



Case Number : T 488/91 - 3.5.1 (B)
EP- 82 903 018.8

D E C I S I O N
of 5 May 1993 correcting errors in
the Decision of the Technical Board of Appeal 3.5.1
of 15 November 1992

Appellant : N.V. Philips' Gloeilampenfabrieken
(Opponent 01) Groenewoudsweg 1
NL - 5621 BA Eindhoven (NL)

Representative : van Gils, Cornelis Johannes Maria
INTERNATIONAAL OCTROOIBUREAU B.V.
Prof. Holstlaan 6
NL - 5656 AA Eindhoven (NL)

Appellant : Interessengemeinschaft für
(Opponent 02) Rundfunkschutzrechte e.V.
Bahnstrasse 62
W - 4000 Düsseldorf (DE)

Representative : Gornott, Dietmar, Dipl.-Ing.
Zilleweg 29
W 6100 Darmstadt 12 (DE)

Respondent : MOTOROLA, INC.
(Proprietor of the patent) 1303 East Algonquin Road
US - Schaumburg, IL 60196 (US)

Representative : Ibbotson, Harold
Motorola Ltd.
Patent and Licensing Operations - Europe
Jays Close
Viables Industrial Estate
Basingstoke
GB - Hampshire RG22 4PD (GB)

Decision under appeal : Interlocutory decision of the Opposition Division
of the European Patent Office dated 26 April 1991
concerning maintenance of European patent
No. 0 091 445 in amended form.

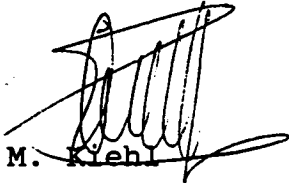
Composition of the Board :

Chairman : P.K.J. van den Berg
Members : W.M. Schar
R. Randes

In application of Rule 89 EPC the Decision given on
15 November 1992 is hereby ordered to be corrected as follows:

Page 3, line 26, line 31 and page 4, line 5 the citation G 9/91
is replaced by G 9/92.

The Registrar:



M. Kiehl

The Chairman:



P.K.J. van den Berg

A		B	X	C	
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File Number: T 488/91 - 3.5.1
Application No.: 82 903 018.8
Publication No.: 0 091 445
Title of invention: Vertical sync counter with automatic recognition of TV
line standard

Classification: H04N 5/04

INTERLOCUTORY DECISION
of 15 November 1992

Applicant: MOTOROLA, INC.
Opponent: (01) N.V. Philips' Gloeilampenfabrieken
(02) Interessengemeinschaft für Rundfunkschutzrechte
e.V.

Headword: Power of Board of Appeal

EPC

Keyword: "Extent to which contested decision may be amended"

Catchwords

The following two-fold question concerning an important point of law shall be referred to the Enlarged Board of Appeal:

- A. Is the Board of Appeal allowed to modify a contested decision to the detriment of the Appellant;
- B. if yes, to what extent?



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Chairman : P.K.J. van den Berg
Members : W.M. Schar
R. Randes

Summary of Facts and Submissions

- I. Before the Opposition Division the Patentee presented two new (restrictively amended) sets of claims, the first one filed as a main request and the second one filed as an auxiliary request.

By decision dated 26 April 1991 the Opposition Division maintained the European patent No. 0 091 445 in amended form according to the auxiliary request of the Patentee.
- II. By notice of appeal dated 20 June 1991 and received on 24 June 1991 an appeal was lodged by the Appellant (Opponent 02) against this decision requesting revocation of the patent. The appeal fee was received on the same day. The Statement of Grounds dated 14 August was received on 16 August 1991 at the EPO.
- III. The Patentee answered by letter of 3 March 1992 requesting the maintenance of the patent as decided by the Opposition Division.
- IV. On 15 July 1992 oral proceedings were held before the Board of Appeal. At the end of the oral proceedings the Appellant repeated his request for revocation of the patent. The Patentee now requested maintenance of the patent on the basis of his former main request which had been refused by the Opposition Division and only auxiliarily as maintained by the Opposition Division according to the Patentee's former auxiliary request.
- V. The Board decided to continue the proceedings in writing.

Reasons for the Decision

1. The appeal is admissible.
2. The Appellant is requesting revocation of the patent. By requesting maintenance of the patent according to his former main request the Respondent (Patentee) goes beyond the request of the Appellant. The Respondent's request concerns a set of claims whose scope is broader than the one of the claims allowed by the Opposition Division. He does not just counter the Appellant's request by defending the outcome of the (contested) interlocutory decision of the Opposition Division which remained unappealed by him, and he aims not only at achieving dismissal of the appeal but also at a modification of the contested decision putting him in a better position than if no appeal at all had been lodged.

The question arises whether the Patentee is entitled to do so and whether the Board may grant such a request, namely:

Is the Board of Appeal allowed to modify a contested decision to the detriment of the Appellant;
if yes, to what extent?

3. By interlocutory decision of 5 October 1992 the Technical Board of Appeal No. 3.2.1 (mechanics) referred two similar cases T 60/91 and T 96/92 with the same question as the one just mentioned to the Enlarged Board of Appeal. The question is pending under G 9/92.

The present case is especially similar to the above referred case T 96/92 insofar as it concerns also a Patentee requesting a broader claim than the one

maintained by the interlocutory decision. However the present case is different insofar as the Respondent (Patentee) does not defend his patent as granted by the Examining Division. He is defending it only on the basis of his main request as filed during the opposition proceedings. The claims filed under the main request were already of restricted scope compared to the claims granted by the Examining Division.

Due to this similarity the answer of the Enlarged Board in these parallel cases (G 9/92 - T 60/91 and T 96/92) has a bearing also on the outcome of the present case. If this answer were to have an adverse effect on the rights of a party to the present case, the party's right to be heard could be considered to be violated if the present case were just suspended until the question were answered in the mentioned parallel cases, because the party would not have had the opportunity to comment on an important point concerning its own rights (Art. 113(1) EPC).

Moreover, would the Board suspend the proceedings, such a party would upon resumption of the proceedings, have the opportunity to comment on all points, including those mentioned in the decision by the Enlarged Board in G 9/92. It could then turn out that new aspects arise, which could necessitate a new referral to the Enlarged Board. Also in the light of that it seems expedient to refer the present case which falls under the question pending in G 9/91² directly to the Enlarged Board.

The Board has therefore decided to refer this important point of law by putting anew in respect of the present appeal the same question already pending before the Enlarged Board of Appeal under G 9/91².

Thus the requirements of Article 112(1)(2) EPC are met in the present case.

4. As far as the further reasons for the decision are concerned the Board refers to the ones mentioned in points 2. - 12. of the above mentioned interlocutory decision T 60/91 and T 96/92 of 5 October 1992 (pending under G 9/91²).

Order

For these reasons, it is decided that:

The following twofold question concerning an important point of law shall be referred to the Enlarged Board of Appeal:

- A. Is the Board of Appeal allowed to modify a contested decision to the detriment of the Appellant;
- B. if yes, to what extent?

The Registrar:

The Chairman:

M. Kiehl

P.K.J. Van den Berg