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**Datasheet for the decision
of 16 July 2014**

Case Number: T 1929/13 - 3.5.07
Application Number: 06702666.6
Publication Number: 1847997
IPC: G11B27/00, G11B20/10,
G11B20/12, H04N5/91
Language of the proceedings: EN

Title of invention:

Information recording/reproduction device and information recording medium

Applicant:

Sharp Kabushiki Kaisha
Pioneer Corporation
JVC KENWOOD Corporation
Hitachi, Ltd.
Sanyo Electric Co., Ltd.

Headword:

Information recording and reproduction/SHARP

Relevant legal provisions:

EPC R. 137(3)
EPC Art. 84, 123(2)
RPBA Art. 12(4)

Keyword:

Amendments -
discretion of examining division (incorrectly exercised)
Added subject-matter (no) (after amendment)

Decisions cited:

G 0007/93, J 0007/82, T 0271/85, T 0598/88, T 0946/96,
T 0573/12

Catchword:



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Case Number: T 1929/13 - 3.5.07

**D E C I S I O N
of Technical Board of Appeal 3.5.07
of 16 July 2014**

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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 8 March 2013**

refusing European patent application No.
06702666.6 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman R. Moufang
Members: P. San-Bento Furtado
R. de Man

Summary of Facts and Submissions

I. The appeal lies from the decision of the Examining Division to refuse European patent application No. 06702666.6, which was filed as international application PCT/JP2006/300249. The application concerns the recording of image data, for example stream broadcasting data, in an information recording and reproduction device.

II. The decision was based on

- a main request, including claims 1 to 7 submitted on 15 October 2012,
- a first auxiliary request with claims 1 to 4 filed during oral proceedings on 15 November 2012, claims 1 to 4 having only a minor amendment over the corresponding claims of the main request, and
- a second auxiliary request filed during oral proceedings with the same claims as the first auxiliary request.

III. Claim 1 of the main request read as follows:

"An information recording/reproduction device (20) having a recording means (30) recording image data, comprising:

a means (24) of generating a plurality of items of first class information and a plurality of items of second class information, the plurality of items of first class information each including reference information indicating at least a part of the image data and the plurality of items of second class information each including reference information indicating at least one of the plurality of items of first class information;

a class information recording means for recording the plurality of items of first class information and the plurality of items of second class information; and a means of obtaining the reference information from the plurality of items of second class information, wherein

the information recording/reproducing device is operable to delete items of first class information from amongst the plurality of items of first class information and is arranged to invalidate the reference information, indicating the items of first class information to be deleted, included in the plurality of items of second class information when deleting the items of first class information;

the reference information indicating at least one of the plurality of items of first class information included in each of the plurality of items of second class information includes position information indicating a recording position of the at least one of the plurality of items of first class information; and

the class information recording means is arranged to defragment the plurality of items of first class information based on the plurality of items of second class information by creating a temporary first class information list file, copying items of first class information, from amongst the plurality of items of first class information, onto the temporary first class information list file when the reference information indicating the first class information is valid, putting the reference information included in the plurality of items of second class information in a state of referring to none of the plurality of items of first class information when the reference information is invalid, and replacing an original first class information list file, on which the plurality of items

of first class information are recorded, with the temporary first class information list file."

- IV. The Examining Division was of the opinion that none of the requests, *prima facie*, met the requirements of Articles 84 and 123(2) EPC, and did not admit them into the proceedings under Rule 137(3) EPC. The application was refused under Article 97(2) EPC on the ground that there was no text approved by the applicants within the meaning of Article 113(2) EPC.

With respect to Article 123(2) EPC, the Examining Division furthermore noted that according to claim 1 of the main request "the class information recording means is arranged to defragment the plurality of items of first class information based on the plurality of items of second class information", and that the examples of "defragment" operations provided in paragraphs [0046] to [0047] and [0075] to [0079] of the application included defragmenting a PGR, PGRG or UDFP list based respectively on a PGRM, PGRGM or TVREC.MGR. It was not directly and unambiguously derivable from the application as filed that any type of "first class information" could be defragmented based on any type of "second class information". Not all combinations were disclosed in the application. For example, there was no basis for defragmentation of "OPGR and UPGR" based on a "PGRG". Hence, the subject-matter of claim 1 of the main request extended beyond the content of the application as filed, contrary to Article 123(2) EPC.

