11. Although the objection under Rule 27(1)(b) EPC 1973 was raised for the first time in the opinion sent with the extended European search report, the amended pages of the description containing the acknowledgements of the cited prior art were first filed with the reply to the communication annexed to the summons to oral proceedings. However, the opinion simply concludes the objection under Rule 27(1)(b) EPC by stating: "This intentional non-compliance with Rule 27(1)(b) EPC may well have consequences during the examination procedure". The

Board does not consider this statement as a clear invitation to amend the description. Therefore, refusing the amendments to the description filed by the applicant could not be justified by refusing the consent of the examining division to further amendments under Rule 137(3) EPC 2000, nor because they were considered as late-filed according to Rule 116(1) EPC 2000. By not allowing the applicant to amend the description in order to correct the deficiencies noted the examining division violated the procedure foreseen in Article 94(3) and Rule 71(1) EPC 2000. This procedural violation was substantial because its immediate consequence was the refusal of the application. Therefore, the Board finds that reimbursement of the appeal fee is equitable in the sense of Rule 67 EPC 1973 which is applicable to the present case (J 10/07, OJ 2008, 567, point 7 of the reasons) or the substantially identical Rule 103(1)(a) EPC 2000.

12. Thus, the Board deems the appeal allowable and does not see any reason in the present case to depart from the long-standing practice of the EPO. Although the decision under appeal mentions that the applicant filed new pages of the description with letter of 19 May 2008, it states that the "examination is being carried out on the following applications documents: Description, Pages 1-10 **as originally filed** ..." (emphasis added). For the avoidance of doubt, the Board wishes to state clearly that, in its present form, the description of the application is to be regarded as being amended in the way specified in the letter of 19 May 2008.

13. As the present decision is in line with what is requested by the appellant, there is no need to hold oral proceedings.

Order

For these 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