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File Number: T 472/91 - 3.5.1

Application No.: 85 112 469.3

Publication No.: 0 189 524

Title of invention: Memory unit having arithmetic and logic functions, in particular for graphic processing

Classification: G06F 7/48

DECISION
of 19 August 1992

Applicant: HITACHI, LTD.

Headword:

EPC Articles 56, 111(1), 123(2)

Keyword: "Amendment admissible (main request: no)" - "Subject-matter of auxiliary request dropped earlier in the proceedings but not abandoned, admitted for consideration" - "Inventive step examination of auxiliary request not carried out - remittal to first instance"



Case Number : T 472/91 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 19 August 1992

Appellant : HITACHI, LTD.
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Representative : Patentanwälte
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Decision under appeal : Decision of Examining Division of the European
Patent Office dated 28 January 1991 refusing
European patent application No. 85 112 469.3
pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : W.B. Oettinger
C. Holtz

Summary of Facts and Submissions

- I. The appeal contests the decision, dated 28 January 1991, of the Examining Division to refuse the European patent application No. 85 112 469.3 which had been filed on 2 October 1985 (publication No. 0 189 524).

The reason given for the refusal was that the subject-matter of the only independent Claim 1, filed on 7 June 1990, did not involve an inventive step, having regard to the prior art in

D1: US-A-3 984 670

D2: US-A-3 976 982.

- II. The appeal was lodged on 26 March 1991 with a request that the appealed decision be set aside. The respective fee was paid simultaneously.

The Appellant filed a Statement of Grounds on 7 June 1991 together with amended claims.

- III. In a communication pursuant to Article 11(2) Rules of Procedure, the Board, referring to documents D1, D2,

D3: JP-A-55-129 387 (mentioned in the description), and

D4: GB-A-2 103 399 (mentioned in the Search Report),

expressed its provisional view that Claim 1 filed on 7 June 1991 would not appear allowable and the claims appended to it would not seem to allow a more positive conclusion.

- IV. In response, the Appellant without defending any of the formerly considered claims filed on 23 July 1992 new claims of which the independent Claim 1 reads as follows:

"A data processor with a memory on which can be performed:

an ordinary write mode in which, based on a first data (Y) from an external device and a second data (Do) in said memory elements (2), said first data (Y) is stored in said memory elements (2);

a logic operation mode in which data (Z) obtained as a result of a logical operation performed between said first data (Y) and said second data (Do) is stored in said memory element (2); and

an arithmetic operation mode in which data (Z) obtained as a result of an arithmetic operation performed between said first data (Y) and said second data (Do) is stored in said memory elements (2), characterized by

two selector means (SEL 3, SEL 4) each for selecting a data item X and Y, respectively from a plurality of input data items,

an output from a first selector circuit (SEL 4) of said selector means coupled to an input of said first data (Y),

an output from a second selector circuit (SEL 3) of said selector means coupled to an input of one of said control input signals (Cr) from external devices; and

output selections of said two selectors (SEL 3, SEL 4) each are specified independently of each other."

In support of this new claim, the Appellant submitted that the preamble and characterising portion of this claim would correspond to the original Claims 23 and 33 respectively, and that this subject-matter would not be obvious from any of the prior art documents cited nor from their combination.

V. In oral proceedings, held on 19 August 1992, the Board pointed out that Claim 1 of 23 July 1992 was not only unclear (Article 84 EPC) but, moreover, no support for the combination of features constituting the subject-matter of this claim could be found in the original application documents; the amendments resulting in this claim would therefore appear to be inadmissible (Article 123(2) EPC).

The Appellant in response made an auxiliary request aiming at the incorporation of an additional feature, taken from the original Claim 24, now Claim 2, into Claim 1.

It was further discussed, in the oral proceedings, whether the filing of claims based on original claims which were, after the first communication from the Examiner, never defended or refiled either in the first instance procedure or in the appeal, at such a late stage, viz. only a few weeks before and in oral proceedings held before the second instance Board, would amount to an abuse of the procedure, and whether such claims should be disregarded under Article 114(2) or not given the Board's consent under Rule 86(3), second sentence, EPC.

In this respect, the Appellant pointed out that the subject-matter of the original Claims 23 ff. was never abandoned. It was still part of the application when it was refused by the decision under appeal. That decision not only rejected the claims then on file but refused, by virtue of Article 97(1) EPC, the application as a whole which still (in the description) contained the subject-matter of said claims. The Appellant would be entitled, in response to the Board's negative opinion expressed in its communication, to shift the subject-matter claimed to any other matter not abandoned and thought to be inventive.

In this context, the Appellant informed the Board that a divisional application, No. 92 112 252.9, was filed on 17 July 1992 on subject-matter similar to that previously claimed in the present parent application. In his opinion, Rule 25 EPC would allow the presently effected distribution of different subject-matters on the two applications equally well as the inverse.

VI. The Appellant thus requested that the decision under appeal be set aside and the case remitted to the first instance for further prosecution on the basis of the claims filed on 23 July 1992 (main request) or on the basis of the original Claim 33 (auxiliary request).

