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File No.: T 0746/91 - 3.5.1
Application No.: 84 401 705.3
Publication No.: 0 135 437
Classification: H04L 27/12
Title of invention: Sinusoidal signal generator, the frequency of which is dependent upon a binary signal, in particular for a modem

D E C I S I O N
of 20 October 1993

Applicant: -
Proprietor of the patent: I Texas Instruments France
II Texas Instruments Inc
Opponent: Wandel & Goltermann GmbH & Co.
Headword: -
EPC: Art. 111(1), R. 86(3)
Keyword: "Substantially amended claims filed with statement of grounds of appeal" - "Remittal to Opposition Division"

Headnote
Catchwords



Case Number: T 0746/91 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 20 October 1993

Appellant: Texas Instruments France
(Proprietor of the patent) F-06270 Villeneuve Loubet (FR)

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 23 July 1991 revoking
European patent No. 0 135 437 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: P.K.J. van den Berg
Members: A.S. Clelland
F. Benussi

Summary of Facts and Submissions

- I. This appeal contests the decision of the Opposition Division, dated 23 July 1991, to revoke European patent No. 135 437, which was granted on European application No. 84 401 705.3, following an admissible opposition. The reason given for the revocation was that the subject-matter of the claims of both a main and an auxiliary request did not involve an inventive step having regard to the disclosure of documents cited by the Opponent (Respondent).
- II. In a letter dated 20 September 1991, received 23 September 1991, the patent proprietor (appellant) lodged an appeal against this decision. The prescribed appeal fee was paid. In the grounds of appeal, contained in a letter dated 22 November 1991 and received on 25 November 1991, the appellant filed a revised set of claims and requested that the decision of the Opposition Division be set aside and - implicitly - that the patent be maintained on the basis of the revised claims.
- III. The Respondent requests *inter alia* that the appeal be refused and that he be awarded his costs.
- IV. Claim 1 now reads as follows:

"A sinusoidal signal generator with low harmonic distorsion and programmable frequency, characterized in that it comprises a sequence generator (2) allowing, from a high frequency base clock (1) and programmable dividers, to generate sequences of control signals controlling the generation of a step signal by means of a digital/analog converter (7), said step signal being formed of M steps each including N segments of variable duration corresponding an angular value of the sinusoidal

signal equal to $2\pi/N.M$ and a sampled filter (10) for filtering said step signal, the sampling frequency of said filter being a multiple of the fundamental frequency of the sinusoidal signal in order to filter the step signal harmonics."

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. In the statement of grounds of appeal the appellant states that Claim 1 (of the granted patent) "does not clearly state the features by which the arrangement of the invention patentably distinguishes" over the cited art. The appellant goes on to say that "in order to better illustrate the difference between the invention and the prior art the patentee files new amend(ed) claims enclosed herewith in duplicate It is to be pointed out that the method claims have been withdrawn from this new set of claims."
3. The Board understands this to be an attempt to overcome the grounds for the impugned decision and to mean that the appellant no longer requests that a European patent be granted containing claims as previously considered by the Opposition Division; instead his sole request is that the patent be maintained in amended form on the basis of the claims filed with the statement of grounds of appeal.
4. An examination of the revised claims reveals that all differ substantially from the claims of the granted patent, these being the claims of the appellant's main request in the opposition proceedings. They also differ substantially from the claims of the auxiliary request,

which itself differed from the main request only in having a more limited form of Claim 1. Nor can the present claims be clearly related to the claims of the application as originally filed.

5. Under Rules 57(1) and 58(2) EPC the filing of amendments during opposition proceedings is at the discretion of the Opposition Division, see Decisions T 406/86 (OJ EPO 1989, 302) and T 295/87 (OJ EPO 1990, 470). In accordance with Article 111(1) and Rule 66(1) EPC this discretion may in appeal proceedings be exercised by the Board.
6. In opposition proceedings two conflicting requirements have to be balanced: on the one hand the need to establish as rapidly as possible, in the interests of both the public and the parties to the opposition proceedings, whether or not a patent may be maintained, and on the other hand the need to allow the parties to present their case adequately so that the correct decision can be made. (See "General Principles" applying to opposition procedure, OJ EPO 1989, 417).
7. In the present appeal, substantial amendments were made to the claims at the date of filing of the grounds of appeal, which, if they are admitted to the proceedings, would require further examination in relation to both the formal and substantive requirements of the EPC. In the Board's view, such further examination should be carried out, if at all, only by the first instance after it has decided whether to exercise its discretion. In this way the appellant's right to appeal to a second instance is maintained, both in relation to the exercise of the discretion and (if such discretion is favourably exercised) in relation to the formal and substantive allowability of the claims (see for instance T 63/86, OJ EPO 1988, 224, an *ex parte* appeal).

8. In the present appeal the Board considers that the balance can only be maintained if it exercises its power under Article 111(1) EPC to remit this case to the Opposition Division, in order that it should examine and decide:
 - (a) whether the discretion should be exercised in favour of the appellant; and
 - (b) if the discretion is so exercised, whether the claims comply with the provisions of the EPC.

9. The Board takes this view in the particular circumstances of the present case. The reasons are as follows: firstly, as noted at paragraph 4 above, the amendments to the claims are substantial and require further examination in relation to both the formal and substantive requirements of the EPC, in principle (see paragraph 7) a matter for the first instance; secondly, the opposition proceedings were themselves comparatively rapid and did not involve the holding of oral proceedings, so that the principle of rapid establishment of whether or not a patent may be maintained (see paragraph 6) is not breached; and thirdly, the amended claims were filed with the Statement of Grounds, i.e. at the earliest possible stage of the appeal procedure.

10. In accordance with Article 104 EPC each party to opposition proceedings shall meet the costs he has incurred unless the Board for reasons of equity orders a different apportionment of costs incurred during the taking of evidence or oral proceedings. The Board does not consider that such reasons apply to the present case, so that an order as to costs is not appropriate.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution in relation to the proposed amended claims filed with the statement of grounds of appeal received on 25 November 1991.

The Registrar:

The Chairman:

M. Kiehl

P.K.J. van den Berg