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**Datasheet for the decision
of 5 July 2018**

Case Number: T 2447/13 - 3.4.03

Application Number: 01956652.0

Publication Number: 1334478

IPC: G09B19/02, G09B7/02

Language of the proceedings: EN

Title of invention:
ELECTRONIC CALCULATOR

Applicant:
Samson, Ilan Zadik

Headword:

Relevant legal provisions:
EPC 1973 Art. 111(1), 113(2)
EPC Art. 123(2)
EPC 1973 R. 67

Keyword:
Amendments - broadening of claim (yes) - added subject-matter (yes)
Reimbursement of appeal fee - (no)

Decisions cited:

Catchword:



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Case Number: T 2447/13 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 5 July 2018

Appellant: Samson, Ilan Zadik
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Representative: Harrison IP Limited
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 16 July 2013
refusing European patent application No.
01956652.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Eliasson
Members: T. M. Häusser
C. Heath

Summary of Facts and Submissions

- I. The appeal concerns the decision of the examining division refusing the European patent application No. 01 956 652 for lack of inventive step (Article 56 EPC 1973) in relation to the requests pending at the time.
- II. Oral proceedings before the board took place in the absence of the appellant, of which the board had been informed beforehand.

In writing the appellant had requested that the decision under appeal be set aside and a patent be granted based on the main request or the first or second auxiliary requests, all filed with the letter dated 16 November 2013 setting out the grounds of appeal. Furthermore, the appellant requested the reimbursement of the appeal fee.

- III. The wording of respective claim 1 of the requests is as follows (board's labelling "(a)", "(b)", "(c)", "(d)", "(e)", "(a)'", "(c)'", and "(e)'"):

Main request:

"1. An electronic calculator having means for enabling a user to enter calculations, a processor for performing the entered calculations and a display for displaying the result of calculations, characterised in that,

- (a) in a mode of operation of the calculator, the processor is programmed to provide:
- (b) means requiring the user, following completion of the entry of the calculation, to enter an estimate of the result of the calculation,
- (c) means for computing a tolerance range,

(d) means for comparing the estimate entered by the user with a correct result of the calculation computed by the calculator, and

(e) means for preventing the correct result of the calculation from being displayed, for at least one estimate entered by the user, when the difference between the estimate and the correct result lies outside a determined tolerance range."

First auxiliary request:

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that features (c) and (e) are replaced by the following features (c)' and (e)', respectively:

(c)' "means for computing a tolerance range in dependence upon the nature of the operators, the numerical value of the operands in the calculation and any tolerance range of the operands",

(e)' "means for displaying the correct result of the calculation if the difference between the estimate entered by the user and the correct result lies within the determined tolerance range"

Second auxiliary request:

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that feature (a) is replaced by the following feature:

(a)' "during operation of the calculator, the processor is programmed to provide:"

IV. The appellant argued essentially as follows:

(a) Procedural matters

The appellant stated its belief that the claims filed on 7 June 2005 could perhaps form the basis for the grant of a patent.

Moreover, the long duration of the proceedings before the examining division (delay of 6 years between the appellant's letter and the subsequent summons to oral proceedings) and the examination division's statement in a communication that the application contained patentable subject-matter amounted to a substantial procedural violation warranting the reimbursement of the appeal fee.

(b) Amendments

In the grounds of appeal the appellant referred to its letter dated 23 May 2013 for the basis of the amendments. In that letter it is stated that the removal in claim 1 of the main request of the precise definition of the tolerance range was appropriate in view of the general definition of predetermined tolerances in the description of the application on page 2, lines 15-26.

Moreover, the amendment to replace the term 'determining' with 'computing' in claim 1 of the main request had a basis on page 9, lines 3-4. The omission of the mode of operation in claim 1 of the second auxiliary request was based on page 14, line 29 - page 15, line 3 of the application as filed.

Reasons for the Decision

1. Procedural matters

1.1 In its reply to the summons to oral proceedings the appellant informed the board about its absence from the forthcoming oral proceedings and further stated that it "believe[d] the claims filed on 7 June 2005 could perhaps form the basis for the grant of a patent".

The board notes that according to Article 113(2) EPC 1973 the EPO shall consider and decide upon the European patent application only in the text submitted to it, or agreed, by the applicant. It is therefore the applicant's responsibility to clearly define the text on the basis of which it requests a patent to be granted.

