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D E C I S I O N
of 17 October 1994

Case Number: T 0266/92 - 3.5.1

Application Number: 81903038.8

Publication Number: 0067168

IPC: H04N 5/05

Language of the proceedings: EN

Title of invention:

Horizontal Phase Detector Gain Control

Applicant:

MOTOROLA, INC.

Opponent:

Interessengemeinschaft für Rundfunkschutzrechte e.V.

Headword:

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Relevant legal norms:

EPC Art. 107, 112

Keyword:

"Contested decision to detriment of Appellant"

"Reformatio in peius"

"Patent maintained in amended form in accordance with
auxiliary request"

Decisions cited:

G 0004/93, G 0009/92

Catchword:

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Case Number: T 0266/92 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 17 October 1994

Appellant: Interessengemeinschaft
(Opponent) für Rundfunkschutzrechte e.V.
Bahnstrasse 62
D-40210 Düsseldorf (DE)

Representative: Gornott, Dietmar, Dipl.-Ing.
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Respondent: MOTOROLA, INC.
(Proprietor of the patent)1303 East Algonquin Road
Schaumburg, IL 60196 (US)

Representative: Hudson, Peter David
Motorola
Patent and Licensing Operations - Europe
Jays Close
Viables Industrial Estate
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office dated 29 January 1992
concerning maintenance of European patent
No. 0 067 168 in amended form.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: A. S. Clelland
G. Davies

Summary of Facts and Submissions

- I. European patent No. 0 067 168, claiming a priority date of 29 December 1980, was granted on 10 August 1988 on the basis of European patent application No. 81 903 038.8, filed on 28 October 1981.
- II. An opposition was filed on 8 May 1989. The Opponent (Appellant) alleged that the subject-matter of the patent did not involve an inventive step and requested that the patent be revoked in its entirety; an auxiliary request called for oral proceedings to be appointed.
- III. In a letter received on 21 September 1991, in response to a communication from the Opposition Division to both parties suggesting the wording of an independent claim, the Opponent withdrew the request for oral proceedings on the condition that the Patent Proprietor accepted the wording proposed by the Opposition Division. On 8 October 1991, the patent proprietor (Respondent) filed a revised introduction to the description and amended Claims 1 and 6 based on the proposed wording; he requested that the patent be maintained in amended form on the basis of the revised documents.

In a decision dated 29 January 1992 the Opposition Division maintained the patent in the amended form.

- IV. On 26 March 1992 the Opponent lodged an appeal against this decision and paid the prescribed appeal fee. Cancellation of the decision and the revocation of the patent was requested. On 16 May 1992 a statement

setting out the grounds of appeal was filed. The sole ground relied upon was lack of inventive step.

- V. In a communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal, dated 8 April 1993, the Rapporteur expressed the preliminary view that the subject-matter of Claim 1 involved an inventive step.
- VI. On 9 June 1993 the Respondent filed a main request that the patent be maintained as granted. Reference was made to appeal G 9/92, then pending before the Enlarged Board, which is directed to the question of whether a Board of Appeal is allowed to modify a contested decision to the detriment of the Appellant. The Respondent considered that such a modification would be equitable in the present case since, in the first instance, the Opponent (Appellant) had implicitly acquiesced in the proposed amendments to the patent; he had stated that he would withdraw his request for oral proceedings provided the claims were amended, which they subsequently were, and yet the appeal had been filed "in spite of this agreement between the parties". Since the Appellant was free to ask the Board to modify the Opposition Division's decision, it would be inequitable for the Respondent not to be free to make the same request.
- VII. Oral proceedings were held on 15 June 1993. At these proceedings the Appellant requested that the patent be revoked in its entirety, whilst the Respondent requested that the patent be maintained on the basis of the patent as granted (main request) or alternatively

maintained on the basis of Claims 1 to 9 as maintained by the Opposition Division (auxiliary request).

- VIII. In an Interlocutory Decision of 15 June 1993 the Board held that the subject-matter of both requests of the Respondent met the substantive requirements of the EPC, so that the Appellant's request could not be allowed, but that a final decision on whether the Respondent's main request was allowable must be deferred pending the decision of the Enlarged Board in case G 9/92.

Reasons for the Decision

1. As indicated at paragraph VIII above, the Board decided on the substantive issues raised in the present appeal in its Interlocutory Decision of 15 June 1993. The only matter remaining to be decided is that of *reformatio in peius*, i.e. whether the Board is free to grant the Respondent's request that the patent be maintained as granted and thus with broader claims than those allowed by the Opposition Division, leaving the Appellant in a worse position than if he had not appealed at all.

2. This question was decided by the Enlarged Board in Decisions G 9/92 and G 4/93, both dated 14 July 1994. It is observed that the present parties were also parties before the Enlarged Board in Decision G 4/93. Referring to the latter decision at points 15 and 16, the Enlarged Board considered the specific circumstances arising in the present appeal, i.e. where the Opponent has filed an appeal aimed at amending the contested decision either so that the patent is revoked

in full or maintained in a yet more restricted form. The Enlarged Board held that in such circumstances:-

"The patent proprietor, who has not filed an appeal and is therefore only a party to the proceedings under Article 107, second sentence, EPC, does not have the right to file a "cross-appeal" without limit of time. Unlike the rights he would have as appellant, his requests are therefore subject to restrictions. By not filing an appeal, he has indicated that he will not contest the maintenance of the patent in the version accepted by the Opposition Division in its decision. He is therefore primarily limited to defending this version...".

3. The Enlarged Board also stated that any amendments proposed by a Respondent could be rejected by the Board if they did not arise from the appeal.
4. In the present case, the Respondent's main request seeks to restore the patent to the form in which it was granted. This request does not arise as a consequence of issues raised by either the Appellant or the Board and it is accordingly clear from paragraphs 2 and 3 above that the request is inadmissible.
5. The Respondent's only other request is the auxiliary request, namely that the patent be maintained in the amended form agreed with the Opposition Division. As noted at paragraph VIII above, the Board held in its Interlocutory Decision of 15 June 1993 that there are no substantive objections to the claims of this

request. This request is thus in effect a request that the appeal be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg