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**Datasheet for the decision
of 13 July 2010**

Case Number: T 2193/09 - 3.5.04

Application Number: 97113311.1

Publication Number: 0822554

IPC: G11B 20/10

Language of the proceedings: EN

Title of invention:

Method and apparatus for adaptively processing the readback signal in a read channel device for digital storage

Applicant:

NEC Electronics Corporation

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 108

Relevant legal provisions (EPC 1973):

-

Keyword:

"Form of appeal - grounds - substantiation (no)"

Decisions cited:

-

Catchword:

See point 1.5.2



Case Number: T 2193/09 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 13 July 2010

Appellant: NEC Electronics Corporation
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Kanagawa 211-8668 (JP)

Representative: Glawe, Delfs, Moll
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 7 April 2009
refusing European application No. 97113311.1
pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: F. Edlinger
Members: C. Kunzelmann
C. Vallet

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 97 113 311.1.
- II. In the proceedings before the examining division, the applicant had several times filed amended claims in reply to communications from the examining division. Following the filing of new claims with a letter dated 20 December 2005, the examining division, in a communication dated 22 September 2006, set out new objections under both Article 84 EPC 1973 and Article 56 EPC 1973.
- III. In reply, the applicant filed a new set of claims with a letter dated 2 April 2007 and requested that examination should proceed on the basis of the new claims on file.
- IV. In a communication accompanying the summons to oral proceedings the examining division informed the applicant that the claims were not acceptable under Rule 137(3) EPC.
- V. In a letter dated 13 January 2009 the applicant withdrew the request for oral proceedings but did not change the request to proceed on the basis of the claims filed with the letter dated 2 April 2007.
- VI. In the decision under appeal the examining division set out that the set of claims filed with the letter dated 2 April 2007 was not admissible under Rule 137(3) EPC because the independent claims no longer defined "a 7

pole, 2 zero, equiripple filter", a feature which had been present in the claims filed with the letter dated 20 December 2005. The application was thus refused since under Article 113(2) EPC a decision could be taken only on the set of claims as submitted by the applicant. The examining division made an additional observation which was "not part of this decision", stating that "if the present claims would be amended so as to be admissible under R. 137(3) EPC, then they would proba[b]ly be obvious, contrary to Art. 52(1) and 56 EPC".

VII. The applicant appealed and requested that the decision under appeal be set aside and a patent be granted. With the statement of grounds of appeal the appellant filed claims 1 to 5 according to a main request and claims 1 to 3 according to an auxiliary request. In the statement of grounds of appeal the appellant submitted arguments why, in his view, the subject-matter of the claims according to the main request was new and involved an inventive step. The appellant also submitted that the claims according to the main request corresponded to the claims as filed with the letter dated 2 April 2007 with an additional feature at the end of the claims and that independent claims 1 and 2 according to the auxiliary request corresponded to claims 1 and 3 filed with the letter dated 20 December 2005, with the same additional feature as the claims of the main request. These claims also specified the amendment that had been required by the examining division during prosecution of the application.

VIII. The board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to a summons to oral proceedings dated 19 April 2010. In this communication it expressed doubts as to the admissibility of the appeal under Article 108 EPC because the statement of grounds of appeal did not give reasons why the decision was alleged to be incorrect. The board indicated that it intended to limit the oral proceedings to the issues of admissibility of the appeal and admissibility of the claims in the appeal proceedings.

IX. In a letter dated 14 June 2010 the appellant submitted arguments why the appeal should be considered admissible.

X. Oral proceedings were held on 13 July 2010. The appellant did not file any new requests. At the end of the oral proceedings the chairman announced the board's decision.

Reasons for the Decision

1. *Admissibility of the appeal (Article 108 EPC and Rule 101(1) EPC)*

1.1 Pursuant to Article 108, third sentence, EPC, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations within four months of notification of the decision. An appeal which does not comply with this requirement shall be rejected as inadmissible (see Rule 101(1) EPC).

1.2 According to established case law the statement setting out the grounds of appeal should specify the legal or factual reasons on which the case for setting aside the decision is based. The arguments must be clearly and concisely presented to enable the board to understand immediately why the decision is alleged to be incorrect, and on what facts the appellant bases his arguments, without first having to make investigations of its own (see Case Law of the Boards of Appeal, 5th edition 2006, VII.D.7.5.1).

1.3 In the present case, the applicant had requested the grant of a patent on the basis of a set of claims to which the examining division did not give its consent under Rule 137(3) EPC. The application was refused on the ground that the examining division, pursuant to Article 113(2) EPC 1973, was bound to decide on a text submitted to it. Thus the decision under appeal was based on the ground that there was no admitted set of claims. Implicitly this meant that a patent could not be granted (Article 97(1) EPC in conjunction with Article 78(1)(c) EPC 1973), and had to result in the refusal of the application (Article 97(2) EPC).

1.3.1 In this context the relevant legal question is whether the statement of grounds of appeal sets out why, according to the appellant, the examining division was not correct in basing its decision on the ground that there was no set of claims admitted under Rule 137(3) EPC.

1.3.2 The text of Rule 137(3) EPC which is applicable to the present case reads as follows:

"After receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend **once** the description, claims and drawings, provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the Examining Division" (emphasis by the board).

- 1.4 The statement of grounds of appeal in the present case does not give any reasons why the decision is alleged to be incorrect. The lack of claims underlying the decision under appeal is not discussed in the statement of grounds of appeal. The appellant does not contest that there was no admitted set of claims and that the examining division was entitled to refuse the application as a consequence. Nor does the appellant contest that the examining division was entitled to exercise its discretion under Rule 137(3) EPC or that it had exercised this discretion in accordance with the right principles. Instead the statement of grounds of appeal gives arguments as to why the subject-matter of the (amended) main request filed with the statement of grounds of appeal is both new and inventive in view of the references cited in the decision under appeal and states that the appellant's arguments as to novelty and inventive step "have not been duly considered by the contested decision". Regarding the auxiliary request, the appellant merely submitted that these claims specified the amendment that had been required by the examining division, but did not provide arguments as to why the re-filing of the claims (with an additional feature) overcame the objection of a lack of claims admitted under Rule 137(3) EPC, or why the claims should be admissible on appeal. Thus the submissions in

the statement of grounds of appeal do not set out the relevant reasons why the decision of the examining division not to give its consent to the amendments under Rule 137(3) EPC and to refuse the application for lack of admissible claims is alleged to be incorrect or not to have been taken in accordance with the right principles.

1.5 It is established case law that, in exceptional circumstances, claims filed with the statement of grounds of appeal may suffice for the appeal to be admissible even if the statement of grounds of appeal does not explicitly set out why the decision under appeal is alleged to be incorrect. This may, for instance, be the case if from the decision under appeal and the statement of grounds of appeal it is clear that the claims of an auxiliary request filed with the statement of grounds of appeal overcome all the objections raised in the decision under appeal (see Case Law of the Boards of Appeal, 5th edition 2006, VII.D.7.5.2(d)).

1.5.1 In the present case, however, there are no such exceptional circumstances as far as the main request is concerned. The wording of the amended claims according to the main request filed with the statement of grounds of appeal does not enable the board to immediately understand why the examining division should have exercised its discretion under Rule 137(3) EPC in a different manner. In particular, the additional feature is not concerned with re-introducing a feature ("a 7 pole, 2 zero, equiripple filter") the removal of which had led the examining division to refuse its consent.

1.5.2 The statement of grounds of appeal, in conjunction with the wording of the amended claims according to the auxiliary request filed with the statement of grounds of appeal, makes clear that the claims of the auxiliary request are an attempt to re-introduce the feature the removal of which had been indicated in the decision under appeal as a reason for not giving consent to the amendment. However, the appellant did not set out legal or factual reasons why the filing of these claims with the statement of grounds of appeal removed the deficiency of a lack of a set of admitted claims. Also, the board fails to see how the mere filing of these claims in separate appeal proceedings addressed the issue of the examining division's not having given consent to different claims in examination proceedings. Furthermore, the appellant did not set out reasons why the examining division should have rectified its decision (Article 109(1) EPC 1973) or why the board should set it aside. Moreover, the appellant did not argue, and there is no indication in the file, that the claims of the auxiliary request overcome objections under Article 84 EPC 1973 which had been raised by the examining division (see point II above).

2. The admissibility of the appeal is a prerequisite for the examination and decision as to the allowability of the appeal (see Articles 110 EPC and 111 EPC 1973). If the board finds that that the appeal is inadmissible, examination and decision as to its allowability are not possible. Hence, in section 1 of this decision concerning the admissibility of the appeal, the board has considered the appellant's arguments submitted after the time limit for filing the statement of grounds of appeal (see Article 108 EPC) only to the

extent that they may be relevant for the assessment of whether the statement of grounds of appeal suffices to render the present appeal admissible. In the present case this means that the board has examined whether the arguments presented in the letter dated 14 June 2010 and in the oral proceedings have an impact on the board's understanding of the statement of grounds of appeal or the decision under appeal.

- 2.1 In the letter dated 14 June 2010 the appellant submitted the argument that, at least implicitly, the reason for not admitting the set of claims submitted to the examining division was lack of novelty or lack of inventive step of the subject-matter claimed; but the appellant did not indicate any particular statement in the decision under appeal supporting that argument. The decision under appeal, however, discusses inventive step only in a hypothetical context of non-admitted claims in a paragraph headed "The following is not part of this decision".

- 2.2 The appellant's argument in the letter dated 14 June 2010 that, under Article 125 EPC, it should be sufficient to explain the facts of the case since the board could be assumed to know the legal framework is not convincing, as the facts of the present case which led to the refusal of the application were not the facts given in the statement of grounds of appeal (see in particular points 1.3 and 1.4 above).

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

L. Fernández Gómez

F. Edlinger