The first and second auxiliary requests did not overcome at least some of the objections under Articles 84 and 123(2) EPC and, like the main request, were not admitted either under Rule 137(3) EPC.

V. With the grounds of appeal, the appellants requested that the decision be set aside and that a patent be granted based on the main request or the first auxiliary request, both filed with the statement of grounds of appeal. The claims of the main request were the same as claims 1 to 4 of the main request considered in the appealed decision (see claim 1 in section III above).

The appellants argued that the Examining Division had incorrectly exercised its discretion under Rule 137(3) EPC in not admitting the requests, in particular the main request, and that the requests filed on appeal fulfilled the requirements of Articles 84 and 123(2) EPC.

According to the appellants, Rule 137(3) EPC referred to "voluntary" amendments made after the first response of the applicant mentioned in Rule 137(2) EPC. However, the amendments at issue, i.e. the main request on which the decision was based, were not "voluntary" because they had been made specifically to address the objections raised by the Examining Division in the summons to oral proceedings.

Furthermore, the main request had been filed in time, by the final date for filing written submissions set out in the summons. The Examining Division was therefore required to admit it into the proceedings to ensure that the applicant had an opportunity to comment as guaranteed by Article 113(1) EPC.

The appellants also mentioned that the Guidelines for Examination (in the version then applicable), H-II, 2.3, third paragraph, stated that "Amendments remedying a deficiency in response to the preceding communication

must always be admitted, provided that they do not give rise to some new deficiency". In the present case, the amendments had indeed remedied the deficiencies raised, as none of the objections raised in the communication accompanying the summons had been repeated in the written decision. The main request did not give rise to any new deficiency, because the objections to claim 1 in the decision could equally have been raised against the claims pending when the summons to oral proceedings was issued.

The appellants argued that the Board should admit the main request into the proceedings, since it had been filed in time and not admitting it would unfairly deny the applicants' usual right to appeal and lead to a "potential procedural violation".

According to the appellants, the net result of refusing to admit not only the main request, but also the first and second auxiliary requests filed during oral proceedings, was that the claims previously on file, submitted with the letter dated 27 April 2012, were still pending. The Examining Division had been incorrect in refusing the application without issuing any written decision on those claims which were on file.

The appellants did not agree with the objection under Article 123(2) EPC. The teaching of the application as filed was explicitly general. Paragraph [0002] described defragmentation in a general way applying to "a stream recorded on an information recording medium" and not to specific aspects of what might be recorded. Paragraphs [0046] and [0047] did not set out a single example of defragmentation but rather two different examples, each one taught in a general fashion.

Original paragraph [0001] and claim 1, when read together, also taught the same level of generality. Therefore the claimed feature of defragmenting first class information based upon second class information did not add subject-matter but instead simply reflected the explicit generalised teaching provided to the skilled person by the application as filed.

In respect of the objection regarding the defragmentation of OPGR and UPGR based on a PGRG, the concrete example admittedly referred to defragmenting a PGR based upon a PGRM. However, given the overall generalised teaching of the application, there was nothing to indicate that an OPGR or UPGR could not be defragmented based upon a PGRG.

VI. The Board summoned the appellants to oral proceedings. In an annex to the summons, it summarised the issues likely to be discussed at the oral proceedings. The Board expressed the preliminary opinion that the Examining Division had incorrectly exercised its discretion in not admitting the main request before it. However, the main request did not appear to fulfill the requirements of Articles 84 and 123(2) EPC. Claim 1 of the auxiliary request also appeared to be unclear. Furthermore, the Board informed the appellants that it was inclined, if these objections were overcome, to remit the case to the Examining Division for assessment of novelty and inventive step.

VII. With letter dated 13 June 2014 the appellants submitted a new first and a second auxiliary request.

Claim 1 of the first auxiliary request differed from that of the main request (see sections III and V above) in that the first occurrence of the phrase "reference

information" had been amended to "first reference information", and the following occurrences had been amended to "second reference information".

