

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 21 June 2007**

Case Number: T 1488/06 - 3.5.01

Application Number: 99304420.5

Publication Number: 0965921

IPC: G06F 11/00

Language of the proceedings: EN

Title of invention:

Distributed indirect software instrumentation

Applicant:

LUCENT TECHNOLOGIES INC.

Opponent:

-

Headword:

Software instrumentation/LUCENT

Relevant legal provisions:

EPC Art. 108

EPC R. 65(1)

RPBA Art. 10a(2)

Keyword:

"Grounds of appeal - set out by reference to a party's previous letters (not sufficient)"

"Grounds of appeal - formed by an unreasoned combination of refused claims (not sufficient)"

"Insufficient statement of grounds of appeal - remedied by an additional statement filed after the 4-month period of Article 108 EPC (no)"

"Admissibility of appeal (no)"

Decisions cited:

J 0022/86, T 0220/83, T 0145/88, T 0729/90, T 0162/97,

T 0349/00, T 0502/02

Catchword:-



Case Number: T 1488/06 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 21 June 2007

Appellant: LUCENT TECHNOLOGIES INC.
600 Mountain Avenue
Murray Hill, New Jersey 07974-0636 (US)

Representative: Sarup, David Alexander
Alcatel-Lucent Telecom Limited
Unit 18, Core 3
Workzone
Innova Business Park
Electric Avenue
GB-Enfield, EN3 7XU (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 22 May 2006
refusing European application No. 99304420.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Steinbrener
Members: K. Bumès
A. Pignatelli

Summary of Facts and Submissions

- I. This appeal is against the Examining Division's decision, posted on 22 May 2006, to refuse application No. 99304420.5 for lack of clarity (Article 84 EPC), lack of inventive step (Article 56 EPC) and insufficiency of disclosure (Article 83 EPC).
- II. The notice of appeal, filed on 20 July 2006, includes a request that the decision be set aside and a patent granted, and an instruction to deduct the appeal fee.
- III. With a facsimile letter of 20 September 2006, the appellant filed amended claims forming a (second) auxiliary request and presented "Grounds of Appeal" consisting of the following sentence: "Our appeal arguments are the same as those previously provided in our letters dated January 14, 2004 and March 13, 2006."
- IV. In a communication dated 1 March 2007, the Board expressed doubts about whether the appellant's letter of 20 September 2006 qualified as a written statement of grounds of appeal within the meaning of Article 108 EPC and Article 10a(2) of the Rules of Procedure of the Boards of Appeal (RPBA). A mere reference to party's first-instance submissions did not replace a complete and express statement of the party's grounds of appeal. As to the amended claims filed with the letter of 20 September 2006, the appellant had not explained why he considered the amendments to overcome the objections of the decision under appeal. Consequently, the appeal might have to be rejected as inadmissible pursuant to Rule 65(1) EPC.

- V. The appellant's response, filed on 4 May 2007, provides detailed substantive comments on the refusal decision.

Reasons for the Decision

1. According to Article 108 last sentence EPC, a written statement setting out the grounds of appeal must be filed within four months after the date of notification of the decision under appeal.

Article 10a(2) RPBA stipulates that the statement of grounds of appeal shall contain a party's complete case, shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, and should specify expressly all the facts, arguments and evidence relied on.

2. These requirements are not met by the "Grounds of Appeal" embedded in the appellant's letter of 20 September 2006 which consist of a single sentence referring to two previous letters ("dated January 14, 2004 and March 13, 2006") which the applicant (now appellant) had sent to the Examining Division.
- 2.1 While two typing errors in the two dates may be rectified from the file (the correct dates of the referenced letters should read January 15, 2004 and April 10, 2006), the Board notes that a mere reference to first-instance submissions does not replace a complete and express statement of a party's grounds of appeal, i.e. its legal and/or factual reasons why the decision under appeal should be set aside. In general, such a reference does not enable the Board to

understand immediately, without first having to make investigations of its own, why the decision is alleged to be incorrect, see e.g. T 220/83 (OJ EPO 1986, 249), confirmed by numerous decisions (cf. Case Law of the Boards of Appeal, European Patent Office, 5th edition 2006, section VII.D.7.5.1). This applies all the more to the present case as the applicant's first-instance submissions have been comprehensively addressed by the decision under appeal (point 2.6 therein) so that the appeal should have provided further explanations of the appellant's reliance on those submissions.

- 2.2 A brief statement of grounds of appeal may be considered sufficient in extreme cases, e.g. where a substantial violation of the first-instance proceedings occurred or where a reading of the impugned decision itself reveals that it cannot be upheld, see e.g. J 22/86 (OJ EPO 1987, 280, points 1 and 2 of the Reasons), or T 349/00 (point 4 of the Reasons).

However, no such deficiency is apparent to the Board in the present case. In particular, the decision under appeal is based on the text submitted by the applicant (Article 113(2) EPC), it is reasoned (Rule 68(2) EPC) and based on grounds and evidence on which the applicant had an opportunity to present his comments (Articles 96(2) and 113(1) EPC), including an opportunity to attend oral proceedings (Article 116(1) EPC).

- 2.3 The letter of 20 September 2006 introduces an amended claim set (as a second auxiliary request) and explains how the amended claim 1 has been formed (by

incorporating the limitations of the previous dependent claims 9 and 10).

If the appeal is based on amended requests, which can also be auxiliary requests, the appellant has to allege that the amendments overcome the objections on which the first-instance decision is based. The causal link between the amendments and the objections must be either explicitly explained or immediately recognisable (see e.g. T 729/90 or T 162/97).

In the present case, the appellant has not explained why it considers the amendment to overcome the objections of the decision under appeal. Such an explanation would have been particularly necessary in view of point 4.2 of the impugned decision which summarises prior art objections to the dependent claims (including said claims 9 and 10). An unreasoned combination of claims which have been objected to by the department of first instance does not provide even a minimum of reasoning in support of the appeal, see e.g. T 145/88 (OJ EPO 1991, 251, point 2 of the Reasons) or T 502/02 (point 5 of the Reasons).

3. The appellant's letter of 4 May 2007 deals in detail with the substantive arguments set out in the decision under appeal. However, as the letter has been filed after expiry of the 4-month period laid down in Article 108 EPC, it does not fulfil the requirement that a written statement setting out the grounds of appeal must be filed within said period.
4. Consequently, since no statement setting out the grounds of appeal was filed within the time limit

provided for by Article 108 EPC, the appeal has to be rejected as inadmissible pursuant to Rule 65(1) EPC.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

T. Buschek

S. Steinbrener