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**D E C I S I O N**  
of 23 June 1994

**Case Number:** T 0582/93 - 3.5.1

**Application Number:** 88105793.9

**Publication Number:** 0295379

**IPC:** G06F 11/00

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for communication network alert message construction

**Applicant:**

International Business Machines Corporation

**Opponent:**

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**Headword:**

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**Relevant legal norms:**

EPC Art. 113(1)  
EPC R. 67

**Keyword:**

"procedural violation"  
"programming language"  
"reimbursement of appeal fee"

**Decisions cited:**

-

**Catchword:**



Case Number: T 0582/93 - 3.5.1

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.1**  
**of 23 June 1994**

**Appellant:** International Business Machines  
Corporation  
Old Orchard Road  
Armonk, N.Y. 10504 (US)

**Representative:** de Pena, Alain  
Compagnie IBM France  
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**Decision under appeal:** Decision of the Examining Division 065 of the  
European Patent Office dated 3 February 1993  
refusing European patent application  
No. 88 105 793.9 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** P. K. J. van den Berg  
**Members:** R. Randes  
G. Davies

### Summary of Facts and Submissions

- I. By a decision of the Examining Division dated 3 February 1993, the Appellant's European patent application No. 88 105 793.9, filed on 12 April 1988, claiming priority from a previous application in the USA, was refused.
- II. In the first and only communication according to Article 96(2) and Rule 51(2) EPC dated 25 August 1992 the Examining Division had informed the Applicant of its grounds against the grant of a patent.
- III. The Applicant (now Appellant) had replied in the letter filed on 15 December 1992 together with a new and amended set of claims.
- IV. The decision of the Examining Division was taken on the basis of Claims 1 to 10, of which independent Claim 1 reads as follows (the Board has identified the characterising features of the claim by signs (a) to (e) and the wording of the original Claim 1 is bold-typed - the words deleted from the original Claim 1 are indicated by the bold-typed words within parentheses):  
**An event notification device for a communication network** wherein there exist a plurality of types of events of which notification is provided, **characterised in that it comprises:**
  - (a) means for receiving **a plurality of code points** associated with an event;
  - (b) **an index for (receiving)** cross referencing **said code points (and providing)** to **units of text** corresponding to **said code points**;

- (c) text providing means coupled to the means for receiving said code points, for utilising said index to provide said units of text; and
- (d) **display means coupled to said (index) text** providing means for combining said (strings) units **of text to form a display describing the event** with which said code points are associated.

Independent Claim 7 reads as follows (presented in the same form as amended Claim 1 in relation to **original** Claim 1):

**A method of an alert receiver displaying event alerts in a communication network having a plurality of event generating products coupled thereto**, wherein there exist a plurality of types of event alerts which are displayed, **(characterized in that)** the method comprising the steps of:

- (a) **receiving a plurality of code points** via said network **which reference strings of text** and which are associated with an event;
- (b) **retrieving said strings of text from storage locations indexed by said code points;**
- (c) combining said strings of text to form a message describing the event with which said code points are associated and
- (d) **displaying said message to an operator.**

V. The reason for the refusal was that the subject-matter of Claim 1 and Claim 7 was not considered to have an inventive step having regard to the disclosure of

D1: US-A-4 481 577.

In the decision, the Examining Division based its reasoning mainly on the argumentation already used in the only communication, dated 25 August 1992, wherein it had been stated that the features (a), (b) and (d) of the original Claim 1 were disclosed by D1. Also it considered that the new feature (c) was partly disclosed by one already cited part of D1 (procedure edprwarn, column 10, line 37 to column 11, line 10 was said to use an error message library or the local header table, which was considered as said text providing means).

With regard to the new precharacterising part of Claim 1, reference was also made to column 1, lines 42 to 55 of D1 and, moreover, in order to show that D1 also disclosed that **one event** is associated with a plurality of code points, which is apparently indicated in at least the features (a) and (d) of amended Claim 1, the Examining Division referred to the table edmsgtab{} written in C language and shown in columns 9 and 10 in D1, where, according to the Examining Division, it was obvious that the error numbers WED-024 and WED-025 were used together to identify a plurality of record names.

The Examining Division concluded that amended Claim 1 was distinguished from D1 only in that the event notification device was used in a **communication network**, whereas D1 disclosed a computer system wherein the events were produced by an editor program. However, it would be obvious for the skilled man, faced with the problem of extending the teaching of D1 to a communication network, to arrive at the subject-matter of Claim 1.