Claim 1 of the second auxiliary request differed from that of the first auxiliary request in that the feature

"the information recording/reproducing device is operable to delete items of first class information from amongst the plurality of items of first class information and is arranged to invalidate the second reference information, indicating the items of first class information to be deleted, included in the plurality of items of second class information when deleting the items of first class information"

had been replaced with

"the information recording/reproducing device is operable to invalidate the second reference information, indicating items of first class information to be deleted, included in the plurality of items of second class information to delete the items of first class information to be deleted from amongst the plurality of items of first class information".

VIII. At the oral proceedings on 16 July 2014, the appellants submitted a third auxiliary request. Claim 1 of this request read as follows:

"An information recording/reproduction device (20) having a recording means (30) recording image data, comprising:

a means (24) of generating a plurality of items of first class information and a plurality of items of second class information, the plurality of items of

first class information each including first reference information referring to at least a part of the image data and the plurality of items of second class information each including second reference information referring to one of the plurality of items of first class information, the second class information collectively recording the second reference information on the plurality of items of first class information;

a class information recording means for recording the plurality of items of first class information and the plurality of items of second class information; and

a means of obtaining the second reference information from the plurality of items of second class information, wherein

the information recording/reproducing device is operable to invalidate the second reference information referring to items of first class information to be deleted in order to delete the items of first class information to be deleted;

the second reference information includes position information indicating a recording position of the one of the plurality of items of first class information; and

the class information recording means is arranged to defragment the plurality of items of first class information based on the plurality of items of second class information by creating a temporary first class information list file, copying items of first class information, from amongst the plurality of items of first class information, onto the temporary first class information list file when the second reference information referring to the first class information is valid, putting the second reference information included in the plurality of items of second class information in a state of referring to none of the plurality of items of first class information when the

second reference information is invalid, and replacing an original first class information list file, on which the plurality of items of first class information are recorded, with the temporary first class information list file,

wherein either a) the plurality of items of first class information are Program References (PGR) referring to at least a part of a program and the plurality of items of second class information are collectively recorded in a Program Reference Manager (PGRM) data structure; or
b) the plurality of items of first class information are Program Reference Groups (PGRG) each referring to one or more PGRs and the plurality of items of second class information are collectively recorded in a Program Reference Group Manager (PGRGM) data structure; or
c) the plurality of items of first class information are User Defined Favourites Folders (UDFF) each referring to one or more PGRs or to one or more PGRGs."

IX. The appellants' final request was that the decision under appeal be set aside and that a patent be granted on the basis of the main request including claims 1 to 4 filed with the grounds of appeal or, in the alternative, on the basis of claims 1 to 4 of either the first or second auxiliary request filed with the letter dated 13 June 2014, or on the basis of a third auxiliary request including claims 1 to 4 filed during the oral proceedings and the amendments to the description underlying the then first auxiliary request filed with the grounds of appeal dated 18 July 2013. The application documents for the third auxiliary request thus include the description pages 1, 1a, 4 and 13 to 14 filed with the grounds of appeal dated 18 July 2013, and pages 2, 3, 8 to 12, and 15 to 44

filed upon entry into the European phase (pages 5 to 7 having been deleted in the submission dated 15 October 2012), as well as the drawing sheets 1/27 to 27/27 as filed upon entry into the European phase.

- X. At the end of the oral proceedings, the Chairman announced the decision of the Board.

Reasons for the Decision

Admissibility of the appeal

1. The appeal is admissible since it complies with the provisions referred to in Rule 101 EPC.

Admission of requests into the proceedings: main request

2. According to Article 12(4) RPBA the Board has the power to hold inadmissible requests which were not admitted in the first-instance proceedings. Although the appellants' main request is not identical to the main request before the Examining Division, both requests include the same claims 1 to 4 as well as the same description. Since the reasons given by the Examining Division for not admitting the then main request under Rule 137(3) EPC were based *inter alia* on the argument that *prima facie* claim 1 did not comply with Articles 84 and 123(2) EPC (see section IV above), the Board considers Article 12(4) RPBA to be applicable in principle.
 - 2.1 The general principles for exercising the discretion to allow amendments are well-established in the case law (see G 7/93, OJ EPO 1994, 775). According to the Enlarged Board of Appeal, "the way in which the

Examining Division should exercise its discretion to allow an amendment of an application must depend upon the circumstances of each individual case, and must also depend upon the stage of the pre-grant procedure which the application has reached" (reasons 2.2).