In the present case the appellant's statement cited above is a mere expression of its belief concerning a possible basis for the grant of a patent. However, there is no indication that the appellant wished in fact that a patent be granted on the basis of the mentioned claims, let alone that these claims should form a request replacing the requests on file or supplementing these requests as a main request or first, second or third auxiliary request.

Therefore, the above statement by the appellant is not considered a request.

1.2 The appellant also argued that the long duration of the proceedings before the examining division and the examination division's statement in a communication that the application contained patentable subject-matter amounted to a substantial procedural violation warranting the reimbursement of the appeal fee.

According to Rule 67 EPC 1973 the reimbursement of appeal fees has to be ordered where the board of appeal deems an appeal to be allowable, if the reimbursement is equitable by reason of a substantial procedural violation.

In its communication dated 5 December 2006 the examining division merely made an opening remark that "it appears that there is patentable subject-matter in the application" but continued by raising objections under Articles 84 and 123(2) EPC 1973. The board sees no causal link between either this remark or the long duration of the proceedings before the examining division on the one hand and the filing of the appeal on the other hand. These alleged procedural errors were not the reason that the appeal had to be filed. Rather, the appellant had to file the appeal irrespective of whether or not the alleged errors had occurred. However, without such a causal link the reimbursement of the appeal fee is not equitable (see *Case Law of the Boards of Appeal of the EPO*, 8th edition 2016, section IV.E. 8.6.1).

In view of the above the request for reimbursement of the appeal fee must be refused.

2. Amendments

2.1 In the decision under appeal the examining division held that the subject-matter of the claims of the requests pending at the time, which correspond essentially to the claims of present requests, lacked inventive step (see points 19 and 20 of the Reasons).

2.2 In its communication under Article 15(1) RPBA the board raised other objections, *inter alia* concerning added subject-matter (Article 123(2) EPC).

In particular, one added subject-matter objection concerned features (a) and (d) of claim 1 of the main request, according to which the processor of the claimed electronic calculator is programmed in a certain mode of operation to provide means for comparing the estimate entered by the user with a correct result of the calculation computed by the calculator. There is no indication in features (a) and (d) (or any other feature of the claim) concerning how this comparison is to be performed. Since this is left open, the means of comparison are claimed in broad terms and the relevant comparison may be performed, according to the claim, in any manner whatsoever.

In the original application documents it is disclosed in this respect that the above comparison is performed by checking whether the estimate lies within a pre-determined tolerance range of the correct result. This is specified in claim 2 as originally filed and in the corresponding part of the description, in which the invention is disclosed in terms of the technical problem and its solution (see page 1, line 36 - page 2, line 2 of the original description).

In the concrete embodiments of the invention as shown in the flow charts of Figures 1, 2, and 3 this comparison is carried out in step 205, in steps 305 and 313, and in step 408, respectively. In each case the comparison involves checking whether the estimate lies within the tolerance of the correct result determined by the calculator (see the description of the application, page 7, lines 27-29; page 8, lines 9-20; page 9, lines

14-17), where the tolerance had been determined by the calculator in a previous step using an algorithm built into the calculator (see page 7, lines 14-16; page 8, lines 9-20 and 34-36; page 9, lines 3-7).

Hence, in the original application documents there is no disclosure of the comparison means in the broad terms claimed. Moreover, it has in fact only been disclosed that the relevant comparison is carried out by checking that the estimate lies within a predetermined tolerance range of the correct result.

Consequently, the subject-matter of features (a) and (d) is not directly and unambiguously derivable from the original application documents. In particular, various ways of performing the comparison which have no basis in the application as filed are encompassed by the claimed subject-matter, e. g. checking whether the order of magnitude of the estimate is the same as that of the correct result.

Therefore, claim 1 of the main request contains subject-matter extending beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

2.3 Claim 1 of the first auxiliary request also contains features (a) and (d). In claim 1 of the second auxiliary request feature (a) was merely amended in that reference to a particular mode of operation was suppressed.

For the same reasons as those mentioned under point 2.2 above claim 1 of the first auxiliary request and claim 1 of the second auxiliary request also contain subject-matter extending beyond the content of the application

as filed, contrary to the requirements of Article 123(2) EPC.

2.4 In view of the above the appeal must be dismissed (Article 111(1) EPC 1973).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated