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D E C I S I O N
of 17 March 1999

Case Number: T 1188/97 - 3.5.2

Application Number: 87904196.0

Publication Number: 0274487

IPC: H01R 31/00

Language of the proceedings: EN

Title of invention:

Local area network interface

Patentee:

The Whitaker Corporation

Opponent:

Pouyet Reseaux D'Entreprise

Headword:

-

Relevant legal provisions:

EPC Art. 84, 111(2), 123(2), 123(3)
EPC R. 88

Keyword:

"Admissibility of amendments (yes)"
"Clarity (yes)"
"Remittal to first instance for further prosecution"

Decisions cited:

G 0009/91

Catchword:

-



Case Number: T 1188/97 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 17 March 1999

Appellant: The Whitaker Corporation
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Respondent: Pouyet Reseaux D'Entreprise
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 October 1997
revoking European patent No. 0 274 487 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: M. R. J. Villemin

Summary of Facts and Submissions

I. The appellant contests the decision of the opposition division to revoke European patent No. 0 274 487 based upon European patent application No. 87 904 196.0 corresponding to international application WO 87/07775 published under the PCT.

The reasons given for the revocation were the following:

- the subject-matter of claim 1 of the main request and the subject-matter of claim 1 of the auxiliary request extended beyond the content of the international application as originally filed (cf. Article 100(c) EPC),
- the subject-matter of claim 1 of the main request was not novel with respect to the BPLS box presented as prior art by the opponent (cf. Article 100(a) EPC in conjunction with Articles 52(1) and 54 EPC) and,
- the subject-matter of claim 1 of the auxiliary request did not involve an inventive step with respect to the prior art BPLS box, as the use of edge cards adapted to directly plug into an edge card connector was well known of the prior art (cf. Article 100(a) EPC in conjunction with Articles 52(1) and 56 EPC).

II. In the following the international application WO 87/07775 published under the PCT (but excluding the amended claims 10 to 14) will be referred to as "the

original application".

III. In response to objections raised by the respondent (opponent) and comments made by the Board, the appellant filed amended claims 1 to 8 as only request in the oral proceedings held on 17 March 1999. Claim 1 is worded as follows:

"A data connector assembly mountable to a wall box (2) for providing an interface to a communications network, comprising

a data connector (200) engageable by a complementary connector (500) for connecting an electronic component to the network, said data connector including an insulating terminal support housing (202) having a front mating face and a rear face and mounting a plurality of terminals (214) having contact portions engageable with the contacts of the complementary connector (500),

shield means (230, 260) at least partially surrounding the terminals (214) and the terminal support housing (202),

an insulating adaptor (300) secured to the data connector and having resilient latch means (306) for attaching the assembly to the wall box (2) for mounting the data connector to the wall box with its front mating face accessible to the complementary connector, and

an edge card extending rearwardly of the data connector and the adaptor and being adapted to plug directly into an edge card connector (150a, 150b) in the wall box and having data traces (284) engageable with terminals of the edge card connector and electrically connected to terminals (214) of the

terminal support housing (202), whereby the assembly is in the form of a plug-in module for the communications network, the resilient latch means (306) attaching the assembly to the wall box when the edge card is plugged into the edge card connector."

Claims 2 to 8 are dependent on claim 1.

IV. The Appellant argued that the thus amended claim 1 was not objectionable under Article 123(2) or (3) EPC and requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of claims 1 to 8 filed in the oral proceedings before the Board.

V. The respondent argued that claim 1 did not comply with Articles 123(2) and 123(3) EPC for the following reasons:

(a) The adaptor 300 was now described as being "secured" to the data connector and not in the "locked configuration" indicated in the original application (last two lines of page 3 to line 2 of page 4).

(b) It was not disclosed in the original application that the attaching means 306 were "resilient" as presently indicated in claim 1.

(c) The present wording at the end of claim 1: "the resilient latch means (306) attaching the assembly to the wall box when the edge card is plugged into the edge card connector" clearly departed from and was not derivable from the wording: "the edge card

being arranged to plug into an edge card connector (150A, 150B) in the wall box in response to attachment of the adaptor to the wall box" as set out in claim 1 of the patent specification.

The respondent further objected that it was not clear that the problem stated in the patent specification could be solved because the amended claim 1 did not mention shielding of the wall box 2, whereas the original application (page 6, lines 28 to 32) specified that the wall box was plated with a metallic coating to shield the entire box.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible
2. *Admissibility of the amendments made in claim 1*

The Board has to fully examine the amendments as to their compatibility with the requirements of the EPC, as explained by the Enlarged Board of Appeal in its decision G 9/91 (OJ EPO 1993, 408), see paragraph 19 of the reasons).

2.1 Admissibility under Articles 123(2) and (3) EPC

Claim 1 now defines a data connector assembly with a data connector including the shield means 230, 260 indicated in the description and claim 1 of the

original application. It is apparent from Figure 7 of this application that this shield means 230, 260 at least partially surrounds the terminals 214 and the terminal support housing 202 of the data connector. This shield means 230, 260 is also mentioned in granted claim 3 of the European patent specification. The mention of shield means 230, 260 in the present claim 1 amounts to an amendment of claim 1 of the patent specification by way of limitation rather than extension of the protection conferred.

An "insulating adaptor" 300 is unambiguously implicitly disclosed in the original application (see for example page 8, lines 12 to 14) and is specified in claim 1 of the patent specification as granted.

As to the respondent's objection mentioned in paragraph V(a) above, the Board observes that the wording "secured to the data connector" indicates nothing more than that "the adaptor is firmly fastened to the data connector" and in the context implies no technical difference compared with a locked configuration indicated in the original application (last two lines of page 3 to line 2 of page 4 and page 11, second paragraph). An insulating adaptor secured to the data connector is specified in claim 1 of the patent specification as granted.

With regard to the respondent's objection mentioned in paragraph V(b) above, it is observed that since the "adaptor 300 is moulded from a plastic material" as disclosed in the original application (page 8, lines 13 and 14), it is reasonable to admit that its attaching means 306 qualifies as "resilient latch means", as

presently indicated in claim 1. This is confirmed by Figure 12 of the original application showing the adaptor 300 in its locked position which can be reached only if the latch means are resilient. This amendment reduces rather than extends the protection conferred.

With regard to the respondent's objection mentioned in paragraph V(c) above, it is noted that the present wording at the end of claim 1: "the resilient latch means (306) attaching the assembly to the wall box when the edge card is plugged into the edge card connector" is supported by the disclosure in the original application, from which it can be unambiguously deduced that the constructional features of the connector assembly are such that the operation of attaching the connector 200 to wall box 2 by means of latch means 306 of adaptor 300 and the operation of plugging the edge card 280 of connector 200 into the edge card connector 150a or 150b occur simultaneously (see in particular Figures 1, 4D, 6, 7 and 9 and page 12, second paragraph). Therefore, the present wording of the last three lines of claim 1 does not contravene Article 123(2) CBE.

The respondent objected that this wording was different and not derivable from the wording: "the edge card being arranged to plug into an edge card connector (150A, 150B) in the wall box in response to attachment of the adaptor to the wall box" as set out in claim 1 of the patent specification as granted and thus did not comply with Article 123(3) EPC. The Board agrees that this wording was not derivable from the wording of claim 1 of the patent specification but is of the opinion that the term "in response to" in claim 1 of

the patent specification as granted was obviously incorrect and misleading in that the operation of attaching the adaptor to the wall box could possibly occur before the operation of plugging the edge card into the edge card connector. However, as explained in the previous paragraph, the two operations have to occur simultaneously. The amended wording of claim 1 renders it clear that the resilient latch means 306 attaches the assembly to the wall box when (that is, at the same time) the edge card is plugged into the edge card connector. This amendment is regarded as a clarification under Rule 88 EPC in the sense that it is immediately evident from the description and the drawings of the original application that nothing else would have been intended than what is offered as the correction. In the light of the description and drawings, the wording at the end of claim 1 of the patent specification would either have to be disregarded as technically meaningless or notionally corrected to mean the same as is now specified at the end of the present claim 1. The present wording contains concrete technical information amounting to an amendment by way of limitation and cannot therefore be considered as extending the protection conferred by claim 1.

2.2 Compliance with Article 84 EPC

In the Board's opinion, the present claim 1 is clear and in particular all the modifications commented on in section 2.1 above comply with Article 84 EPC.

The respondent objected to a lack of clarity in that the problem stated in the patent specification could

not be solved because claim 1 did not recite shielding of the wall box 2.

It can be deduced from the original application that the main problem to be solved by the invention is to provide a system of interconnections compatible for a shielded and an unshielded system (see for example page 2, second paragraph). This application describes the use of shielding means 230, 260 for the data connector 200 as an essential feature of the claimed connector assembly (see for example page 6, last paragraph, to page 8, line 2). It can be seen in Figure 7 that this shield means 230, 260 at least partially surrounds the terminals 214 and the terminal support housing 202. In the Board's opinion, since the present claim 1 mentions this essential feature, the shielded claimed data connector 200 **alone** is able to solve the problem posed by providing an interconnection compatible with a shielded and an unshielded system because a connector suitable for a shielded system is also able to provide a connection for an unshielded system, even if shielding means is not necessary in such a case. The metallic coating of the entire wall box as described in the original application has to be regarded as a non-essential, optional means of additional shielding for the interface between the network and the electronic component, so that no lack of clarity results from the metallic shielding of the wall box not being mentioned in claim 1 submitted to the Board in the oral proceedings.

3. The Board has not examined dependent claims 2 to 8 and the description to see if they are consistent with and adapted to claim 1. Furthermore, patentability under

Articles 52(1), 54 and 56 EPC of the subject-matter of claim 1 was also not examined by the Board. Rather, the Board makes use of its powers under Article 111(1) EPC to remit the case to the opposition division for further prosecution. This has the advantage of giving both partes the possibility of having, in particular, the patentability of the subject-matter of claim 1 examined by two instances.

For avoidance of doubt, it is pointed out that according to Article 111(2) EPC, the opposition division is bound by the present decision only to the extent that it has been decided that the present claim 1 does not contravene Articles 123(2) and (3) EPC and that it complies with Article 84 EPC.

4. Since it is only because of the amendments submitted by the patentee during the oral proceedings before the Board that the decision under appeal is set aside, these amendments may not be retracted in the further prosecution of the case, which, however, does not exclude the possibility of further limitation in view of the prior art, if necessary.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claims 1 to 8 submitted

during the oral proceedings on 19 March 1999, having regard to the remarks in paragraphs 3 and 4 above.

The Registrar:

The Chairman:

M. Kiehl

W. J. L. Wheeler