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D E C I S I O N
of 21 January 2004

Case Number: T 0056/01 - 3.5.1

Application Number: 97918633.5

Publication Number: 0894402

IPC: H04N 7/173

Language of the proceedings: EN

Title of invention:

A method and system to transmit video/data signals from a device to a communications network connection card

Applicant:

BellSouth Intellectual Property Corporation

Opponent:

-

Headword:

Network connection card/BELLSOUTH

Relevant legal provisions:

EPC R. 29(2)

Keyword:

"Plural independent claims in the same category (no)"

Decisions cited:

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Catchword:

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Case Number: T 0056/01 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 21 January 2004

Appellant: BellSouth Intellectual Property Corporation
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Wilmington, DE 19801 (US)

Representative: Hogg, Jeffery Keith
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 31 July 2000
refusing European application No. 97918633.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: W. E. Chandler
V. Di Cerbo

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division to refuse the application on the ground that the subject-matter of independent claims 1 and 22 did not meet the requirements of Article 56 EPC.
- II. The appellant (applicant) lodged an appeal against the decision and paid the prescribed fee. The appellant requested that the decision under appeal be set aside and a patent granted on the basis of:
A main request, filed with the grounds of appeal, comprising a new set of claims 1 to 17;
A first auxiliary request, subsequently filed in a "supplemental grounds of appeal", comprising new claims 1 to 16; and
A second auxiliary request, filed in the "supplemental grounds of appeal", comprising new claims 1 to 17.
- III. In a communication under Article 11(1) of the Rules of Procedure of the Boards of Appeal, sent together with the summons to oral proceedings under Article 116 and Rule 71(1) EPC, the Board informed the appellant that whilst it was allowable to file new claims at the appeal stage in an attempt to overcome the findings of the impugned decision, the new claims in the appellant's three requests did not appear to serve this purpose.

In particular, the nature of the independent claims was discussed. It was pointed out that the refused application contained two independent claims, a claim to a signal transport system and a claim to a corresponding method. However, each of the appellant's

requests in the appeal contained three independent claims in the same category: a new claim to a broadband communications module and two new claims to a signal transport system. It was stated that these claims did not even meet the requirements of Rule 29(2) EPC since the subject-matter of the claims to the signal transport system was essentially for the same system.

Regarding the content of the claims, the Board pointed out that at least one of the claims in the main and first auxiliary request did not contain the feature of the "separate" paths, which was present in the refused claims and which appeared to be the pivotal point in the reasoning for overturning the decision. This threw into doubt why the appellant regarded the decision under appeal as wrong, and, indeed, the relevance of most of the arguments in the grounds of appeal.

It was also stated that the appellant had offered no explanation for this choice of claims, and had given no explanation for the origin of the amendments.

Finally, it was stated that in order to avoid discussing claims that the appellant did not intend to maintain, the Board considered it to be in the interest of procedural economy to hold oral proceedings to decide the case. The appellant was requested to consider the previously mentioned deficiencies, and to provide a clear explanation of any requests.

Notwithstanding, all of the above, the Board made an attempt to identify the issues of patentability that might have needed to be discussed at the oral proceedings.

IV. The appellant did not respond to the summons, but, in a fax that arrived at the Board's registry on the morning of the oral proceedings, the representative informed the Board that he would not attend the oral proceedings and requested that the Board make a final decision on the basis of the submissions made up to that point.

V. The oral proceedings took place in the appellant's absence.

VI. Independent claim 2 of the main request reads as follows:

"A signal transport system for the delivery of video signals to a plurality of devices (16), for the return of modulated analog signals from at least one of the plurality of devices, converting the modulated analog signals into digital signals, and transmitting the digital signals to a signal destination (34), comprising:

 a video signal source (10) operable for generating a plurality of video signals;

 a broadband communications module (14) operable for:

 receiving the plurality of video signals;

 transmitting the video signals to at least one device; and

 receiving the modulated analog signals having digital content from at least one device;

 a downstream path for carrying the electric video signals to the broadband communications module;

 an interface (30) for converting the analog signals to digital signals;

an optical network unit (32) operable for converting the digital signals from the interface into optical signals; and

an upstream path connected to the optical network unit for carrying the optical signals to the signal destination."

Independent claim 9 of the main request reads as follows:

"A signal transport system for the delivery of video signals in a downstream path to a plurality of devices (16), for the return of modulated analog signals having a digital content from at least one of the plurality of devices (16), and transmitting the modulated signals in an upstream path separate from the downstream path, through an optical network (32) to a signal destination (34), comprising:

a video signal source (10) operative for generating video signals to be transmitted over the downstream path;

an optical transmitter (12), operable for converting the video signal into an optical video signal, and transmitting the optical video signal over the downstream path; and

a broadband communications module (14) comprising:

an optical receiver (40) operable for receiving the optical video signals from the optical transmitter on the downstream path and converting the optical video signal to an electrical video signal;

a filter (42) operable for filtering the electrical video signal;

a coaxial cable interface (44) operable for transmitting the electrical video signal to a plurality

of devices (16) and receiving the return modulated analog signals having a digital content from the at least one device and transmitting the return analog signals to the filter; and

a converter (46) operable for converting the modulated analog signal into a digital signal and transmitting the converted signal to an optical network unit (32) for transmission of the digital signal to the signal destination through the upstream path."

Claim 2 of the first auxiliary request adds to claim 2 of the main request the features of the coaxial cable interface and a filter. Claim 8 of the first auxiliary request corresponds to claim 9 of the main request.

Claims 2 and 9 of the second auxiliary request add to claims 2 and 8 of the first auxiliary request the features of a transmission line and a separate "optical or communications network or the like".

Reasons for the Decision

1. The appellant has had, in accordance with Article 113(1) EPC, an opportunity to present its comments on the objection to the new claims under Rule 29(2) EPC, but has not availed itself of this opportunity. Under these circumstances, the Board can consider the issue of admissibility under the above-mentioned provision in order to decide on this case notwithstanding the appellant's absence at the oral proceedings.
2. According to the decision of the Administrative Council of 13 December 2001 amending Rule 29(2) EPC (OJ EPO

2002, 2), the amended Rule entered into force on 2 January 2002 and applies to all European patent applications in respect of which a communication under Rule 51(4) EPC has not yet been dispatched by that date. Since the present appeal concerns an application that has been refused, and hence for which there has not been a communication under Rule 51(4) EPC, the amended rule applies.

3. Amended Rule 29(2) EPC specifies that, without prejudice to Article 82, a European patent application may contain more than one independent claim in the same category (product, process, apparatus or use), only if the subject-matter of the application involves one of the following:

- (a) a plurality of inter-related products;
- (b) different uses of a product or apparatus;
- (c) alternative solutions to a particular problem, where it is not appropriate to cover these alternatives by a single claim.

4. The Board judges that claims 2 and 9 of the main and second auxiliary request and claims 2 and 8 of the first auxiliary request do not fulfil any of the conditions (a) to (c) above.

4.1 At first sight it would appear that condition (a) could not cover the present case of claims to a signal transport system (apparatus) because it mentions only inter-related "products", and a distinction is made between products and apparatus in the opening part of the Rule.

However, an early proposal to the Administrative Council for the amendment of Rule 29(2) EPC, document CA/128/01 Rev. 1, explains what was meant by inter-related "products" by giving the following examples (see page 2, point 6):

- plug and socket;
- receiver - transmitter;
- intermediate(s) and final product;
- gene - gene construct - host - protein - medicament.

These examples were subsequently incorporated into the December 2003 version of the Guidelines for Examination at C-III, 3.2.

Since claims to a plug and a socket or to a transmitter and a receiver are apparatus claims, the Board concludes that inter-related "products" is meant to include apparatus claims, and hence system claims.

However, the Board does not consider that condition (a) applies to the two apparatus (product) claims for the signal transport system in the present case because they are not inter-related. It can be inferred from the examples that inter-related products are meant to be different objects that complement each other, or somehow work together. However, in the present case, the two different claims to the signal transport system are for essentially the same object and not for objects that work together. Hence, the Board judges that they are not inter-related products.

- 4.2 Condition (b) does not apply either because the claims are not for uses of a product or an apparatus.
- 4.3 Condition (c) allows claims that are "alternative solutions to a particular problem". However, the claims to the signal transport system overlap considerably despite the slightly different wording of many of the common features. The Board does not judge that these claims relate to "alternative" solutions in the sense of different or even mutually exclusive possibilities, but to one and the same solution with slightly different wording and level of detail.

Moreover, even "alternative" solutions are only allowed under the condition that "it is not appropriate to cover these alternatives by a single claim". The crucial question is when is it "not appropriate"? The examples given in CA/128/01 Rev. 1 are of no direct help in answering this question because they concern chemical claims, namely:

- a group of new chemical compounds;
- two or more processes for the manufacture of such compounds.

However, the idea of "not appropriate" was initially expressed in CA/128/01 Rev. 1 as "not possible or not practical" in a list of justifiable exceptions and examples. This list was destined for the Guidelines for Examination, but was subsequently split, in CA/128/01 Rev. 2, into the exceptions, which went into the Rule (with "not possible or not practical" replaced by "not

appropriate"), and the examples, which went into the Guidelines. Nevertheless, the intention was that if it is possible to cover alternative solutions by a single claim, then the applicant should do so.

This also follows from the reasons given for amending Rule 29(2) EPC. CA/128/01 Rev. 1 states (see page 1, point 1; page 2, point 5; page 3, point 7) that the amount of work involved in examining an application is highly dependent on the number of independent claims, and that the aim of the amendment to the Rule was to reduce the room for interpretation and avoid lengthy substantive argument.

The Board can appreciate the desirability of this objective. Overlapping independent claims indeed cause lengthy substantive argument since each different combination and/or different wording of features normally requires a separate analysis of patentability. Of course, if this work is necessary, then it has to be done, but the Board judges the thrust of the reasoning to be that the work has to be done only if it cannot be avoided, which is how the idea of "appropriate" in the amended Rule is to be interpreted.

In the present case, the Board does not see any reason why it should not be possible, practical, or otherwise not be appropriate to cover the subject-matter of the signal transport system by a single independent claim. Given the above-mentioned overlap and similarities in the features of the claims, the Board judges that it would have been entirely appropriate to select a common wording for the essential features of the alleged invention and to have drafted a single independent claim with dependent claims as necessary.

5. The final version of CA/128/01 (i.e. CA/128/01 Rev. 2) makes it clear (see page 2, point 6) that the amendment to Rule 29(2) EPC should have the effect of shifting the burden of proof onto the applicant. Thus when an objection under Rule 29(2) arises, it is up to the applicant to argue convincingly why additional independent claims can be maintained. In the present case, however, the applicant made no substantive reply to the points raised in the communication and did not attend the oral proceedings.

6. Since none of the requests filed in the appeal are judged to meet the requirements of Rule 29(2) EPC, none of the requests are admissible and the appeal is dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

S. Steinbrener