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VI.

Aktenzeichen:
Case Number: T 11/82
N° du recours :

ENTSCHEIDUNG / DECISION

vom / of / du 15 April 1983

Anmelder:
Applicant: LANSING BAGNALL LTD.
Demandeur :

Stichwort:
Headword: Control circuit/Lansing Bagnall
Référence :

EPÜ / EPC / CBE Articles 54(2), 69(1), 78(1)(3), 84, 97(1), 123(2), 138(1)(c)(2),
164(1)(2)
Protocol on the interpretation of Article 69
Rules 27(1)(c)(d), 36(1)
Practice of the Boards of Appeal: Communications

Leitsatz / Headnote / Sommaire

- I. A European patent application must satisfy the conditions laid down in the Implementing Regulations. If, in the opinion of the Examining Division, it does not do so, the Examining Division is obliged to refuse it.
- II. The expression "background art" used in the English text of Rule 27(1)(c) and (d) EPC must have the same meaning as the more familiar expression "prior art".
- III. If amended claims are submitted following the issue of the European Search Report and/or as a result of a communication from the Examining Division, it will be necessary to make consequential amendments to the description in order to ensure that the amended claims are supported by the description. The amended description will be a document replacing a document making up the European patent application and all the provisions of Rule 27 EPC will apply to it.
- IV. Rule 27 EPC recognises the needs of the public to be able to understand the invention and any advantageous effects it may have, from the description, at any time.
- V. The mere addition to a description of a reference to prior art cannot reasonably be interpreted as the addition of "subject-matter", contrary to Article 123(2) EPC. Nor is inevitable that the addition of a discussion of the advantages of the invention with reference to such prior art would constitute a contravention of that Article. Whether it did so would clearly depend on the actual language used and the circumstances of the case.

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Case Number: T 11 / 82

DECISION
of the Technical Board of Appeal 3.5.1
of 15 April 1983

Appellant: LANSING BAGNALL LTD.
Kingsclere Road
Basingstoke
Hampshire

Representative: Horton, Andrew Robert Grant et al.
BOULT, WADE & TENNANT
27 Furnival Street
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Decision under appeal: Decision of Examining Division 054 of the European Patent
Office dated 20 May 1981 refusing European patent
application No 78 300 585.3 pursuant to Article 97(1)
EPC

Composition of the Board:

Chairman: G. Korsakoff
Member: P. Ford
Member: J. van Voorthuizen

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 2 November 1978, European patent application No.78 300 585.3 was filed on behalf of the appellants. The application, which was published under No. 0 002 116 on 30 May 1979, relates to a "Control circuit for a D.C. motor for example in an electrically powered vehicle".
- II. Following the issue of the European Search Report, the appellants' professional representatives amended the claims of the application by submitting new claims pages 1 and 3 to replace the originally filed claims pages 1 and 3. Further amended claims were subsequently submitted in response to a communication from the Examining Division.
- III. By a communication dated 7 May 1980, the Examining Division indicated that the invention appeared to be patentable in accordance with Article 52 EPC, but requested the appellants inter alia to indicate in the description the relevant state of the art disclosed in a published French patent specification, which had been cited in the European Search report, and to state advantageous effects of the invention with reference to the background art as represented by the French patent specification, in accordance with Rule 27(1) EPC.
- IV. In a written reply to this communication, dated 2 October 1980, the appellants' professional representatives declined to comply with the Examining Division's requests. They asserted that the description already contained a reference to the background art which so far as known to the applicant was useful for understanding the invention, and already contained a statement of the

advantageous effects of the invention with reference to the background art. They further submitted that amending the description to refer to the French patent specification, which had not been referred to in the description as filed, would constitute an addition of matter which was prohibited by Article 123(2) EPC. They contended that it could not be guaranteed that Article 123(2) EPC would not be interpreted by a national court or tribunal in a manner prohibiting such an amendment and stated that, accordingly, the appellants declined to risk invalidity of their European patent.

V. In a further communication dated 5 December 1980, the Examining Division expressed the view that the appellants appeared to be mistaken in considering that the addition of references to the (most relevant) prior art would constitute addition of subject-matter contrary to Article 123(2) EPC. Reference was made to the Guidelines for Examination in the European Patent Office, Part C, Chapter VI, paragraph 5.3. The Examining Division added that there was no adequate reference to the prior art; that inter alia the French patent specification was extremely relevant and should be "cited" and that the advantageous effects stated in the appellants' description could exactly apply to the circuit shown in Fig. 1 of the French patent specification. If the objections made were not met, this would appear to be sufficient to result in the rejection of the application.

VI. By letter dated 30 January 1981, the appellants' professional representatives replied that the citation of documents reflecting the background art was a matter of preference, not compulsion, cf. Rule 27(1)(c) EPC. That

paragraph of the Rule was not authority for the re-writing of the description every time some prior art was subsequently found. Moreover, it served no useful purpose to abstract documents which were already mentioned in the search report. Further, it was unnecessary to distinguish the invention from the prior art because the Examining Division had acknowledged that the invention claimed was patentable over the prior art. On the facts of the case, it was clearly technically different from what had been described in the prior art and any further explanation of the advantageous effects of the invention relative to the prior art would clearly constitute "new information" which was not present in the documents as filed. So far as the requirements of Rule 27(1)(d) EPC were concerned, they were adequately met by the existing description.

VII. On 20 May 1981, the Examining Division issued the decision under appeal by which it held that the European patent application did not comply with the requirements of Rule 27 EPC in two respects : First, contrary to Rule 27(1)(c) EPC, the description did not indicate the background art. The contention (in the appellants' professional representatives' letter dated 2 October 1980) that the description already sufficiently indicated the background art, was not accepted. Even if it were to be considered as having indicated the background art, it would still have been necessary for the reference to have been expanded in order that the invention might be seen in its proper perspective in relation to the background art. It was necessary that the manner in which the invention differed from the arrangement described in the French patent specification should be clearly indicated in the description. Further, the submission that

Rule 27(1)(c) EPC applies only to originally filed documents was rejected as being inconsistent with Rule 36(1) EPC. Secondly, contrary to Rule 27(1)(d) EPC, the description was not in agreement in all essential respects with the claims, which was also necessary to comply with Articles 69 and 84 EPC. The Examining Division considered that to communicate once more with the appellants would not result in satisfactory amendment of the application, in view of the appellants' refusal twice to meet the Examining Division's objections. Accordingly, the European patent application was refused under Article 97 EPC.

VIII. By letter dated 8 July 1981, the appellants' professional representatives gave notice of appeal, asking for cancellation of the decision under appeal and alternatively or additionally for amendment of the decision such as to permit amendment of the European patent application by way of rectification of the alleged faults in the application. The appeal fee was duly paid.

IX. A written statement setting out the Grounds of the Appeal was duly filed on 14 September 1981. The appellants' professional representatives submitted that

- (1) The application complied with the requirements of the EPC and the Rules so far as it was necessary to comply with them.
- (2) The Examining Division had misinterpreted the requirements of Rule 27 EPC.

- (3) The decision under appeal was excessively bureaucratic in that it purported to reject the application on a ground which was of no importance to the interpretation or validity of the application.

It was contended inter alia that:

- (a) No reference to the French patent specification was required by the Convention or the Rules or that if such reference were required it would be oppressive to reject the application on the basis of the absence from the description of information which the skilled man did not require for the performance of the invention;
- (b) Rule 27 EPC should not properly be regarded as a weapon for rejecting an application merely because it did not, in the opinion of the Examining Division, make sufficient reference to some particular piece of prior art which the Division happened to consider might be relevant to the validity of the claims;
- (c) Rule 27(1)(c) EPC was an admonition to an applicant, at the time of filing an application, that if he is aware of prior art which he regards as useful for those who may wish to avail themselves of the invention or to examine its merits, he should cite it. Such citation could avoid unnecessary description. The Rule also meant that the applicant should cite prior art of which he was aware to facilitate the drawing up of the search report and the examination of the merits of the invention. However, there was no requirement to do this once the search report had

been drawn up and the examination of the merits of the invention had been made;

- (d) Since Rule 27(1)(c) EPC only makes the citation of documents reflecting the background art a matter of preference, the absence of a citation cannot be made a reason for refusing a European patent application;
- (e) Rule 27(1)(d) EPC does not make possession of advantageous effects a necessary requirement for validity;
- (f) The Examining Division had wrongly interpreted Rule 27(1)(d) EPC as requiring that the advantages of the "inventive step" (the non-obvious difference between the combination of features in the claims and the proven state of the art) should be stated;
- (g) Article 123(2) EPC, which prohibits the addition of subject-matter to an application by amendment, and Article 138 EPC, which makes it a ground of invalidity of a European patent that an application has been amended contrary to Article 123(2) EPC, justify the appellants' refusal to jeopardise the validity of their European patent by amending their application;
- (h) On the facts of the present case, which are that claim 1 refers to features common to the present invention and the French patent specification, citation of the French patent specification is unnecessary. In particular, the decision under appeal had ignored the appellants' professional representa-

tives' arguments (in their letter dated 30 January 1981) that the French specification was not as relevant as the Examining Division had thought;