The Examining Division used the same cited parts of D1 against the method according to Claim 7 as had been used

against the device according to Claim 1. In the said single communication, it had been stated that the argumentation with regard to Claim 1 also applied to Claim 7. Thus, with regard to Claim 7, the Examining Division, in addition to the parts of D1 referred to in the said single communication, now also cited said table edmsgtab[] in C language in columns 9 and 10 of D1.

The Examining Division also expressed the opinion that the Applicant's statement, in the letter filed on 15 December 1992, to the effect that there was nothing in D1 either to suggest the association of a plurality of code points to an event or to indicate that several error numbers would correspond to a single event, was not correct, since said table in C language, in fact, disclosed that feature.

VI. An appeal was lodged against the decision on 5 April 1993 and the appeal fee was received on the same day. In support of the appeal, the Appellant inter alia stated in the grounds of appeal, filed on 3 June 1993, that

"despite the apparent uniqueness of these two message numbers (i.e. WED-024 and WED-025), and the complete lack of disclosure regarding how they could be operated, it is on the basis of an extensive interpretation of the only four lines of C language code where they appear that the Examining Division has based its decision to refuse the subject application".

The Appellant then analyses the interpretation of D1 by the Examining Division and comes to the conclusion that this is incorrect. Moreover, he states:

"Going well beyond the actual contents of the disclosure, the Examining Division has read into it several features that were suggested to the Division by

its knowledge of the invention and not by what directly and necessarily results from the disclosure itself."

The Appellant made the following request:

"The applicant therefore requests that the decision of the Examining Division be set aside and that a European patent be granted on the subject application."

### **Reasons for the Decision**

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments (Article 113(1) EPC). According to Article 96(2) the Examining Division "shall invite the Applicant, in accordance with the Implementing Regulations and as often as necessary, to file his observations within a period fixed by the Examining Division". Rule 51(2) of the Implementing Regulations reads: "In any invitation pursuant to Article 96, paragraph 2, the Examining Division shall, where appropriate, invite the Applicant to correct the disclosed deficiencies and, where necessary, to file the description, claims and drawings in an amended form." Rule 51(3) reads: "Any communication pursuant to Article 96, paragraph 2, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent."

Thus the Examining Division has to communicate the grounds against the grant of a patent to the Applicant

before refusing an application. In doing so it has to exercise its discretion to decide when it is deemed necessary and appropriate to invite the Applicant's comments. This has to be done objectively in the light of the circumstances of each case (T 162/82, OJ EPO 1987, 533, point 12).

This does not mean that the Applicant should be given repeated opportunity to comment on the same objections (T 161/82, OJ EPO 1984, 551; T 42/84, OJ EPO 1988, 251, point 12; T 243/89, point 5.1).

In a case where an Applicant has made a *bona fide* attempt to overcome the objections raised by the Examining Division, Article 113(1) may require such an attempt to be confirmed in the light of amended claims and substantial comments of the Applicant.

3. In the present case, the Examining Division, in dealing with Claims 1 to 10 as originally filed, started its first and only communication by citing the relevant references (in point 1) and continued by stating:

"2. The application does not meet the requirements of Article 84 EPC, because Claims 1 and 10 are not clear.

3. Furthermore, insofar as the present text can be understood, the subject-matter of Claims 1, 7 and 10 does not involve an inventive step, and therefore the requirements of Articles 52(1) and 56 EPC are not met."

The Examining Division then returned to the Article 84 issue mentioned in point 2 above and went on to say:



"4. The various definitions of the invention given in independent Claims 1 and 10 are such that the claims as a whole are not clear and concise, contrary to Article 84 EPC. The claims should be recast to include only the minimum necessary number of independent claims in any one category, Rule 29(2) EPC, with dependent claims as appropriate, Rule 29(4) EPC.

5. In the present case it is considered appropriate to use only one independent claim in any category."

The communication then continued by summarising, using the particular wording of the respective claims, those features of each of the independent Claims 1, 7 and 10 to be considered as known from D1. As has been mentioned under point V above, the communication identified parts of D1 which were considered to be relevant for the different features. It is observed that the communication under paragraph 8.1, when analysing the feature of Claim 10,

"table means containing a plurality of code points and associated descriptive information which are representative of an event",

in fact, referred to "the table in the C program edmsg.c of column 9, line 8 - column 10, line 26".

However, the Board also observes that this reference, apparently, is a general reference to the table as such. In its communication, the Examining Division did not indicate reasons why in its view the feature that one event could be associated with a plurality of code points is disclosed by that table.