This latter claim, and the claims on which it depends, read as follows:

"23. A memory circuit having memory elements (2) on which operations to read, to write, and to store data can be arbitrarily effected characterized by comprising control circuit means (1') having:

an ordinary write mode in which, based on a first data (Y) from an external device and a second data (Do) in said memory elements (2), said first data (Y) is stored in said memory elements (2);

a logic operation mode in which data (Z) obtained as a result of a logical operation conducted between said first data (Y) and said second data (Do) is stored in said memory elements (2); and

an arithmetic operation mode in which data (Z) obtained as a result of an arithmetic operation conducted between said first data (Y) and said second data (Do) is stored in said memory elements (2).

24. A memory circuit according to Claim 23 wherein said three modes in said control circuit means (1') each are

specified by a plurality of control input signals (CNT, Cr) from external devices.

33. A memory circuit according to Claim 24 further comprising:

two selector means (SEL3, SEL4) each for selecting a data item (X, Y) from a plurality of input data items,
an output from a first selector means (SEL4) of said selector means being an input of said first data (Y),
an output from a second selector means (SEL3) thereof being an input of one of said control input signals from external devices; and
output selections of said two selectors (SEL3, SEL4) each are specified independently of each other."

Reasons for the Decision

1. The appeal is admissible (Articles 106 to 108 and Rule 64 EPC).
2. Main request

The absence of any definition, in Claim 1 filed on 23 July 1992, of "said" control input signals, such definition only being given in Claim 2, renders Claim 1 unclear (Article 84 EPC).

Even more serious, this absence amounts to an inadmissible amendment (Article 123(2) EPC). The original Claim 33 (cf. paragraph VI) has, by virtue of its dependency, for its subject-matter the combination of all features recited in Claims 23, 24 and 33. Claim 1 now on file, however, would seek protection for the sub-combination of the features of Claims 23 and 33 only, without those of Claim 24. The Board has found no support for this latter sub-combination

in the application documents as originally filed, and the Appellant has not disputed this view.

As Claim 1 is not admissible for the reasons set out above, the main request must be rejected.

3. Auxiliary request

3.1 The Board agrees with the Appellant that the subject-matter of the original Claim 33 was not irrevocably abandoned but was, at the time of refusal of the application, still part of the application, albeit only by way of the description without a claim being directed on it. It is therefore considered that this is still true in the present state of affairs. Thus, the introduction of this matter in the claims does not add any subject-matter extending beyond the content of the application as filed (Art. 123(2) EPC).

It is further agreed that there was no procedural abuse from the side of the Appellant, in response to the Board's provisional objection expressed in its communication, to make an attempt to overcome the objection by bringing up such subject-matter which was never abandoned.

The original Claim 33 is therefore admitted for consideration (Rule 86(3), second sentence, EPC).

The existence of a divisional application (cf. paragraph V) is, in this context, of no importance.

3.2 However, the subject-matter of this claim, consisting of the preamble and characterising features of Claim 23 with the features of Claim 24 and 33 directly appended, differs substantially from the subject-matter pursued and considered, after the Examiner's first communication,

throughout the examination procedure before the first instance including the decision under appeal and even during the appeal procedure until the oral proceedings. The characterising features of Claim 1 of 7 June 1991 concerning the kind of memory, the chip technology and the read/write cycle are no longer claimed; instead, selector features are claimed (cf. VI) which were not required in any of the previous versions of Claim 1.

In the Examiner's first communication dated 26 May 1989, he raised an objection of lack of inventive step against Claim 33 but neither was this objection countered by the Applicant nor was it later referred to by the Examining Division. In his submission of 23 July 1992, the Appellant contended that the selector features now claimed would not be obvious from the prior art but he did not in any way refer to the Examiner's argumentation based specifically on D2 or common knowledge in addition to D1.

Thus, no discussion of this issue has effectively taken place and the Board considers therefore that Claim 33 has not, in effect, been examined. Moreover, this claim will have to be refiled as an independent claim containing all features of Claim 33 and of the claims on which it depends but with its partitioning (Rule 29(1) EPC) corrected in view of the nearest prior art; the remaining dependent claims (3 to 11 of 23 July 1992?) will have to be refiled renumbered, and the description will have to be examined, at least if the claims are not objectionable. In this latter context it is noted, as an example only, that page 5 and the first paragraph on page 7 filed on 23 July 1992 appear inconsistent with the claim now under consideration. In addition, should eventually a patent be granted, it will have to be ensured that the subject-matter claimed in the present application and that claimed in the divisional application (cf. paragraph V) are not identical.

The Board therefore finds it appropriate, making use of its discretion (Article 111(1), second sentence, EPC), to allow the Appellant's request for remittance of the case to the first instance for further prosecution on the basis of the auxiliary request.

Order

For these reasons, it is decided that:

1. The Appellant's main request is rejected.
2. The decision under appeal is set aside and the case remitted to the first instance for further prosecution on the basis of the auxiliary request (cf. points VI and 3.2).

The Registrar:



M. Kiehl

The Chairman:



P.K.J. van den Berg

