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**Datasheet for the decision
of 23 January 2012**

Case Number: T 0317/11 - 3.5.03

Application Number: 05711096.7

Publication Number: 1738572

IPC: H04M 11/02

Language of the proceedings: EN

Title of invention:

Method and device for access communication/control

Applicant:

Trell, Anders Edvard

Headword:

-

Relevant legal provisions:

EPC Art. 109(1), 109(2), 111(1)

EPC R. 103(1)

Keyword:

"Substantial procedural violation - no"

"Remittal for further prosecution"

Decisions cited:

T 0139/87, T 2140/09



Case Number: T 0317/11 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 23 January 2012

Appellant: Trell, Anders Edvard
(Applicant) Högalidsgatan 27
SE-117 30 Stockholm (SE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 13 April 2010
refusing European patent application
No. 05711096.7 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: B. Noll
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse European patent application No. 05711096.7 originally filed as international application No. PCT/SE2005/000236 and published as No. WO 2005/104516 A2. The application was refused on the grounds that the subject-matter of claim 1 lacked an inventive step (Article 56 EPC) and that claims 2 and 12 comprised subject-matter which extended beyond the content of the application as filed (Article 123(2) EPC).
- II. Together with the statement of grounds as filed on 6 August 2010 a set of amended claims was filed.

The board understands from the penultimate sentence of the statement of grounds, which reads "I herewith submit above amendment, cancel all old claims, propose new claims etc entirely without prejudice and/or disclaimer, aiming at and respectfully requesting getting an interlocutory revision admitting the herewith presented new claims 1-15, grant of patent for this my new, original and valuable invention and my fee money back", that the appellant is requesting on the one hand that the impugned decision be set aside and a patent be granted on the basis of the claims as filed together with the statement of grounds of appeal, and on the other hand that the appeal fee be reimbursed.

Claim 1 as filed with the statement of grounds reads as follows:

"Method for control of access using an access device, which access device with regular telephone number or address and means can be connected to a regular telephone or data network which regularly provides the Caller-ID service and which access device includes receiving means contrived to enact said access device on receipt of a herefore intended code, comprising the following steps:

a visitor who wants to have access effectuated, to that end establishes a direct communication via his/her individually held suited communication means at hand, call via the regular telephone or data network, with an authorized party, characterized in that said authorized party is a machine called B-replier able to deliver said intended code;

and that said B-replier approves said visitor and presents in such case, in making a regular call, fixed or mobile, to said and connected access device, by means of an attached caller-ID device, said intended code, being originally a regular telephone number or address of said B-replier, to said receiving means so that said access device is enacted to effectuate said access."

III. On 31 January 2011 the examining division instructed the formalities officer that it would not rectify the decision under appeal and that the case should be referred to the board of appeal.

- IV. The board issued a communication on 13 July 2011 in which the board took the preliminary view that the case should be remitted to the examining division for further examination. The appellant was invited to file comments, if any, within two months.
- V. No reply was received within the given time period.

Reasons for the decision

1. *Remittal*

- 1.1 The decision to refuse was preceded by a communication of the examining division issued on 6 May 2009 in which inter alia objections of added subject-matter (Article 123(2) EPC, cf. the fourth paragraph at point 2 of the communication) against claim 2 and of lack of inventive step (Article 56 EPC, cf. point 3.1 of the communication) against claim 1 were raised. In the last paragraph at point 3.1 of this communication the examining division further argued that "The expression, line 13 [of claim 1], "man or machine" discloses two alternatives. The lack of inventive step described above concerns the alternative where the B-replier is a man. But the lack of inventive step of one of both alternatives results in lack of inventive step of the claim 1."

In the same communication the examining division proposed an amended claim 1 which in its view would overcome the objections on file (point 5 of the communication). From this proposal it is clear that the examining division considered the claimed method as

involving an inventive step if the authorized party was "a machine called B-replier" whereas it considered the method as lacking an inventive step if the method encompassed the possibility that the authorized party was a "man called B-replier".

1.2 A new set of claims was filed on 8 August 2009. The examining division then refused the application, taking the view that the objections raised in the communication were not met by the amended claims.

1.3 Claim 1 as filed together with the statement of grounds corresponds to the claim which the examining division stated in its communication of 6 May 2009 would overcome the objections it had raised. In the reasons of the impugned decision, see point 5, the examining division explicitly described the proposed claim as "patentable subject-matter".

Furthermore, claims 2 and 12, said by the examining division to contain added subject-matter, have been deleted from the present set of claims.

Hence, the objections which led to refusal of the application have been overcome by amendment. Consequently, the appeal is well founded.

1.4 According to the established case law of the boards of appeal (see e.g. T 139/87, OJ 1990, 68; T 2140/09, not published) the case ought therefore to have been rectified by the department of first instance pursuant to Article 109(1) EPC. The examining division did not however grant interlocutory revision, the reason for the apparent change of mind of the examining division

remaining unclear to the board. Under these circumstances the board considers that the case should be remitted to the examining division for further prosecution in accordance with Article 111(1) EPC.

2. *The request for reimbursement of the appeal fee*
- 2.1 Pursuant to Rule 103(1)(a) EPC the appeal fee shall be reimbursed in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.
- 2.2 The board infers from the statement of grounds of appeal (cf. the first and the second paragraphs) that by refusing the application at this stage of the procedure the appellant (applicant) was taken by surprise so that the refusal constituted a substantial procedural violation.
- 2.3 The grounds for refusal as given in the reasons of the impugned decision substantially correspond to the objections as discussed above (cf. points 1 and 2 of the reasons of the impugned decision).
- 2.4 It follows that the decision to refuse the application was based solely on grounds communicated to the applicant in the examining division's communication and on which the applicant had an opportunity to comment (Article 113(1) EPC). Whether or not in the present case a further communication should have been issued by the examining division instead of an immediate refusal was a matter for the discretion of the examining

division. Accordingly, the grounds for refusal do not give rise to a procedural violation.

2.5 Furthermore no sanction is provided in the EPC in the event of failure to forward the case to the board of appeal within the three month time limit as required by Article 109(2) EPC; therefore the fact that the examining division had delayed the remittal of the appeal to the board of appeal by more than five months from receipt of the statement of grounds in contravention of Article 109(2) EPC entails no legal consequence.

2.6 Even if this delay may be considered a procedural violation there is no causal link between the reasons of the impugned decision and this deficiency. Accordingly this procedural violation is not "substantial" in the sense of Rule 103(2) EPC.

2.7 It follows from all these reasons above, that the board sees no substantial procedural violation in view of which reimbursement would be equitable.

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 request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

G. Rauh

A. S. Clelland