In his reply to this communication (letter filed on 15 December 1992), the Appellant (then Applicant) deleted Claim 10, but at least partly introduced this feature into independent Claims 1 and 7, filed as part of a fresh set of Claims 1 to 10, having only one independent claim in each category (cf. under point IV above) and objected that he could find nothing in the table of columns 7, 8 and 9 of D1, nor anywhere else in D1, which would indicate that several error numbers would correspond to a single event.

The Board also notes that both independent Claims appear to be clear in the sense that they clearly define the device and the corresponding method. In fact, the Examining Division in its decision also acknowledged that the objection on the ground of lack of clarity had been overcome by the new set of claims (cf. under paragraph 3 in the first part of the decision).

The Board also notes that amended Claim 1 in comparison with original Claim 1 includes more technical features in that now also "means for receiving a plurality of code points" and "text providing means" are identified and the connection of these means to the index and the display means is given. The amended Claim 1 is related to original Claim 10 which, however, did not include the display feature and was not clear.

The Board, moreover, notes (as has been hinted above) that Claim 1 (indicated at least by features (a) and (d)) now defines a device that is concerned with events, each of which can be associated with a plurality of code points.

Also Claim 7 has been amended in a similar way. The features (a), (c) and (d) together disclose that the

method is concerned with events, each of which can be concerned with a plurality of code points.

In view of the foregoing, the Appellant (Applicant) tried to overcome all the objections mentioned in the Examining Division's only communication:

- by filing only two independent claims, one in each category, he met the objections under the cited points (4) and (5) above of the communication that the claims were numerous;
- by amending the wording and introducing new features he met the objection under cited paragraph 2 above as to clarity;
- by introducing new features, in particular the feature that one event can be associated with a plurality of code points, the Appellant (Applicant) from his point of view may have hoped to avoid a lack of inventive step objection against the combination of features of his new independent claims; this may be also derived from Applicant's letter, filed on 15 December 1992, wherein he emphasised that "there is nothing in D1 which suggests the association of a plurality of code points (or error numbers) to an event"

These are substantial amendments in the light of the objections raised by the Examining Division. They met the Article 84 objections and changed the subject-matter of the independent claims considerably. The effort by the Appellant (then Applicant) is therefore considered to represent a bona fide attempt to overcome these objections.

It seems to the Board that the feature that "~~one~~ event is associated with a plurality of code points" constitutes an essential feature of the invention as claimed.

The more particular reasoning for establishing that D1 also discloses this feature appears for the first time in the contested decision, e.g. under reasons 2.2 and 4.4. Thus, in effect, the Appellant did not have an opportunity to present his comments with regard to the grounds for refusal of the amended Claims 1 and 7 and/or did not get a possibility to file new claims or auxiliary requests. This is both necessary and appropriate in the light of Article 113(1) and Article 96(2) and the requirements according to Rule 51(2,3) EPC.

The Board, moreover, notes that the said reasoning presented for the first time in the decision relied on the said table given in a programming language (C language). It is true that the Board in a recent decision (T 164/92, to be published) has come to the result (against the opinion of an Examining Division) that program listings, when they are appended to publications in a normal (human) language which hint to the listings and when the listings also include words and expressions understandable for a non-programmer and, in particular, when these listings have been properly translated to a human language, have to be allowed into the proceedings under certain circumstances. Even in the present case, it appears that the part of D1 written in the C language could be allowed into the proceedings. Nevertheless, it appears that in such a case it is extremely important that an Examining or an Opposition Division before taking a decision ensures that the grounds and evidence in the form of a program on which the decision is relying has been communicated to the

Applicant or Patentee, so that the requirements of Article 113(1) are met. It may, e.g. be necessary for an Applicant or a Patentee to contact a programming expert in order to be able to understand a reference written in a programming language. Thus evidence used in the form of a document including programming language appears to emphasise the requirement according to Article 113(1) that the parties concerned must have had an opportunity to present their comments.

4. All this amounts to a substantial procedural violation which renders the contested decision void. The case has thus to be remitted to the Examining Division for further examination of the application (Article 10, Rules of Procedure of the Boards of Appeal, OJ EPO 1980, 171). This means here resumption of the examination on the basis of the requests as they stood when the contested decision was taken.
  
5. Since the Board has found the substantial procedural violation to be the ground for allowing the appeal, it finds it equitable to order reimbursement of the appeal fee in accordance with Rule 67 EPC.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The matter is remitted to the Examining Division for further examination of the application.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg