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**Datasheet for the decision
of 15 September 2009**

Case Number: T 1854/08 - 3.5.02

Application Number: 03809809.1

Publication Number: 1576734

IPC: H03M 13/00

Language of the proceedings: EN

Title of invention:
Trellis-based-receiver

Applicant:
NXP B.V.

Headword:
-

Relevant legal provisions:
EPC Art. 113(1)(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Substantial procedural violation - yes -"
"Reimbursement of the appeal fee - yes -"

Decisions cited:
-

Catchword:
-



Case Number: T 1854/08 - 3.5.02

DECISION
of the Technical Board of Appeal 3.5.02
of 15 September 2009

Appellant: NXP B.V.
High Tech Campus 60
NL-5656 AG Eindhoven (NL)

Representative: Gray, Peter John Bracey
Thompson Gray LLP
Sussex Innovation Centre
Science Park Square
Falmer
Brighton BN1 9SB (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 26 March 2008
refusing European patent application
No. 03809809.1 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: M. Ruggiu
Members: P. Mühlens
J.-M. Cannard

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the Examining Division of 26 March 2008 to refuse European Patent application No. 03 809 809.1 for lack of clarity and lack of inventive step.
- II. The application was filed on 22 September 2003 as an International Application under the PCT with a set of 10 claims. After the entry into the European phase and first and second communications of the Examining Division dated 29 March 2006 and 21 July 2006 respectively, the applicant filed with letter of 21 November 2006 a new set of claims. He was then summoned to oral proceedings to be held on 14 December 2007.
- III. With letter of 5 November 2007, the applicant filed a new main request and first and second auxiliary requests. In his letter, he requested consequently that a patent be granted on the basis of one of those requests.
- IV. On 27 November 2007, the examining division sent an e-mail to the applicant with the following content (in part):
- " Dear Mr. White,
- the examining division has discussed the three new requests filed with letter of Nov.5.
- I. These requests are not admitted into the proceedings, pursuant to Rule 86(3)EPC, because they introduce substantial obscurities (Art.84 EPC). In particular:

.....
 II.
 III.

IV. If no new request is filed which is admissible under Rule 86(3), then the oral proceedings will be based on the request on which the summons to oral proceedings was based."

The applicant was then asked by e-mail the day before the oral proceedings scheduled for the 14 December 2007 to indicate whether he intended to be present at the oral proceedings. By e-mail of the same day, the applicant confirmed that he would not be present.

V. As announced, the applicant did not attend the oral proceedings. At the oral proceedings, the application was refused on the basis of the claims filed on 21 November 2006, which had been objected to in an annex to the summons to oral proceedings. As announced by e-mail, the examining division did not admit the newly filed main and auxiliary requests into the proceedings.

VI. With the grounds of appeal, the appellant requested that a patent be granted on the basis of the claims presently on file or as amended in the main, first or second auxiliary requests set out in the grounds of appeal. Oral proceedings were provisionally requested.

VII. By communication of 3 February 2009, the Board expressed the view that the impugned decision seemed to contravene Art. 113 EPC and that it intended to remit the case to the department of first instance for

further prosecution and to reimburse the appeal fee. In his letter of response, the appellant informed the Board that this was acceptable to him.

Reasons for the decision

1. The appeal is admissible and leads to a remittal of the case to the department of first instance for further prosecution.
2. The procedure in the first instance suffers from substantive procedural violations:
 - 2.1 In deciding on the basis of the set of claims filed with letter of 21 November 2006, the examining division decided on the basis of a set of claims which was no longer agreed by the applicant because new requests had been filed with letter of 5 November 2007. From this letter, it could be clearly and unambiguously derived that the new main and auxiliary requests were meant to replace the claims filed before. This follows from the fact that the applicant requested in his letter that a patent be granted on the basis of one of the newly filed requests. Hence, deciding on the basis of the old set of claims contravenes directly Art. 113(2) EPC, where it is stated that the European Patent Office shall examine, and decide upon, the European patent application only in the text submitted to it, or agreed, by the applicant.
 - 2.2 By an e-mail of 27 November 2007, the applicant was informed that the three newly filed requests were not admitted into the proceedings, because they introduced

substantial obscurities. The applicant was not given any opportunity to present his comments to overcome the negative position expressed in the e-mail. Contrary to that, he had to gather from the e-mail that it was no longer possible to convince the examining division. This follows from the fact that the refusal to admit the newly filed request was not presented as a provisional opinion of the division to prepare a discussion in the forthcoming oral proceedings but as a decision which could not be overturned. In the e-mail, it is clearly expressed that "if no new request is filed which is admissible under Rule 86(3), then the oral proceedings will be based on the request on which the summons to oral proceedings was based", i.e., that the requests filed on 5 November 2007 were no longer under consideration. This contravenes Art 113 (1) EPC where is laid down that the decisions of the European Patent Office may only be based on grounds on which the parties concerned have had an opportunity to present their comments.

3. As contravening Art 113(1) and (2) EPC constitutes a substantive procedural violation, the Board remits the case to the department of first instance for further prosecution (Art. 11 of the Rules of procedure of the Boards of appeal, OJ EPO 2007, 536 to 547).
4. Moreover, it is questionable whether an e-mail can constitute a communication under Art. 96(2) EPC 1973 to file observations within a period to be fixed by the Examining Division.
However, as the case has to be remitted for the above mentioned reasons alone, this point has not to be decided in the present case.

5. As the substantial procedural violations have occasioned the appeal, it is equitable to order the reimbursement of the appeal fee (Rule 67 EPC 1973).
6. As the appellant has agreed to the remittal of the case, oral proceedings are not necessary.

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:

U. Bultmann

M. Ruggiu