

Publication in the Official Journal / No

File Number: T 831/90 - 3.5.1
Application No.: 83 900 222.7
Publication No.: 0 094 423
Title of invention: A security system for SSTV encryption

Classification: H04M 1/32

D E C I S I O N
of 29 July 1991

Applicant: Communications Satellite Corp.

Headword: Inadmissible appeal/Communications Satellite

EPC Article 97(2)(a), 107; Rule 51(4) and (6)

Keyword: "Party adversely affected (no)" - "alleged telephone call to
Examining Division insufficient as positive disapproval of the text
in which Examining Division intends to grant the patent"

Headnote



Case Number : T 831/90 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 29 July 1991

Appellant : Communications Satellite Corporation
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US

Representative : Pinguet, André
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Decision under appeal : Decision of Examining Division of the European
Patent Office dated 26 July 1990 to grant a
European patent on application No. 83 900 222.7
pursuant to Article 97(2) EPC.

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : M. Lewenton
A. Clelland

Summary of Facts and Submissions

- I. The Appellant filed international application PCT/US 82/01631 on 19 November 1982 claiming the priority of a national patent application filed in the United States on 19 November 1981. This application was given the European patent application No. 83 900 222.7.

- II. On 20 January 1988 the Examining Division of the European Patent Office issued a communication pursuant to Rule 51(4) EPC. Within the four months' time limit provided by that communication the Appellant requested on 13 May 1988 amendment of the application, namely to include 35 claims instead of 13 claims as originally filed. Following this request the procedure was reopened and on 3 February 1989 the Examining Division issued a communication according to Article 96(2) and Rule 51(2) EPC inviting the Appellant to correct several deficiencies in the application as amended within four months. With reference to a further request of the Appellant the said time limit was extended by two months.

- III. Within the extended time limit the Appellant submitted on 12 August 1989 a new set of 26 claims. The Examining Division thereupon issued a communication under Rule 51(6) EPC dated 11 December 1989 accepting the proposed amended claims and requesting the filing of translations and the payment of the due fees.

- IV. In a letter dated 15 December 1989, the Appellant requested further amendment of the application by the addition of two further claims, 27 and 28. In a communication of 8 February 1990 the Appellant was informed that the further amendment would not be taken into account, on the ground that the request was received after the Appellant had approved the text intended to

serve as a basis for grant. The Appellant was bound by his approval and the patent therefore could be granted only including those claims as accepted in the communication of 11 December 1989.

V. With letters received on 20 March 1990 and 22 June 1990 in response to the communication of 8 February 1990 the Appellant requested grant of a patent on the basis of the text previously accepted by the Examining Division. Accordingly, on 26 July 1990, a decision was issued to grant the patent.

VI. On 6 September 1990 the Appellant filed the present appeal requesting

- (a) that the communication pursuant to Rule 51(6) be cancelled;
- (b) that the European Patent Office either grant a patent on the basis of the complete amendment submitted in response to the communication of 3 February 1989 or definitely reject this amendment;
- (c) that the appeal fee be reimbursed.

The appeal fee was paid on 6 September 1990 and a statement giving the grounds of appeal was received on 27 October 1990.

VII. In his statement of grounds the Appellant essentially argued that the communication pursuant to Rule 51(6) EPC was issued although no text was available by that time on the basis of which a patent could be granted. Before issuing this communication the Examining Division had consented in a telephone conversation that the Appellant could further amend his text filed on 12 August 1989 by submitting two new claims, 27 and 28. Accordingly this was

done in his letter of 15 December 1989. Therefore by issuing the communication under Rule 51(6) EPC the Examining Division did not respect Section C-VI, 15.1.4 of the Guidelines for Examination. Consequently also the communication of 8 February 1990 refusing the amendment of the Claims 27 and 28 was not correct. Either the Examining Division should have considered the new claims or should have rejected the amendment. As a result of the Examining Division's proceeding, the Appellant did not have the opportunity to further amend the claims or to file a divisional application.

Reasons for the Decision

1. In order for an appeal to be admissible, it must comply with the provisions of Articles 106 to 108 and Rule 64(b) EPC. An appeal which does not comply with these requirements has to be rejected as inadmissible unless the deficiency has been remedied before the relevant time limit laid down in Article 108 has expired, Rule 65(1) EPC.
2. In the present case, the Appellant feels adversely affected by the communication under Rule 51(6) EPC which did not consider the Claims 27 and 28 submitted in his letter of 15 December 1989. According to his statement this amendment was accepted by the Examining Division during a telephone conversation held before the communication was issued, and therefore the patent in suit should not have been granted since the Appellant had not approved the text.
3. In the Board's view, an applicant for a European patent can only be adversely affected by a decision to grant the patent when such a decision is inconsistent with what he

has specifically requested (cf. decisions of the Legal Board J 12/83, OJ EPO 1985, 6 and J 12/85, OJ EPO 1986, 155). In the present case, the patent was granted on the basis of the text cited in the communication pursuant to Rule 51(6) EPC to which the Appellant had implicitly given his consent in his letters of 20 March 1990 and 22 June 1990.

4. In the case of a European patent application meeting the requirements of the Convention the Examining Division shall decide to grant the patent provided that it is established, in accordance with the Implementing Regulations, that the applicant approves the text in which the patent is intended to be granted, Article 97(2) EPC. After the Appellant had requested amendments in his letter of 13 May 1988, the Examining Division correctly followed the procedure as prescribed in Section C-VI 15.1.4 of the Guidelines. As in his letter of 12 August 1989 the Appellant had met the request of the Examining Division to rectify remaining deficiencies; consequently the communication under Rule 51(6) EPC was issued establishing the final text of the patent to be granted.

5. As stated by the Legal Board of Appeal in the two cases cited above, in order for examination to be resumed in accordance with the last sentence of Rule 51(4) EPC, disapproval must actually be communicated. The alleged telephone conversation according to which the Examining Division had in principle accepted the filing of Claims 27 and 28 cannot be considered as positive disapproval in the sense of the decisions mentioned above. The conversation is not minuted in the application file and the Appellant did not give any details of the content of that conversation, nor did he even indicate when it took place. In the Board's view, it seems most unlikely that the Examining Division at that late stage of the procedure

would have been prepared to accept new claims solely announced to it by a telephone call and not submitted in writing. Only on 15 December 1989 did the Appellant send a letter to the Examining Division specifying the claims which he wanted to be added. However, this letter cannot be considered as an effective disapproval since it was received after the time limit allowed in the communication of 3 February 1989 and subsequently extended had expired and after the Examining Division had issued the communication pursuant to Rule 51(6) EPC based on the Appellant's request of 12 August 1989.

6. The Board is aware of the fact that the principles of due process and good faith (see. e.g. J 3/87, OJ EPO 1989, 3) make it paramount that the EPO always ensures that applicants are given clear guidance and kept within their rights. However, in the present case a violation of these principles cannot be detected. After having implicitly given his approval to a text with 26 claims (letter of 12 August 1989) the Appellant could not reasonably expect to be allowed to delay the procedure further merely by a telephone call. The circumstances of the case in suit would have required that any further amendment be submitted in writing and be received by the Examining Division before expiry of the time limit. The EPC makes no provision for reopening of the procedure after the communication under Rule 51(6) EPC is issued.

7. It follows that the Board is not satisfied that the Appellant is a party "adversely affected" by the decision to grant the European patent, within the meaning of Article 107 EPC. Accordingly the appeal must be rejected as inadmissible, in accordance with Rule 65(1) EPC.

Order

For these reasons, it is decided that:

The appeal against the decision dated 26 July 1990 is rejected as inadmissible.

The Registrar:

The Chairman:

M. Beer

P.K.J. van den Berg