- (i) Discussion of a particular piece of prior art can be misleading, since documents found by a search are not always the most relevant;
 - (j) The Examining Division's view that the description was not in agreement with the claims was based on points that were in some cases trivial and in other cases incorrect. Furthermore, in one respect an objection had been taken which had not previously been brought to the appellants' attention;
 - (k) If the appellants' submissions as to the meaning of Rule 27 EPC were not accepted by the Board of Appeal, then they should be entitled to submit appropriate amendments.
- X. By letter dated 30 April 1982, the Technical Board of Appeal invited the appellants' professional representatives' observations on certain points of law affecting the arguments on the appeal, and drew attention to other matters which might call for further amendment of the description and claims in due course.
- XI. The appellants' professional representatives submitted arguments in response by letter dated 24 June 1982.
- XII. The Technical Board of Appeal invited the appellants to make further observations by letter dated 8 November 1982, to which the appellants' professional representatives replied by letter dated 6 January 1983.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is, therefore, admissible.
2. The Examining Division rejected the appellants' European patent application under Article 97(1) EPC, which provides that the Examining Division shall refuse a European patent application if it is of the opinion that such application or the invention to which it relates does not meet the requirements of the Convention, except where a different sanction is provided for by the Convention.
3. There is no question in this case of a different sanction being provided for by the Convention, nor is it an issue in this appeal whether the invention to which the application relates meets the requirements of the Convention.

The Examining Division has held that the application does not meet the requirements of the Convention because it does not comply with the requirements of Rule 27(1)(c) and Rule 27(1)(d) EPC.

4. A European patent application must satisfy the conditions laid down in the Implementing Regulations: cf. Article 78(3) EPC. If, in the opinion of the Examining Division, the application does not do so, the Examining Division is obliged by Article 97(1) EPC to refuse it.

.../...

5. Article 78(1)(b) EPC provides that a European patent application shall contain a description of the invention and Article 78(1)(c) EPC provides that it shall contain a claim or claims. As the Examining Division has rightly pointed out in the decision under appeal, the relationship between the description and the claims is important, because, inter alia, the description shall be used to interpret the claims (Article 69(1) EPC) and because the claims shall be supported by the description (Article 84 EPC). The Protocol on the interpretation of Article 69 EPC underlines the significance of the description when the extent of protection conferred by a European patent is being determined. It is in accordance with the expressed policy of maintaining a just balance between a fair protection for the patentee and a reasonable degree of certainty for third parties, that the European Patent Office must ensure that applicants comply properly with the requirements of inter alia Rule 27 EPC.
6. Rule 27 EPC, which deals with the contents of the description, is an integral part of the Convention (cf. Article 164(1) EPC) and it is clear that any mandatory provisions it contains could only lawfully be disregarded in the case of conflict between the provisions of the Convention and those of the Implementing Regulations: cf. Article 164(2) EPC.
7. Rule 27(1)(c) EPC provides that the description 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 Reports and for the examination, and, preferably, cite the documents reflecting such art."

8. In the decision under appeal, the Examining Division did not contest the appellants' professional representatives' view that the citation of particular documents is a matter of preference and not compulsion. It pointed out, however, that Rule 27(1)(c) EPC requires that the description shall indicate the background art and that this is not a matter of preference.
9. In view of the arguments advanced on behalf of the appellants in this case, it seems desirable that the Board should comment on certain aspects of interpretation of Rule 27(1)(c) and (d) EPC.
10. As a matter of general language, "to indicate" means "to point out" or "to make known". "To cite" means "to mention as example" or "to quote (passage, book, author) in support of a position" (cf. The Concise Oxford English Dictionary, 6th Edition).

These general meanings appear to the Board to be appropriate when applied to Rule 27(1)(c) EPC. Nothing in the French or German texts or in the legislative history of the Rule suggests that other meanings should be given to the terms in question. It follows that the Rule can be re-stated, as a general proposition (subject to exceptions considered below), thus: an applicant must point out or make known the background art known to him (cf. para. 17 below), preferably by mentioning and/or quoting documents which reflect it.

11. The Examining Division held, in effect, therefore, that the appellants were obliged to point out in the description that there existed in the art a proposal for a control circuit for a D.C. motor having certain technical features (namely, those set out in the French patent specification).

12. It is true that, as noted above in paragraph V, in the Examining Division's communication dated 5 December 1980, the requirement was imposed that the French patent specification should be "cited" otherwise there could be rejection of the application. However, the appellants' professional representatives challenged that requirement in their letter dated 30 January 1981, and it does not appear in the decision under appeal.
13. It follows that, for the purposes of the present appeal, there is no relevance in the appellants' arguments directed to an alleged requirement for an "explicit reference" to the French patent specification (Statement of Grounds, paragraph 7) and that citation of prior documents is not required by the Rule (Statement of Grounds, paragraph 8) and cannot be made a reason for refusing a European patent application (Statement of Grounds, paragraph 11). If there were any relevance in those arguments, it would appear to be a complete answer to them that Rule 27(1)(c) EPC expresses a preference for citation which the legislator clearly intended should be complied with unless, in the circumstances of a particular case, this was not possible or was clearly not the best way to indicate the background art.
14. The appellants' professional representatives have argued that it is inconsistent to regard a specification which the Examining Division considered as most relevant to the invention as background art. It is, they assert, the foreground not the background (Statement of Grounds, paragraph 23).

15. What is alleged to be the consequence of this argument is not clear but, as an argument, it must also be rejected. The expression "background art" used in the English text of the Rule is not to be contrasted with "foreground art". The French text of the Rule refers to "l'état de la technique antérieure" and the German text to "der bisherige Stand der Technik". Both from its context in Rule 27(1)(c) and (d) EPC, and from the parallel French and German texts, and also having regard to the definition of "the state of the art" in Article 54(2) EPC, "background art" must have the same meaning as the more familiar expression "prior art". For present purposes it is unnecessary to consider the point further, because the appellants' professional representatives have shown themselves prepared, in their letter dated 6 January 1983, to accept that, for the purpose of the argument on the appeal, the background art is the content of the French patent specification.
16. The argument that Rule 27(1)(c) EPC applies only to the description as filed, must also be rejected. The Examining Division, correctly, considered that this was inconsistent with the provisions of Rule 36(1) EPC, which stipulates that the provisions of Rule 27 EPC shall apply to documents replacing documents making up the European patent application. If, as in the present case, amended claims are submitted, following the issue of the European Search Report and/or as a result of a communication from the Examining Division, it will be necessary to make consequential amendments to the description, in order to ensure inter alia that the amended claims are supported by the description, in conformity with Article 84 EPC. The amended description will be a document replacing a document making up the European patent application and all the provisions of Rule 27 EPC will apply

to it, in application of Rule 36(1) EPC. The argument included in the letter dated 6 January 1983 that Rule 36 EPC "plainly refers and is confined to matters of size, margins and the like in replacement documents" is not consistent with the text of that Rule or of the other Rules referred to therein and must accordingly be rejected.

17. It is also argued that only background art known to the applicant at the time of filing need be indicated in order to comply with Rule 27(1)(c) EPC.

It is contended that once the European Search Report has been drawn up and the examination has been completed, it serves no useful purpose to indicate the background art. However, these propositions are too narrow in scope because Rule 27(1)(c) and (1)(d) EPC refer respectively to "background art which ... can be regarded as useful for understanding the invention" and stating "any advantageous effects, with reference to the background art". The needs of the public to be able to understand the invention and any advantageous effects it may have, from the description, at any time, are recognised in the Rule.

18. The Board does not accept the appellants' professional representatives' arguments in relation to Rule 27(1)(d) EPC any more than it accepts their arguments in relation to Rule 27(1)(c) EPC. The clearly mandatory character of Rule 27(1)(d) EPC has already been recognised by a Technical Board of Appeal in Case T26/81 (Official Journal EPO 1982, 211). In the present case, the appellants are obliged to amend the description so that it discloses the invention as claimed in the amended claims in such

terms that the technical problem and its solution can be understood. The appellants' professional representatives' argument that they are not required to discuss the inventive step - as distinct from the invention - in the description does not assist them to avoid compliance with Rule 27(1)(d) EPC.

19. Rule 27(2) EPC provides, so far as could be material to the present appeal, that the description shall be presented in the manner specified in inter alia Rule 27(1)(c) and (d) EPC unless "because of the nature of the invention" a different manner would afford a better understanding and a more economic presentation. The Board gave the appellants, through their professional representatives, an opportunity to submit arguments in support of their case under Rule 27(2) EPC but no such arguments have been submitted and the Board, having considered the matter of its own motion (cf. Article 114(1) EPC), can find no argument based on Rule 27(2) EPC to justify the appellants' refusal to comply with the Examining Division's request that an indication of the content of the French patent specification should be included in the description, in conformity with Rule 27(1)(c) EPC.
20. It is contended that amending the description to refer to the French specification or to its contents or to state advantages of the present invention as compared with the invention described in the French specification would constitute an addition of "subject-matter" contrary to Article 123(2) EPC. Alternatively, it is argued that there is a serious risk that a national court of a designated Contracting State might hold the appellants'

European patent incurably invalid under Article 138(1) EPC for contravening Article 123(2) EPC. The Board does not accept either of these contentions on the case as it stands at present.

21. Article 123(2) EPC provides that a European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. The expression used is "subject-matter", not "matter". The corresponding expressions in the French and German texts are, respectively, "son objet" and "ihr Gegenstand". Article 84 EPC, which requires the claims to define "the matter for which protection is sought", also uses the expressions "objet" and "Gegenstand" in a related context.
22. On no reasonable interpretation of the expressions "subject-matter", "ihr Gegenstand" (einer europäischen Patentanmeldung), or "son objet" (d'une demande de brevet européen) in the context of Article 123(2) EPC could it be held that the mere addition to a description forming part of a European patent application of a reference to prior art would constitute a contravention of Article 123(2) EPC. Nor is it inevitable that the addition of a discussion of the advantages of the invention with reference to such prior art would constitute a contravention of that Article. Whether it did so would clearly depend on the actual language used and the circumstances of the case.
23. If such language expressly or impliedly extended the matter for which protection is sought, then there would be a risk that the patent granted could be revoked under the law of a Contracting State, with effect for its ter-

ritory, under Article 138(1)(c) EPC. It is clear that the effect of the risk must be reduced by the provisions of Article 138(2) EPC, in accordance with which, if the grounds for revocation only affect the European patent in part, revocation shall be pronounced in the form of a "corresponding limitation" of the patent. In the present case, however, it is not possible to consider this matter further because the appellants have not so far proposed any amendments to their description.

24. In the opinion of the Board, so far as the facts of the case are concerned, it must first be said that the Examining Division correctly assessed the relevance of the cited French patent specification as background art, after having properly considered the arguments put forward in the appellants' professional representatives' letter dated 30 January 1981 (cf. the decision under appeal, page 3).
25. Secondly, it is clear that after having properly considered the relevant submissions in the said letter (cf. the decision under appeal, page 4) the Examining Division correctly held that the unamended description was not in agreement with the amended claims in all essential respects. It is clear that there is a discrepancy between the originally filed description (in particular, page 1) and the amended claim 1 - which purports to acknowledge a state of the art different from that implied in the description. In the opinion of the Board, it is clearly necessary in the circumstances of the case that the description should be amended so that it provides support for the amended claims, in conformity with Article 84 EPC. The amended description must comply with Rule 27 EPC for that purpose.

26. In all the circumstances, the Board must uphold the decision of the Examining Division insofar as it held that the European patent application did not comply with Rule 27 EPC in two stated respects. The Examining Division erred in not calling for amendment of the description in relation to the amended claim 15 before issuing its decision but this error can be rectified by giving the appellants now an opportunity to propose a suitable amendment.
27. However, the appellants were entitled to challenge the views expressed by the Examining Division on points of law which had not previously been considered in their entirety by any Board of Appeal, and it is just that the present case should now be referred back to the Examining Division, in order for the appellants to have the opportunity, if they so desire, of submitting amendments to the description to meet the requirements of this Decision. To that extent, therefore, the decision under appeal will be amended.
28. The last letter from the appellants' professional representatives in the present case concluded by assuming that as certain points raised by them in the Statement of Grounds of the appeal had not been referred to in the Boards' communications, the Board accepted that the appellants were correct on those points. No such assumption should be made. The practice of the Boards of Appeal, underlined by the provisions of Article 12 of the Rules of Procedure of the Boards of Appeal, is to issue communications in order to draw attention to matters which appear to require elucidation, elaboration or reconsideration by the parties before the Board gives its decision.

For these reasons

It is decided that:

1. The decision of the Examining Division dated 20 May 1981 is hereby amended as follows:

The European patent application shall not be refused according to Article 97(1) EPC on the grounds set out in the said decision provided that the applicants offer amendments to the description which in the opinion of the Examining Division meet the objections set out in Part II of the said decision within time limits set by the Examining Division.

2. The European patent application is remitted to the Examining Division for further prosecution.

J. Rbc

Registrar:

G. Korsari

Chairman: