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D E C I S I O N
of 9 March 2000

Case Number: T 0302/98 - 3.5.1

Application Number: 93200920.2

Publication Number: 0565170

IPC: H04N 5/76

Language of the proceedings: EN

Title of invention:

Apparatus for use in a system for interconnecting appliances

Applicant:

Koninklijke Philips Electronics N.V.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 82

EPC R. 67

Keyword:

"Article 82 - unity - (no)"

"Rule 67 - reimbursement of the appeal fee - (no)"

Decisions cited:

-

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0302/98 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 9 March 2000

Appellant: Koninklijke Philips Electronics N.V.
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Representative: van der Kruk, Willem Leonardus
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 15 January 1998
refusing European patent application
No. 93 200 920.2 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: R. S. Wibergh
S. C. Perryman

Summary of Facts and Submissions

I. This appeal is against the decision of the Examining Division dated 15 January 1998 to refuse European patent application No. 93 200 920.2 on the grounds of lack of clarity of claim 19 (Article 84 EPC) and lack of unity between the subject-matters of claims 1 and 19 (Article 82 EPC).

II. The procedure before the first instance can be summarised as follows.

In its first communication (C1) the Examining Division raised the objection that the subject-matters of claim 1 and claim 12 (which claim formed the basis for the later claim 19) were not linked by a common inventive concept. Furthermore a number of clarity objections were raised, and it was stated that the subject-matters of the independent claims appeared to be derivable from the four documents marked as Y in the Search Report and two further documents. As to the last objection no reasons were given.

In the second communication (C2) the unity objection was maintained. No further comments were made as to an inventive step.

The Applicant (Appellant) filed an amended set of claims, including a new independent claim 19. Some claims - but not claim 19 - contained hand-written amendments.

In a brief third communication (C3) the Examining Division required inter alia that "fair copies of the amendments should be filed", taking account of Rules 36(1) and 35(10) EPC, "in particular with a view to avoiding mistakes in printing any patent which may result from the present application".

In reply, the Appellant filed a completely type-written set of claims.

In the fourth communication (C4) clarity objections were raised against claim 19. The subject-matters of claims 1 and 19 were found not to form unity. It was furthermore said that the documents cited did not seem to be prejudicial to the patentability of claims 1 to 18.

In his reply, the Appellant complained that C3 had conveyed the impression that the application fulfilled the requirements of the EPC. It was not understood why material objections against claim 19 had not been raised already in C3 but only in C4. A new claim 1, containing minor amendments, was filed.

The Examining Division then refused the application.

III. Claims 1 and 19 read (omitting the reference signs):

"1. An apparatus comprising first and second connector means and first and second switching means, the first and second connector means each having a signal input terminal, a signal output terminal and a control signal terminal, the first and second switching means each having first, second and third terminals, the first

terminal of the first switching means being directly coupled to the signal output terminal of the second connector means, the second terminal of the first switching means being directly coupled to the signal input terminal of the first connector means, the first terminal of the second switching means being directly coupled to the signal output terminal of the first connector means, the second terminal of the second switching means being directly coupled to the signal input terminal of the second connector means, the first switching means being adapted to couple the second or the third terminal to the first terminal under the influence of a first control signal, the second switching means being adapted to couple the second or the third terminal to the first terminal under the influence of a second control signal, the apparatus further comprising control signal generator means having a first terminal coupled to the directly interconnected control signal terminals of the first and second connector means, and an output terminal for supplying the first and second control signal for the first and second switching means respectively, the apparatus further comprising third connector means having a signal input terminal, the signal input terminal of the third connector means being coupled to the third terminals of the first and second switching means, the control signal generator means having a second second (sic) terminal for receiving a control signal, and being adapted to generate a switching control signal for at least one of the first and the second switching means, in response to the control signal applied to its second terminal.

19. A control signal generator means for use in the

apparatus as claimed in claim 12, characterized in that it comprises a controller and an input-output circuit comprising a first terminal coupled to the first terminal of the control signal generator means, an input coupled to an output of the controller, and an output coupled to an input of the controller, first low pass filter means being coupled between the input terminal and the first terminal, and diode means being coupled between the first terminal and a first point of constant potential."

IV. According to the appealed decision, the only feature claims 1 and 19 had in common was the "control signal generator means" comprising a "first terminal". A signal generator equipped with a terminal was not a special technical feature in the sense of Rule 30 EPC.

V. In the grounds of appeal the Appellant presented no arguments as to the clarity and unity issues. Instead, the following was submitted:

In C1 the Examining Division had committed a procedural violation by not indicating the closest prior art document but merely referring in general terms to no less than six documents and leaving it to the Appellant to find out by himself which was the closest one. Such a behaviour was against Rule 51(3) EPC which required "any communication pursuant to Article 96(2) EPC to contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent". Moreover, the statement in the decision to the effect that only two documents had been referred to in C1 was incorrect.

In C3 the Examining Division had requested the applicant to produce fair copies of previously filed replacement pages containing hand-written amendments "with a view to avoiding mistakes in printing any patent which might result from the present application". In the appealed decision, however, the Examining Division gave the impression that the hand-written amendments had been illegible and that for this reason examination had had to be resumed. (Actual wording used in the decision: "a fair and legible set of claims 1 to 19 was only filed in response to the third communication... it was therefore only possible for the Examining Division to raise objections against claim 19 at this later stage".) This appeared to be an ex post defence of the Examining Division to support its behaviour, especially considering that claim 19 had not contained any hand-written amendments at all. The Examining Division's attitude during the proceedings was not considered to be based on good faith.

VI. The Appellant requested:

Main request:

- (a) reimbursement of the appeal fee, for the reason that the examining division did not act in good faith and violated Rule 51(3) (a procedural violation),
- (b) reversal of the decision to reject the application, and
- (c) referring the case back to the examining division and instructing the examining division to continue

the examination proceedings in good faith;

Auxiliary request:

- (a) reimbursement of the appeal fee, for the reason that the examining division did not act in good faith and violated Rule 51(3) (a procedural violation),
- (b) reversal of the decision to reject the application, and
- (c) referring the case back to the examining division and instructing the examining division to issue a decision to grant a patent on the documents now on file but excluding claim 19,
- (d) oral proceedings in the event that the board of appeal intended to reject the appeal.

VII. In a communication pursuant to Article 110(2) EPC the Board gave the following preliminary opinion.

As to the main request, the arguments given in the appealed decision in support of the objection under Article 82 EPC appeared convincing. Therefore the main request was not likely to be granted.

On the other hand, the auxiliary request for remittal to the Examining Division on the basis of the amended set of claims would probably be granted since the deletion of claim 19 overcame all the objections which had led to the refusal.

VIII. In respect of the Appellant's submission that the Examining Division had committed a procedural violation by not respecting Rule 51(3) EPC and had not acted in good faith, the following was said in the Board's communication.

It was true that the issue of inventive step was not more than hinted at in C1. It was furthermore clear that an applicant was not required to figure out himself why a claimed invention might not be inventive in respect of one or more of six collectively cited documents. However, the objection raised first in C1 was in respect of non-unity. The nature of this objection was such that, as long as it had not been overcome, no further substantive examination could be performed since it still had to be determined which invention should be examined. This was also expressed in the EPO standard clause reproduced at paragraph I.1 of C1. It would therefore have been possible for the Examining Division not to raise any further objections at all at that stage, in accordance with the Guidelines C-VI 3.6. It was hard to see how an examining division could be criticised for giving a preliminary opinion on the patentability of the different subject-matters. Some applicants might appreciate this as it could assist them in limiting the application. An applicant who was of the opinion that such hints were not helpful was naturally free to ignore them.

Furthermore, in C3 only formal objections had been raised, based on Rule 36(1) and Rule 35(10) EPC. It was agreed that these objections appeared largely pointless; the replacement pages which had been filed in reply to C2 were believed to have been in a form

which was normally accepted by the EPO. Since no fundamental objections were mentioned in C3, in particular under Article 82 EPC, it was understandable that the Appellant got the impression that grant was envisaged and that he was later surprised at the objections raised in C4. This was unfortunate but hardly represented a procedural violation.

The Appellant had furthermore complained that it was suggested in the decision that the claims filed in reply to C2 were illegible. The Board agreed that the claims had not been illegible. This statement in the decision under appeal was surprising in the circumstances.

Considering, with the benefit of hindsight, the whole procedure before the first instance it appeared that it would have been better if the Examining Division had raised only the non-unity objection and had been prepared to base an early refusal on it.

IX. With letter dated 27 August 1998 the Appellant withdrew his request for oral proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. The Appellant's main request (see point VI above)
 - 2.1 The Board understands the Appellant's main request as meaning that the Examining Division's decision be reversed because of a substantial procedural violation

and to remit the case to the examining division to continue the examination proceedings. In this context the Board would like to point out that the Appellant had ample opportunity to comment on the objections raised by the Examining Division under Articles 84 and 82 EPC, so that the requirements of Article 113(1) EPC have been met. Furthermore, there was no request for oral proceedings which might have been overlooked. Thus the Examining Division committed no substantial procedural violation because of which the Board would have to set aside the decision under appeal.

Although the Board may well understand that the Appellant was dissatisfied with some aspects of the procedure as well as with certain parts of the decision, it appears sufficient in the circumstances to refer to the comments made in the Board's communication (see point VIII above).

No substantial procedural violation having been committed, reimbursement of the appeal fee has to be refused.

- 2.2 Apart from this it should be noted that the statement setting out the grounds of appeal is concerned with procedural matters, but contains no grounds as to why the decision under appeal would be wrong in substance.

The decision was based on lack of unity between the subject-matters of claims 1 and 19 (Article 82 EPC) and lack of clarity of claim 19 (Article 84 EPC).

Limiting itself to the unity issue, the Board finds the arguments given in the decision (see point IV above)

convincing, as already pointed out in its communication, and thus also on substantive grounds sees no reason to set aside the decision under appeal.

Since there are no sufficient grounds for setting aside the decision under appeal, also remittal to the Examining Division under the main request has to be refused. It follows that the main request has to be refused in toto.

3. *The auxiliary request (see point VI above)*

- 3.1 The Appellant requests the reversal of the decision to reject the application and referring the case back to the Examining Division and instructing the Examining Division to issue a decision to grant a patent on the documents now on file.

As far as this request is based on the substantial procedural violation alleged to have been committed by the Examining Division, also the auxiliary request has to be refused for the same reasons which have been given hereinbefore in this respect for the refusal of the main request. This also applies to the reimbursement of the appeal fee: Such reimbursement has to be refused under the auxiliary request for the same reasons as it was refused hereinbefore under the main request.

- 3.2 However, according to the auxiliary request claim 19 is deleted. The deletion restores unity and moreover has the effect that the part of the decision under appeal which deals with clarity no longer applies.

As to the Appellant's request that the Examining Division be instructed to grant a patent, it is noted that the decision under appeal only concerns the provisions under Articles 82 and 84 EPC, examination with regard to the other requirements of the EPC obviously not yet having been carried out.

In these circumstances the Board thinks it appropriate to preserve for the Appellant the right to examination in two instances also with regard to said other requirements of the EPC. The case is therefore remitted to the Examining Division with the instruction to continue the prosecution and in particular to continue the examination.

The auxiliary request is therefore allowable to the extent of setting aside the decision under appeal and remitting the case to the Examining Division for further prosecution on the basis of claims 1 to 18 and the other patent application documents now on file.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The Appellant's main request is refused.
3. The case is remitted to the first instance for further prosecution on the basis of claims 1 to 18 and the other patent application documents now on file in accordance with the Appellant's auxiliary request.

4. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg