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D E C I S I O N
of 27 September 2005

Case Number: T 0133/02 - 3.5.1
Application Number: 94931667.3
Publication Number: 0744053
IPC: G06F 12/06, H04L 12/28
Language of the proceedings: EN

Title of invention:
Ranking-based address assignment in a modular system

Applicant:
Koninklijke Philips Electronics N.V.

Opponent:
-

Headword:
Address assignment/PHILIPS

Relevant legal provisions:
EPC Art. 83, 84, 96(2), 111(1), 113(1), 123(2)
EPC R. 29(1)(2)(3), 67
RPBA Art. 10

Keyword:
"Conciseness of claim set comprising two apparatus claims relating to a system and a component of the system (yes)"
"Opportunity to comment on all the reasons for the decision (no)"
"Substantial procedural violation (yes)"
"Remittal to department of first instance (yes)"

Decisions cited:
T 0951/92, T 0410/96, T 1194/97

Catchword:
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Case Number: T 0133/02 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 27 September 2005

Appellant: Koninklijke Philips Electronics N.V.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 April 2001
refusing European application No. 94931667.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: K. J. K. Bumés
G. E. Weiss

Summary of Facts and Submissions

I. The appeal lies from the decision of the Examining Division to refuse European patent application No. 94931667.3. The decision refers *inter alia* to

D1: EP-A-0 493 905.

II. *Procedure before the Examining Division*

(a) In a single substantive communication pursuant to Article 96(2) and Rule 51(2) EPC, the Examining Division objected to the presence of three independent apparatus claims (control system claim 1, control means claim 6 and module claim 7) which it found to contravene the requirements of conciseness and clarity laid down in Article 84 EPC. (While the European application originates from a PCT application, there was no international preliminary examination prior to entry into the regional phase before the EPO. Hence, the abovementioned communication was indeed the only substantive communication to the applicant.)

In view of prior art document D1 which it considered novelty defeating, the Examining Division announced that any attempt to delimit the invention from D1 by means of a disclaimer would have to meet two conditions: The original basis of the disclaimer would have to be identified, and any amended independent claim would have to define an alternative feature essential for fulfilling the function of the (omitted) disclaimed feature even though no such alternative feature was

apparent to the Examining Division from the application as filed. The last paragraph of the communication invited the applicant to indicate on which part of the application any amendment to be filed would be based (Article 123(2) EPC).

- (b) With a letter of reply, the applicant filed amended claims 1 to 9, referred to original passages on which the amendments were said to be based, and set out reasons why in his view the amended claims complied in particular with the requirements of Articles 84 and 123(2) EPC. An apparatus claim 1 relating to the control system and an apparatus claim 6 relating to a control means for use in the system were maintained, whereas the original module claim 7 was deleted.
- (c) Thereafter the application was refused on the ground that the claim set lacked conciseness and clarity because two apparatus claims, claims 1 and 6, were considered as separate independent claims relating effectively to the same subject-matter.

Another ground for the refusal was that the amended characterising part of claim 1 introduced subject-matter beyond the content of the application as filed, contrary to Article 123(2) EPC. The decision discussed and dismissed the passages on which the applicant had based his amendments.

(d) The refused claims 1 and 6 read:

"1. A control system (100) comprising

- a plurality of modules (102, 104, 106), each particular one thereof including identification means (110, 112, 114) for representing a particular number to enable identification of the particular module;
- control means (108) being operative to control assignment of respective addresses to respective ones of the modules for access to the modules and being operative to carry out an assignment of the respective addresses to respective ones of the modules on the basis of the particular numbers, the control means comprising:
 - a) - determining means for determining a plurality of mutually exclusive number ranges, each respective one containing a respective single one of the particular numbers, the determining means including:
 - i) - stimulating means for stimulating each respective one of the modules to respond if its respective particular number lies in a specific range of numbers; and
 - ii) - altering means for altering the specific range if none or more than one of the modules responds;
 - b) - specifying means for specifying the respective addresses on the basis of the specific ranges found and carrying out the assignment, characterized in that the specifying means specify the respective addresses exclusively on the basis of the specific ranges found and in that none of the modules transmits its particular number at any

stage during the assignment of the respective addresses."

"6. Control means for use in the system of claim 1."

- (e) Claim 7 is an independent method claim corresponding to system claim 1.

III. The appellant requests that the decision under appeal be set aside and a patent be granted on the basis of the refused claims (claims 1 to 9 filed with letter of 6 November 2000). He argues that the adopted form of claims reflects a usual practice in European patents, and reiterates passages of the description as an original basis for the features of the characterising portion of amended claim 1. Oral proceedings are requested on an auxiliary basis.

IV. In a communication to the appellant, the Board expressed its preliminary view that the Examining Division might not have given the applicant an appropriate opportunity to present his comments on the specific grounds of refusal relating to Article 123(2) EPC, contrary to the requirements of Article 113(1) EPC. The Board referred to Article 10 of the Rules of Procedure of the Boards of Appeal (RPBA) according to which a case shall be remitted to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

The Board drew the appellant's attention also to Article 111(1) EPC according to which the Board would

be able to exercise any power within the competence of the Examining Division. That power would include an examination of the application as to the requirements of novelty and inventive step, in particular in view of the fact that some prior art discussion had taken place before the Examining Division even though some documents cited in the Search Report (notably US-A-4 667 193) had not been considered yet.

- V. The appellant informed the Board that he was not aware of any special reason for not remitting the case to the Examining Division.

Reasons for the Decision

1. *Teaching of the application as filed*

A control means is linked to a limited number of modules, each module having a long ID number ("particular number"). Instead of addressing the modules by their long ID numbers, the control means initialises the system by

- (a) finding out how many modules are linked to it (inventory step), and then
- (b) providing each module with a new address which can be relatively short (assigning step).

The control means finds the modules and creates the inventory by (sub)dividing and interrogating address ranges until only one module per address range responds. In that process, the modules do not have to

transmit their ID numbers; they just reply / do not reply when their address is / is not in a range currently interrogated by the control means.

The initial disclosure of this aspect is summarised on page 2, lines 25 to 29 of the application as filed and published (WO-A1-95/14972 = "A1" hereinafter): An inventory is made, i.e. the number of modules in the system is determined (see A1, page 6, lines 22 to 24, for example), and that inventory enables the control means to create the required number of addresses of appropriate width (preferably as short as possible, see A1, page 9, line 12).

The inventory is made without the modules transmitting their ID numbers to the control means (A1, page 2, lines 27/28).

The specifying step disclosed by A1 is based on the ranges found (page 2, lines 23 to 27), more precisely on the number of ranges found (page 6, lines 20 to 29), and preferably selects the shortest possible address to represent that number of ranges (page 9, lines 11 to 13).

2. *The decision under appeal*

2.1 Article 84 EPC

In a short introductory paragraph, the Examining Division regards claims 1 and 6 as two independent claims in one category which are said to deprive the claim set of conciseness because claims 1 and 6 "appear to relate effectively to the same subject-matter".

Moreover, a lack of clarity of the claims as a whole is said to arise "since the plurality of independent claims makes it difficult, if not impossible, to determine the matter for which protection is sought, and places an undue burden on others seeking to establish the extent of the protection" (point II.1 of the decision).

2.2 Article 123(2) EPC

The focus of the decision under appeal lies on the fact that the application (including the initial claims) is silent on what the modules transmit or do not transmit during the address assignment step performed by the control means. Unlike the applicant, the Examining Division does not see any original basis for the disclaiming amendment (in the characterising portion of claim 1) that none of the modules transmits its particular number "at any stage during the assignment" of the respective addresses.

- (a) According to a first argument of the Examining Division (point II.2.1 of the decision under appeal), a description of the behaviour of the prior art (A1, paragraph bridging pages 1/2) does not imply that features missing from a cited document are present in the application.
- (b) Point II.2.2 of the decision under appeal states that A1 is explicit only in relation to the inventory stage: The inventory is made without the modules transmitting their ID numbers to the control means (A1, page 2, lines 25 to 29).

- (c) Point II.2.3 of the decision qualifies three passages cited by the applicant (A1, page 2, lines 28/29; page 3, lines 4 to 6; page 6, lines 23/24) as irrelevant as they are silent on a transmission of particular numbers.

- (d) Point II.2.4 of the decision relates to the characterising feature (of amended claims 1 and 7) that the addresses are specified "exclusively" on the basis of the specific ranges found. The insertion of the word "exclusively" is considered to be in conflict with the application as originally filed.

- (e) Point II.2.5 of the decision can be summarised as follows: The system according to claim 1 differs from D1 in that the modules do *not* transmit their ID numbers ("particular numbers") to the control means. Hence, in a special situation described in D1 (column 3, line 54 to column 4, line 9), the control means ("SIU" in D1) may not notice whether two modules ("slaves") happen to have the same ID number ("DLA"). As the system of claim 1 under consideration does not comprise means for resolving such a potential conflict, the applicant's arguments in support of a basis in the originally disclosed subject-matter are said to be inconsistent.

3. *Right to be heard*

According to Article 113(1) EPC, the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an

opportunity to present their comments. A ground is not merely the relevant provision of the EPC (e.g. the number and wording of Article 123(2) EPC) but is to be understood as the essential legal and factual reasoning which leads to the refusal of the application (see e.g. T 951/92, OJ EPO 1996, 53).

In the present case, the decision under appeal is in substance based on two different grounds, viz. lack of clarity and conciseness of the amended claim set and non-compliance of amended claim 1 with Article 123(2) EPC (but see also point 4.2 below). If a decision is based on plural grounds (as opposed to one ground followed by *obiter dicta*), then Article 113(1) EPC requires that the parties concerned must have had an opportunity to comment on all of the grounds.

3.1 The conciseness and clarity objections in the decision under appeal (point II.1) are substantiated essentially like in the Examining Division's preceding communication (item 2.2). Although the applicant had made an effort in this respect by deleting the third apparatus claim, it may be said that he had an opportunity to comment on those objections and - from the Examining Division's point of view - did not fully overcome them. Hence, the Board accepts that Article 113(1) EPC is not infringed by that part of the decision.

3.2 Conversely, most of the Examining Division's specific arguments under Article 123(2) EPC in respect of amendments to the claims have been put forward for the first time in the decision under appeal. It is true that the preceding substantive communication included a

precautionary warning as to the requirements of Article 123(2) EPC, asking the applicant to identify original passages in support of potential amendments to be filed (item 3.1.1 and the very last paragraph of the communication). It is further true that part of the applicant's amendments (disclaimer) indeed went in the direction anticipated by the Examining Division's communication. However, when the applicant's reply presented supporting passages and detailed arguments, the Examining Division dismissed them in a specific counterargumentation which was not foreseeable on the basis of the Examining Division's communication.

- (a) Point II.2.1 of the decision under appeal does not have any counterpart in the Examining Division's preceding communication.
- (b) Point II.2.2 of the decision has a very general precursor in the form of items 3.1 and 3.1.1 of the communication, asking the applicant to identify the original basis of a potential amendment (disclaimer).
- (c) Point II.2.3 of the decision has no counterpart in the communication.
- (d) Regarding point II.2.4 of the decision, an address specification based "exclusively" on specific ranges was not defined in the initial claims and the Examining Division neither anticipated its inclusion in a claim nor commented on it otherwise in the communication.

(e) While in fact relating to another ground for refusal (insufficiency of disclosure, see point 4.2 below), point II.2.5 of the decision is the only argument which can be considered to have been briefly elaborated in the preceding communication (item 3.1.2).

Therefore, the applicant had an opportunity to comment on it and indeed used that opportunity (letter of reply, page 2: "Regarding the observation by the examiner under 3.1.2 of the communication ..."). The Board thus accepts that this part of the Examining Division's reasoning meets the requirements of Article 113(1) EPC.

3.3 However, insofar as the applicant was confronted with reasons for the first time in the decision under appeal, he was not in a position to deal with them before the application was refused. Hence, in the Board's judgment, the Examining Division's streamlined course of action did not offer the applicant a fair opportunity to comment on, or react to, the grounds on which the decision was based in respect of Article 123(2) EPC.

In the procedural situation reached after the applicant's reply, it would have been appropriate to issue a second substantive communication according to Article 96(2) and Rule 51(2)(3) EPC, or to summon the applicant to oral proceedings before the Examining Division according to Article 116(1) EPC.

4. *Comments on the substance of objections raised*

- (a) Insofar as the Examining Division's objections may be seen to comply with the requirements of Article 113(1) EPC (see points 3.1 and 3.2(e) supra), the Board makes the following comments on the substance of those objections.

4.1 Clarity and conciseness (Article 84 EPC)

- (a) In the Board's judgment, the coexistence of one system claim (claim 1) and one means claim (claim 6) relating to a component of the system does not render the current claim set as a whole inconcise or unclear. An applicant's interest in claiming both a system and a component of the system is legitimate and does not place an undue burden on the public or competitors reading the two claims in one category. On the contrary, the system claim puts the reader in an overall picture and, thus, allows him to understand the component claim more easily.

The Examining Division's assessment of claims 1 and 6 ("same subject-matter") is not shared by the Board. A control system and a control means for use in the system may be based on one invention but constitute two different entities. They are inter-related products, similar to a plug and a connection system combining the plug with an adapted socket.

Since the control means of claim 6 is entirely contained in the system of claim 1, a literal

construction of Rule 29(4) EPC does not exclude that claim 1 may be regarded as a dependent claim with the result that the Examining Division's objection to dual independent apparatus claims would be void *ab initio* as there would be only one independent apparatus claim (claim 6).

Conversely, if claims 1 and 6 were to be considered as two independent apparatus claims, Rule 29(2)(a) EPC would apply according to which a European patent application may (without prejudice to Article 82 EPC) contain more than one independent claim in the same category if the subject-matter of the application involves a plurality of inter-related products. As pointed out above, the Board holds that a control system and a control means for use in the system generally constitute inter-related products.

It may be added that Rule 29(2) EPC in its current wording entered into force on 2 January 2002. It applies to all European patent applications in respect of which a communication under Rule 51(4) EPC has not been despatched by 2 January 2002 (OJ EPO 2002, 2). This is the case for the application under consideration. The Examining Division rendered its decision on 18 April 2001 and, thus, could not be aware of the current wording of Rule 29(2) EPC. However, it is clear that the Examining Division objected to claims 1 and 6 because it considered the control system and the control means to relate effectively to the "same subject-matter". Hence, even from the Division's standpoint, it would be illogical to

simultaneously regard the subject-matter of the claims as unrelated to each other.

Consequently, the Board sees no reason to consider the current claim set as a whole to be inconcise or unclear.

- (b) Looking at claim 6 on an individual basis, the formulation of that claim is particularly short ("Control means for use in the system of claim 1") and, thus, gives rise to the question of whether or not it is clear what technical limitations on the control means result from the reference of claim 6 to claim 1.

The Board notes previous decision T 410/96 (not reported in OJ EPO) which held that a short system claim referenced to a claim of different category ("Data processing system comprising means for carrying out the steps of the method according to anyone of the claims 1 to 5") may, at least in principle, be allowable under Article 84 in combination with Rules 29(1) and (3) EPC (points 7 to 13). That finding applies *a fortiori* to a claim (like present claim 6) which is referenced to a claim of the same category.

T 1194/97 (OJ EPO 2000, 525) dealt with a claim to a record carrier "for use" in a system comprising the record carrier. The "for use" clause was found to explain, by reference to the system claim, the rationale underlying the invention and, thus, to clarify and limit the record carrier for which

protection was sought (see point 2 of the reasons, in particular point 2.2).

In the present case, claim 1 sets out a system comprising modules and control means and the interaction thereof. The control means are defined in detail in claim 1, and claim 6 seeks to protect control means for use in the system, which clearly requires the control means to be arranged according to the control means specification of claim 1.

In conclusion, the Board considers claims 1 and 6 as clear and concise.

4.2 Sufficiency of disclosure (Article 83 EPC)

Without mentioning Article 83 EPC, the Examining Division effectively raised an insufficiency objection by stating that the application failed to disclose means for enabling the claimed system to operate correctly when the modules do not return their respective ID numbers to the control means (item 3.1.2 of the communication; point II.2.5 of the decision under appeal). For example, when the ID numbers (particular numbers) are generated at random, there is no safeguard against duplicate random numbers (point II.2.5.4 of the decision).

In his letter of reply to the Examining Division's communication, the applicant argued (page 2, penultimate paragraph) that the technical problem emphasised by the Examining Division existed only in particular embodiments or was virtually inexistent

because it was unlikely for two modules to have a same particular number. Even if such a conflict happened to arise, it would be resolved by re-executing the assignment procedure as described on page 3, lines 19 to 22 of A1.

In the Board's judgment, the aforementioned resolution of an address conflict is plausible. In any event, it is plausible that the risk of two modules having a same long ID number is low in practice. Moreover, in most cases it will be possible to analyse a claimed technical teaching and construe singular weaknesses thereof in hypothetical circumstances, but that does not prevent protection of a general technical solution. The EPC does not generally require an applicant to claim the best mode for carrying out the invention. A claim covering isolated hypothetical inferior embodiments may be vulnerable to prior art attacks if the non-obviousness of the claimed matter hinges on a particular technical advantage to be achieved in the whole range claimed, but such a claim is not automatically disqualified under sufficiency aspects.

The Board thus considers the application to meet the requirements of Article 83 EPC in respect of claim 1.

5. *Remittal to the department of first instance*

According to Article 10 RPBA, a Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise. An infringement of the right to be heard (Article 113(1) EPC) constitutes a fundamental

procedural deficiency. The appellant has not expressed any reason for not remitting the case, and the Board judges that further substantive discussion before the Examining Division is appropriate for the case to mature into a decision meeting the requirements of the EPC, notably Article 113(1).

Therefore the case is remitted for further prosecution as provided for in Article 111(1) EPC, without the Board considering the open issues (e.g. under Article 123(2) EPC) at this stage.

6. *Reimbursement of the appeal fee*

Where the Board of Appeal deems an appeal to be allowable, the reimbursement of the appeal fee shall be ordered if such reimbursement is equitable by reason of a substantial procedural violation (Rule 67 EPC).

The present appeal is allowable at least in part in that the decision is set aside and the case is remitted.

According to established case law, an infringement of the right to be heard (Article 113(1) EPC) is considered as a substantial procedural violation justifying a reimbursement of the appeal fee for reasons of equity, even where the appellant has not requested the reimbursement.

7. *(Auxiliary) Request for oral proceedings*

Since the appeal is successful at least insofar as the decision under appeal is set aside and the case is

remitted to the department of first instance, it is not necessary for the Board to hold oral proceedings.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

M. Kiehl

S. Steinbrener