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**Datasheet for the decision
of 8 March 2007**

Case Number: T 0750/06 - 3.5.02

Application Number: 99303047.7

Publication Number: 0952557

IPC: G07B 15/02

Language of the proceedings: EN

Title of invention:

A system and method for charging for vehicle parking

Applicant:

Levy, Nessim Igal

Opponent:

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Headword:

-

Relevant legal provisions:

EPC R. 67, 68(2)

Keyword:

"Decision on the state of the file - reasoned (no)"

"Substantial procedural violation - (yes)"

"Reimbursement of the appeal fee - (yes)"

Decisions cited:

T 0583/04, T 1360/05

Catchword:

-



Case Number: T 0750/06 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 8 March 2007

Appellant: Levy, Nessim Igal
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Representative: Cozens, Paul Dennis
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 2 December 2005
refusing European application No. 99303047.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Rognoni
Members: J.-M. Cannard
C. Holtz

Summary of Facts and Submissions

I. The appellant contests the decision of the examining division to refuse European patent application No. 99 303 047.7.

II. The relevant history of the case before the first instance may be summarized as follows:

In a communication accompanying summons to attend oral proceedings and posted on 11 July 2005, the applicant (now appellant) was informed *inter alia* that the subject-matter of the claims filed with a letter dated 17 January 2005 did not involve an inventive step having regard to the combination of documents D2 (WO 95/08162A) and D4 (US-A-5 490 079).

With a letter of reply dated 10 November 2005 received on 14 November 2005, the applicant filed an amended set of claims 1 to 17 with comments in support of their patentability and requested the grant of a patent on the basis of the amended claims.

A consultation by telephone, in the course of which there was, according to the file, a substantive discussion of the case, took place between the first examiner and the applicant's representative on 18 November 2005.

In a letter dated 21 November 2005, faxed on the same day, the applicant informed the examining division that it withdrew its request for oral proceedings and requested "that a decision now be taken based on the

current state of the file, in light of the telephone discussion".

With a fax dated 22 November 2005, the examining division issued a copy of the result of the consultation by telephone of 18 November 2005, confirmed by letter dated 25 November 2005, and, as confirmed by the communication dated 29 November 2005, also informed the applicant that the summons to attend oral proceedings on 22 November 2005 had been cancelled and a decision on the state of the file would be taken.

On 2 December 2005, a decision to refuse the European patent application No. 99 303 047.7 was issued.

III. The decision to refuse the application reads as follows:

"In the communication(s) dated 11.07.2005, 18.11.2005 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 21.11.2005.

The application must therefore be refused."

IV. In the statement of grounds of appeal, the appellant argued that the decision under appeal gave no reasoning. The objections set out in the annex to the Summons to oral proceedings were improperly taken for the reasons set forth in the letter dated 10 November 2005 and for

the further reasons given orally to the first examiner and recorded in the minutes of a telephone consultation dated 25 November 2005. The examining division had failed to adopt the problem and solution approach and was influenced by hindsight and today's common general knowledge in assessing inventive step.

- V. Independent claims 1 and 8 of the set of claims according to the current request, i.e. the claims filed with the letter dated 10 November 2005, read as follows:

Claim 1:

"A system for charging for vehicle parking, comprising:

a plurality of mobile parking units (12), each of said plurality of mobile parking units (12) configured to be installable in a vehicle and having an (*sic*) unique identification; and

a control center (14) for communicating with each of said mobile parking units (12),

characterized by each of said plurality of mobile parking units (12) comprising:

vehicle location means (18) for determining the geographic location and speed of the vehicle;

input and output channels (30) connected to at least one of a group of sensor control means (31) for indicating whether or not the vehicle is immobile, and

a means for calculating and charging (16) for the cost of parking;

wherein, if the location of the vehicle coincides with a known parking location and the vehicle remains immobile each of said plurality of mobile parking units (12) activates charging for parking."

Claim 8:

"A method for charging for vehicle parking characterized by comprising the steps of:

determining the geographic location and speed of the vehicle by means of a mobile parking unit (12) installable within a vehicle, said mobile parking unit (12) comprising vehicle location means (18) and a means for calculating and charging (16) for the cost of parking;

said mobile parking unit (12) determining whether said vehicle is immobile; and

if the location coincides with a known parking location, said mobile parking unit (12) activating parking charges for the total period of time said vehicle remains immobile."

VI. In the notice of appeal, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the application in its current form, or subject to further amendment.

VII. In a communication dated 29 August 2006, the Board indicated *inter alia* that it was inclined to remit the case to the first instance because the decision under appeal was improperly reasoned.

Reasons for the Decision

1. The appeal is admissible.

Claims 1 and 8 according to the current request

2. In claims 1 and 8 according to the current request (i.e. claims 1 and 8 filed with the applicant's letter of 10 November 2005), it is specified, in addition to the features recited in claims 1 and 8 referred to in the communication of the examining division dated 11 July 2005, that each of the mobile parking units comprises:

(a) "a means for calculating and charging (16) for the cost of parking" and that

(b) charging for parking is activated by each of the mobile parking units.

2.1 Current claims 1 and 8 thus differ substantially from those dealt with in the communication of 11 July 2005. Moreover, it is observed that the additional feature (b) is not comprised in any of the claims which were considered in said communication.

Non-compliance with Rule 68(2) EPC

3. The appealed decision is "of a standard form, simply referring to the previous communication(s) for its grounds and to the request of the applicant for such decision" in accordance with the Guidelines for Examination in the EPO (June 2005) C-VI 4.5 and E-X 4.4. The present Board is in full agreement with the decision T 583/04 (not published), according to which such "a request is not to be construed as a waiver to the right to a fully reasoned first instance decision, even in the light of the suggested procedure in the guidelines" (point 10 of the reasons). The Board is also in full agreement with point 5 of the reasons of T 583/04, according to which "such a first instance decision by reference is entirely appropriate when the communication incorporated by reference contains a fully reasoned exposition of the examining division's objections to the current application text and refutation of any rebuttal by the applicant". However, in the judgement of the present Board, the contested decision cannot be considered to be a fully reasoned decision within the meaning of Rule 68(2) EPC because it does not present a full exposition of all the legal and factual reasons for refusing the application, as this appears from the following.

4. The decision under appeal refers *inter alia* to a communication dated 18 November 2005. The Board could however not find in the file any communication from the examining division pursuant to Article 96(2) and Rule 51(2) EPC, namely a communication inviting the applicant to file observations within a period fixed by the examining division, which bears this date. The copy

of the "Result of consultation" dated 18 November 2005 which apparently had been faxed on 22 November 2005 and posted on 25 November 2005, was most probably meant by the reference in the contested decision to the communication dated 18 November 2005.

- 4.1 A record of a telephone consultation is not *sensu stricto* a communication pursuant to Article 96(2) EPC and "the term "state of the file" implies that all relevant facts and arguments are already on file - ie they exist in a written form - which can hardly be the case immediately following a phone call" (T 583/04, points 9 and 10 of the reasons).
- 4.2 The present case, in which the applicant explicitly requested that the decision be taken "on the current state of the file, **in light of the telephone discussion**", however is different from T 583/04, even if, in both cases, the decision of the first instance referred to a result of a telephone consultation.
5. In the present case, the contested decision cannot contain a full exposition of all factual reasons for refusing the application simply because the additional features (a) and (b) included in claims 1 and 8 of the applicant's latest request (see point 2) were never discussed in the course of the first instance proceedings.
 - 5.1 The additional feature b) in particular was not considered in the communication dated 11 July 2005 referred to in the appealed decision because it is not included in any of the claims considered in this communication.

- 5.2 Whether or not the expression "the current state of the file, in the light of the telephone discussion" used by the applicant in its request for a decision on the state of the file was meant to comprise the facts and arguments presented during the telephone conversation, as they were recorded in the "result of telephone consultation", it appears from this record (whose content has not been disputed by the appellant) that the only difference identified by the first examiner between the subject-matter of claims 1 and 8 according to the applicant's latest request and document D2 was the use of vehicle location means for determining the geographic location. This difference, however, is exactly the difference between claims 1 and 8 and the prior art D2 pointed out in the communication of 11 July 2005. Therefore, the substantial additional features (a) and (b) included in claims 1 and 8 of the applicant's latest request were discussed neither in the "communication dated 18.11.2005", nor in the appealed decision, in particular not by means of reference to a previous communication. Thus this decision does not present a full exposition of all the factual reasons for refusing the application and cannot be considered as a fully reasoned decision within the meaning of Rule 68(2) EPC, first sentence.
6. Furthermore, there is no indication in the appealed decision that the claims filed with the letter dated 10 November 2005 (the applicant's latest request) actually formed the basis for the refusal. Nor is it immediately clear on which set of claims the application was refused, because it is doubtful whether the term "the latest communication" in the contested decision

refers to the result of the telephone consultation, which is not *sensu stricto* a communication within the meaning of Article 96(2) EPC. For this reason, the appealed decision cannot be considered to be a reasoned decision pursuant to Rule 68(2) EPC, in the sense that it was not reasoned in the relation to the subject-matter of the claims according the applicant's latest request (T 1360/05 (not published), point 11 of the reasons).

7. Non-compliance with Rule 86(2) EPC constitutes a substantial procedural violation. In accordance with the established case law of the Boards of Appeal, the case is remitted to the department of first instance for further prosecution on the basis of the amended claims filed with the applicant's letter of 10 November 2005.

Reimbursement of the appeal fee

8. Because of the non-compliance with the requirements set out in Rule 68(2) EPC, the applicant was forced to file the present appeal in order to obtain his right to have a reasoned decision. It is therefore equitable to order reimbursement of the appeal fee in accordance with Rule 67 EPC.

Order

For these reasons it is decided that :

1. The decision under appeal is set aside.
2. The decision is remitted to the department of first instance for further prosecution on the basis of claims 1 to 17 of the request filed with the letter dated 10 November 2005, received on 14 November 2005.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

U. Bultmann

M. Rognoni