When deciding on the question of admitting a request, an Examining Division is required to consider all relevant factors which arise in a case (see G 7/93, reasons 2.5). Even though in decision G 7/93 this statement was made in the context of amendments at a late stage of the pre-grant procedure, it has been considered to more generally apply to other phases of the examination procedure (see, for example, Case Law of the Boards of Appeal of the EPO, 7th edition 2013, IV.B.2, and decision T 573/12 of 8 May 2013, reasons 3.3, relating to amendments filed before the time limit set according to Rule 116(2) EPC).

Additionally, according to G 7/93 "In the circumstances of a case such as that before the referring Board, a Board of Appeal should only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance with the right principles [...] or that it has exercised its discretion in an unreasonable way [...]" (reasons 2.6).

- 2.2 Therefore, as a first step, the Board must assess whether the Examining Division exercised its discretion under Rule 137(3) EPC taking into account the right principles and in a reasonable way. If that was not the case and if the correct exercise of the discretion should have led to the admission of the then main

request, the Board would have to admit the appellants' current main request into the appeal procedure.

2.3 Rule 137(3) EPC as currently in force is applicable in the present case, since the search report was established on 20 December 2010, see the transitional provision in Article 2(2) of the decision of the Administrative Council of 25 March 2009 amending the Implementing Regulations to the European Patent Convention (OJ EPO 2009, 299). This provision follows Rule 137(2) EPC (which enshrines a right to make voluntary amendments at a specific stage of the proceedings) and states that no further amendments may be made without the consent of the Examining Division.

2.4 In the present case, the applicant had already amended the application with the letters dated 25 July 2011 and 27 April 2012. The main request on which the decision was based was therefore a further amendment within the meaning of Rule 137(3) EPC and subject to the consent of the Examining Division.

2.5 The Examining Division argued that the main request before it did not *prima facie* meet the requirements of Articles 84 and 123(2) EPC and that, therefore, it was reasonable not to admit it under Rule 137(3) EPC.

It is already questionable whether the main request could have been seen as *prima facie* not fulfilling Articles 84 and 123(2) EPC. *Prima facie* can be understood as "immediately apparent, with little investigative effort". However, the argumentation of the Examining Division is based on several passages of the description and close interpretation and comparison of the description and the claims. It may further be questioned whether the criterion used, i.e. *prima facie*

non-compliance with Articles 84 and 123(2) EPC, may be applied at all to a request filed before the deadline under Rule 116(2) EPC and as a reaction to objections raised by the Examining Division.

In any event, the Examining Division did not mention any other criteria for not admitting the main request. In particular, it did not take into account several criteria which were relevant for the present case.

The Guidelines for Examination deal (in section H-II, 2.3) with the admissibility of amendments under Rule 137(3) EPC during examination after receipt of the first communication, mentioning a number of factors to be considered. Among those are the following criteria:

- (a) the amendments remedy a deficiency in response to the preceding communication, provided they do not give rise to new deficiencies;
- (b) the amendments improve the clarity of the description or claims in a clearly desirable manner;
- (c) need to avoid unnecessary delay and excessive and unjustified additional work for the EPO.

The Board is of the opinion that the Examining Division should have taken criteria (a) to (c) into account.

It follows from the above that the Examining Division incorrectly exercised its discretion under Rule 137(3) EPC in not admitting the main request into the proceedings.

2.6 An analysis of criteria (a) to (c) above is therefore required.

The appellants mentioned the first factor (a), arguing that the non-admitted main request sought to overcome the objections previously raised, remedied the previous deficiencies and did not introduce new ones (see also section V above).

The annex to the summons to oral proceedings before the Examining Division raised major objections under Article 84 EPC against claim 1 of the then pending requests. In response, the applicants filed the main request on which the decision was based. Since different clarity objections were raised against the new claims in the decision, it is reasonable to assume that the Examining Division considered the previous objections to have been overcome and that the amendments sought to overcome the previously identified deficiencies.

Amongst other things, the amendments added the term "plurality of items" to better describe the first and second class information, and a description of the deletion of items by invalidation of the reference information, in order to clarify the feature of defragmentation. These amendments improved the clarity of the claims in a clearly desirable manner.

The Board also finds convincing the appellants' argument that the deficiencies mentioned in the decision were not introduced by the non-admitted claims since they could also have been raised against the previous claims. For example, previous claim 1 already included features defining the first and second class information, and the feature "defrag the first class information based on ... being obtained from the second class information", in a context similar to that of the non-admitted claim.

Additionally, the claims were filed one month before the oral proceedings and the Board is not convinced that unnecessary delay or unjustified work for the EPO would have been caused by their admission.

Therefore, taking criteria (a), (b) and (c) into account, the claims should have been admitted.

- 2.7 Since the Examining Division incorrectly exercised its discretion under Rule 137(3) EPC and a consideration of the right principles should have led to the admission of the then main request, the appellants' current main request has to be admitted.

Admission of requests into the proceedings: first, second and third auxiliary requests

3. The first and the second auxiliary requests were submitted in reaction to the objections raised by the Board in its communication accompanying the summons. The third auxiliary request was filed as a reaction to the discussion of the relevant issues in the oral proceedings and overcomes the objections that were the subject of these appeal proceedings. In the exercise of its discretion under Article 13(1) RPBA, the Board admits these requests.

The invention

4. The application relates to a recording and reproducing device for stream data, i.e. digital broadcasting data, referred to as "image data" in the application and claims.

4.1 According to the description in paragraphs [0027] to [0035], a data structure on the information recording medium is used (see Figure 1) which includes

- "Programs", representing units of image data, or "titles", for example, a movie or a TV program;
- "Original Program References (OPGR)", each OPGR referring to a whole program, and "User Defined Program References (UPGR)", each referring to a part of a program;
- one "Program Map (PGMAP)", referring to the OPGR;
- "Program Reference Groups (PGRG)", which are lists of references to OPGR or UPGR; and "User Defined Favorite Folders (UDFF)", which are lists of references to OPGR, UPGR or PGRG.

A PGRG is taken to be equivalent to a playlist, a list of one or more user's favourite scenes arranged according to the user preferences. The UDFF is used for classifying and arranging image data (paragraph [0028]).

The description also refers to a "Program Reference Manager" (PGRM) as a list of "Program References" (PGR), each PGR referring to at least a part of a program; a "Program Reference Group Manager" (PGRGM) as a list of PGRGs; and a UDFF table as a list of UDFFs (paragraphs [0017] and [0027]).

4.2 The application describes in paragraphs [0046] to [0047] and [0075] to [0080] embodiments of a "defragmentation" process which can be performed for deleting an invalid part from a PGR, PGRG or UDFF list. The "defragmentation" of, for example, a PGR list consists of (see paragraphs [0046], [0047] and [0077], figure 20)

- creating a temporary PGR list,

- for each reference of the PGRM list referring to an entry in the PGR list,
 - if the reference is valid, copying the corresponding entry of the PGR list to the temporary PGR list,
 - if the reference is invalid, changing the reference of the PGRM list into a state of making no reference to any PGR list entry, and
- copying the temporary PGR list to become permanent.

Defragmentation may be carried out at different timings, for example upon stop using the removable recording medium or when it is explicitly selected by the user (see paragraph [0079]).

Main request

5. Claim 1 of the main request defines subject-matter extending beyond the scope of the application as filed (Article 123(2) EPC).
- 5.1 The description refers specifically to the examples of defragmentation of a PGR list based on a PGRM (paragraphs [0046] and [0075] to [0079]), of a PGRG list based on a PGRGM (paragraphs [0047], [0075] and [0079]) and of a UDFD (paragraphs [0075] and [0079]). The claim defines a generalisation of these embodiments, in particular a defragmentation of "the plurality of items of first class information based on the plurality of items of second class information", each item of first class information "including reference information indicating at least part of the image data".

5.2 However, there is no basis in the originally filed application for such a generalised defragmentation.

The appellants cited paragraphs [0001], [0002], [0046] and [0047], as well as claim 1 of the original application, as the basis for such a generalised defragmentation. In oral proceedings the appellants also argued that paragraph [0001] and original claim 1 both described recording and defragmenting in a similar context and that the skilled person would assume that the same level of generality applied to both recording and defragmenting.

The Board does not find the arguments of the appellants convincing. Paragraph [0002] and the original claims do not refer to defragmentation. Paragraph [0001] is an introductory paragraph mentioning defragmentation, but without describing first and second class information. The features regarding defragmentation are only described in two passages of the original application, namely paragraphs [0046] to [0047] and [0075] to [0080]. In these paragraphs, defragmentation is described in the context of specific embodiments and as defragmentation of specific data structures, namely PGR, PGRG and UDFP.

5.3 In addition, the Board notes that, even if the skilled person considered that defragmentation was not necessarily limited to the examples given, he would, based on the description, recognise that defragmentation is based on special structures, such as PGRM and PGRGM. Those special structures are used for management purposes and are "complete", in the sense that they collectively record reference information.

In the description, especially paragraphs [0042], [0048] and [0049], a PGRM data structure is described as collectively recording reference information on the PGR. Paragraphs [0042] to [0050] state that upon recording the PGR the information recording/reproduction device refers to reference information contained in the PGRM. The same is disclosed for the PGRGM. The skilled person reads from these passages that the "manager" structures PGRM and PGRGM, on which the defragmentation is based, are special structures, similar to complete directories used for data management purposes. Those structures are to be distinguished from the others used for the convenience of the user to define, for example, favourite titles (UDFF), preferred scenes (UPGR) or playlists (PGRG).

Regarding this point the appellants argued in oral proceedings that the skilled person would not limit the generality of the description, even if some embodiments covered by such a general claim did not work or were poor solutions to defragmentation.

The Board does not follow this reasoning. There would be no reason for the skilled person to assume that defragmentation according to the invention was also based on such "user" data structures. Defragmentation of a PGR based on a PGRG would not work properly. Since a PGRG is not a complete list of PGR items, the defragmentation would be incomplete and, without further measures, references of the PGRM would be lost. Since a PGRG item may refer to more than one PGR, it would be more difficult to use it as a basis for defragmentation. The application does not address such issues. The skilled person would therefore assume the technical teaching to be restricted to defragmentation based on "management" structures.

- 5.4 The Board also considers that there is no basis in the original application for the feature of claim 1 "the plurality of items of second class information each including reference information indicating at least one of the plurality of items of first class information" (emphasis added). Each entry of the PGRM and the PGRGM refers to exactly one item of the PGR and PGRG, respectively. The application as filed does not clearly and unambiguously describe fragmentation based on a data structure which may include in a single item more than one reference to the list of items to be defragmented (as is the case, for example, of a PGRG).

First auxiliary request

6. In claim 1 of the first auxiliary request (see section VII), the feature "reference information" has been clarified by naming the reference information of the first and second class information "first reference information" and "second reference information" respectively. The objections under Article 123(2) EPC still apply to the first auxiliary request.

Second auxiliary request

7. Claim 1 of the second auxiliary request (see section VII) differs from that of the first auxiliary request in that the feature describing the deletion of items has been reworded for improved clarity. The deficiencies under Article 123(2) EPC discussed under point 5 above have not been overcome by these amendments.

Third auxiliary request

8. With the third auxiliary request (see claim 1 in section VIII) the appellants addressed the remaining objections.

8.1 In claim 1 defragmentation is limited to the combinations described in the application. The last features of the claim, "wherein either a) ...", restrict the combinations of first class information and second class information to PGR and PGRM, as well as PGRG and PGRGM, and also cover the first class information UDFE, describing each of these structures. In particular, the claim defines that the second class information, as well as the PGRM and PGRGM data structures, collectively record the second reference information. The objection discussed in points 5.1 to 5.3 above has therefore been overcome.

Claim 1 also specifies that the second reference information refers to "one", instead of "at least one", of the items of first class information, overcoming the deficiency discussed under point 5.4 above.

The feature "reference information indicating" has been amended to "reference information referring" for improved clarity.

8.2 In the opinion of the Board, none of the objections under Article 84 EPC raised in the decision of the department of first instance applies to the claims of the third auxiliary request.

The feature "first class information" described in current claim 1 of the third auxiliary request is considered to be supported by the description. The

claim restricts the "first class information" to the PGR, PGRG and UDFG data structures described in the application, e.g. in paragraphs [0075] to [0079], in the same combination with the other features of the invention as in the claim. Furthermore, paragraph [0026] of the description has been amended to remove some examples of combinations of first and second class information.

8.3 The subject-matter of the claim can be derived from original claim 1 and the following passages of the originally filed application: paragraph [0042], which is the basis for the feature "the second class information collectively recording the second reference information on the plurality of items of first class information"; paragraphs [0011] and [0064], describing the position information and deletion of items of first class information by invalidation of the corresponding second reference information; paragraph [0027], which refers to the data structures of the invention, including PGRM; and paragraphs [0046], [0047] and [0075] to [0080], describing defragmentation.

8.4 The Board is therefore satisfied that claim 1 of the third auxiliary request overcomes the deficiencies under Articles 84 and 123(2) EPC.

Procedural violation/reimbursement of the appeal fee

9. In the grounds of appeal the appellants claimed that the Examining Division had incorrectly exercised its discretion in not admitting the requests, had deprived them of their right to be heard and had decided on the wrong requests.

Even though the appellants did not request reimbursement of the appeal fee, the Board decided to examine the issue of its own motion, in line with Article 114(1) EPC and established case law, for example decisions J 7/82, OJ EPO 1982, 391, T 271/85 of 22 March 1989, and T 598/88 of 7 August 1989 (see also Case Law of the Boards of Appeal of the EPO, 7th edition, IV.E.8.1.1).

9.1 As set out above (see point 2.5), the Examining Division did indeed incorrectly exercise its discretion in not admitting the main request. This constitutes a procedural violation. Nevertheless, the Board does not consider that it would be equitable within the meaning of Rule 103(1)(a) EPC to reimburse the appeal fee on this ground, independently of whether the procedural deficiency could also be considered to amount to a violation of the right to be heard. It is apparent from the substantiated reasoning given in the decision with respect to the objections under Articles 84 and 123(2) EPC, as well as the treatment of those objections and the applicants' arguments documented in the minutes of oral proceedings, that the Examining Division could have issued a reasoned decision on those grounds. In view of that, it can safely be assumed that the Examining Division would have refused the requests if it had admitted them into the proceedings. Thus, the applicants would still have had to file an appeal.

9.2 The appellants furthermore contended that, as a consequence of not admitting the requests, the claims previously on file were still pending, and the Examining Division should have issued a written decision on those previous claims submitted with the letter dated 27 April 2012.

On the contrary, the Board notes that the claims previously on file were no longer to be considered to be pending, since they had been replaced with the claims of the main request filed with the letter dated 15 October 2012 on which the decision was based. The non-admission of newly submitted claims does not revive the previous set of claims (see T 946/96 of 23 June 1997, reasons 3.2). According to Article 113(2) EPC the European Patent Office must consider and decide upon the European patent application only in the text submitted to it, or agreed to, by the applicant. The Examining Division would have infringed these provisions, had it decided on the basis of claims to which the applicants no longer agreed. By filing new sets of claims, the previous claims were no longer agreed to by the applicants. The case law (see T 946/96, reasons 3.1, and Case Law Book of the Boards of Appeal of the EPO, 7th edition, III.B.3) is consistent in stating that in such a case the Examining Division should not decide upon the previous claims, because they are no longer on file.

Remittal

10. In the decision under appeal the issues of novelty and inventive step (Articles 54 und 56 EPC) were neither decided nor discussed in any form.

Under these circumstances, the Board is not in a position to decide on the novelty and inventive step of the claimed subject-matter and hence cannot accede to the appellants' request for granting a patent in the present appeal proceedings.

Consequently, the Board decides to remit the case to the department of first instance for further

prosecution (Article 111(1) EPC), and in particular for assessment of novelty and inventive step.

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 the third auxiliary request including claims 1 to 4 filed during the oral proceedings and the amendments to the description underlying the then first auxiliary request filed with the grounds of appeal dated 18 July 2013.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated