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D E C I S I O N
of 31 January 1995

Case Number: T 0355/94 - 3.5.1

Application Number: 88302641.1

Publication Number: 0290129

IPC: H04Q 11/04

Language of the proceedings: EN

Title of invention:
Data link controller

Applicant:
Advanced Micro Devices Inc.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 82, 56
EPC R. 46

Keyword:
"Late payment of search fee"
"Plurality of invention"

Decisions cited:
G 0002/92, T 0178/84

Catchword:



Case Number: T 0355/94 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 31 January 1995

Appellant: Advanced Micro Device Inc.
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Decision under appeal: Decision of the Examining Division of the European
Patent Office dated 8 November 1993 refusing
European patent application No. 88 302 641.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: A. S. Clelland
C. Holtz

Summary of Facts and Submissions

- I. European patent application No. 88 302 641.1 was filed on 25 March 1988 claiming a priority of 3 April 1987 and published under No. 0 290 129. A Partial Search Report was issued on 23 August 1989, with an invitation to pay a further search fee for a second invention claimed in Claims 2, 3 and 11 to 18 as filed. There was no response from the Applicant and the European Search Report covering only Claims 1 and 4 to 10 was issued on 30 November 1989.

The application was refused by a decision of the Examining Division dated 8 November 1993 on the ground that the claims for which the grant of a patent was requested included features which formed part of a second invention which had not been searched, no additional search fee having been paid after an invitation to do so had been issued. The Examining Division agreed with the finding of the Search Division that the originally filed claims lacked unity of invention, Article 82 EPC.

The European Search Report included the following document, cited against Claim 1 as filed:

D1: COMPCON 86, 3 to 6 March 1986, pages 70 to 75,
New York, US; P.E.WESTON: "IC solutions for ISDN".

- II. The independent claims on file read as follows:

"1. A data link controller (DLC) (52) comprising an internal, bidirectional port means (104) for high-speed serial receipt and transmission of signals, and interface means connected to an internal bus (58, 60, 62) for the connection of a microprocessor, said interface means comprising transmitter means (100, 102)

for parallel reception of data on said internal bus, for parallel-to-serial conversion thereof, and for serial generation thereof at said port means (104), and receiver means (106, 108) for serial reception of data on said port means (104) for serial-to-parallel conversion thereof and for parallel generation thereof on said internal bus;

wherein said transmitter means (100) includes a transmit byte register and counter means (152, 154) for receiving a transmit packet size for decrementing said transmit packet size and for generating a signal when said decremented count is zero, and FIFO transmit means (150) connected to said internal bus and to said port means for receiving in parallel data on said internal bus, storing a plurality of said data and generating therefrom for generation at said serial port means said most-recently stored data, wherein said FIFO transmit means comprises a plurality of registers (160) each having a plurality of bit positions, including a bit position for storing a signal indicative of the signal generated by said transmit byte register and counter means, thereby tagging a "least byte of packet of a transmit packet",

said transmitter means (102) further including status and control means (112, 212) connected to said internal bus, said interface means and said port means for receiving and generating a plurality of status signals and control signals, said status and control means including a plurality of status and control registers (112) operably connected to said interface means, each register of said plurality of registers comprising a plurality of bit storage locations arrayed in a least-significant to a most-significant order, each location of said plurality of locations representing a predetermined status condition of said data link controller and arrayed in said least-significant to most-significant order in proportion to said status

condition being most- to least- likely to occur, respectively,
an interrupt source register for storing in a predetermined bit position a receiver frame status signal and a plurality of delayed status reporting means receiving a minimum packet size signal and a flag detection signal for generating a status of received data packets on a packet-at-a-time basis."

"17. A data link controller (DLC) (52) having an internal, bidirectional port means (104) for high-speed serial receipt and transmission of signals, and interface means connected to an internal bus for the connection of a microprocessor, comprising transmitter means (100, 102) for parallel reception of data on said internal bus, for parallel-to-serial conversion thereof, and for serial generation thereof at said port means, and receiver means (106, 108) for serial reception of data on said port means for serial-to-parallel conversion thereof and for parallel generation thereof on said internal bus; further including status and control means (112, 212) connected to said internal bus, said interface means and said port means for receiving and generating a plurality of status signals and control signals, said status and control means including: a plurality of status and control registers (112, 212) operably connected to said interface means each register of said plurality of registers comprising a plurality of bit storage locations arrayed in a least-significant to a most-significant order, each location of said plurality of locations representing a predetermined status condition of said data link controller and arrayed in said least-significant to most-significant order in proportion to said status condition being most - to least - likely to occur, respectively, said receiver means further includes a FIFO receive register means (106) connected to said internal bus and

to said port means for receiving in parallel data received on said port means, storing a plurality of said data and generating therefrom on said internal bus said stored data;

said plurality of status and control registers further includes a FIFO status register comprising five of said bit storage locations of said plurality of location said least-significant thereof storing a received threshold reached status, a second least-significant location storing a received FIFO data available status, said FIFO receive register means is responsive to a receive threshold signal and wherein said FIFO receive register means further generates a data request signal, said FIFO receive register means includes FIFO receive buffer means (290) for storing said plurality of data received in parallel by said FIFO receive register means, for generating at a plurality of outputs signals representing said data received, and for generating a signal indication of the number of said plurality of said data stored therein; and data request generating means (296) responsive to said receive threshold signal and said signal indication of the number of said plurality of data stored in said FIFO receive buffer means for generating said data request signal,

said FIFO receive register means is further responsive to a last-byte-of-packet signal, wherein said FIFO receive buffer means further includes means for tagging each of said plurality of data stored therein as a last-byte-of-packet, and for generating a signal indicative of said tagged data stored therein,

wherein said data request generating means is further responsive to an absence of tagged data stored signal generated by said FIFO receive buffer means, said data request signal is generated when said receive threshold signal becomes equal to a predetermined value or said signal indicative of said tagged data is active,

wherein said FIFO receive register means further includes receive byte counter means (292, 294) responsive to said signal indicative of said tagged data stored in said FIFO receive buffer means and to said last-byte-of-packet signal for maintaining a count of the number of said data received by said FIFO receiver register means and for generating a signal indicative of said data received count when said data received by said FIFO receive register means is generated as an output of said plurality of outputs of said FIFO receive buffer means."

- III. On 3 January 1994 the Applicant lodged an appeal against this decision, and paid the appeal fee. A statement setting out the Grounds of Appeal was filed on 7 March 1994.
- IV. After a communication pursuant to Article 110(2) EPC giving preliminary assessment, the Appellant stated in a response received on 1 December 1994 that a divisional application had been filed, and asked that the Board issue a decision in the present case.
- V. In the Notice of Appeal the Appellant implicitly requests that the impugned decision be set aside and also requests that the application "proceed on the basis of the claims at present on file". This is understood to be a request for remittal to the Examining Division. In the Statement of Grounds refund of the appeal fee in the event that the examiner was prepared to offer the option of paying an additional search fee was also requested.

V. The Appellant argues as follows:

- (a) "In carrying out a search of Claim 1, the search report would cover all matters of a narrower scope than Claim 1, and would therefore automatically cover a combination of Claim 1 with any other feature, including the feature of Claim 2. We would argue, therefore, that the search as already carried out should have been sufficiently broad to cover the combination claim now on file."; and
- (b) "If the search carried out on Claim 1 did not cover the combination of Claims 1 and 2, then an additional search is required. Under part C of the "Guidelines for Substantive Examination" paragraph 6.8.5 [Chapter VI, paragraph 8.5] the circumstances under which an additional search might be required are set out and in particular it states that 'A systematic search will sometimes be required either at the first stage of amendment or subsequently. This may arise because ... the Search Division has not searched a particular part of the application because of objection of lack of unity of the invention ... or because the claims have been so amended that their scope is no longer covered by the original search'".

VI. The current application documents are:-

Claims:

1 to 5 and 6 (part) submitted 6 May 1993;
6 (part) and 7 to 17 submitted 13 August 1992.

Description:

pages 1 and 5 to 122 as filed;
pages 2, 3, 4, 4a and 4b submitted 13 August 1992.

Drawings:

sheets 1 to 21 as filed.

Reasons for the Decision

1. The appeal is admissible.
2. *Payment of additional search fees*
 - 2.1 Cases G 2/92 (OJ EPO 1993, 591 to 597) and T 178/84 (OJ EPO 1989, 157 to 166) set out the established jurisprudence of the Boards of Appeal.
 - 2.2 The decision of the Enlarged Board in G 2/92 was that "If the applicant chooses not to pay an additional search fee in respect of a further invention in response to an invitation from the Search Division ... he cannot thereafter put forward that invention as the subject of the claims in that application". Thus, an applicant who fails to pay the further search fees for a non-unitary application when requested to do so by the Search Division under Rule 46(1) EPC cannot pursue that application for the subject-matter in respect of which no search fees have been paid. Such an applicant must file a divisional application in respect of such subject-matter if he wishes to seek protection for it. The Enlarged Board also held that "a review of the correctness of the Search Division's request for an additional search fee is not in accordance with Rule 46 EPC on its proper interpretation". The present Board has accordingly no power to reopen this matter.
 - 2.3 The Appellant's argument that an additional paid search should have been carried out at the substantive examination stage is not therefore supported by the jurisprudence.

2.4 The passage at C VI 8.5 of the Guidelines for Examination cited by the Appellant relates to additional searches instructed by the substantive examiner and includes the condition, which the Appellant has not cited, that the examiner disagrees with the objection of lack of unity raised by the Search Division. This was not the case in the present application. The final proviso of the passage, that the requirement for an additional search may arise if the claims have been so amended that their scope is no longer covered by the original search, is separate from any objection of lack of unity and relates to the situation in which previously minor features have been brought in from the description.

3. *Claimed subject-matter*

3.1 The Board has however considered whether the present claims are, as suggested by the Appellant, in fact directed to subject-matter in respect of which search fees have been paid.

3.2 The Partial European Search Report identified two inventions corresponding to groups of original claims, namely 1, 4 to 10 and 2, 3, 11 to 18. Although an "X" document was cited (a document particularly relevant if taken alone), this objection was apparently made a priori, i.e. without taking the cited art into account. In the course of substantive examination the same objection was made by the Examining Division in the communication dated 14 February 1992. In the response new claims were filed but the objection was not explicitly contested.

3.3 The present set of claims includes two independent claims, Claims 1 and 17. Claim 1 includes all the subject-matter of each of original Claims 1 and 2 as

well as some of original Claim 14, whilst Claim 17 is based on original Claims 2, 3, 4, 9 and 10.

3.4 The Appellant argues that "in carrying out a search of Claim 1, the search report would cover all matters of a narrower scope than Claim 1". Thus, since original Claim 1 has been searched any claim incorporating the subject-matter of original Claim 1 must, on this argument, have been searched since the new claim must be narrower in scope.

3.5 However, the subject-matter of original Claim 1 was shown by the Examining Division in its communication of 14 February 1992 not to involve an inventive step having regard to the disclosure of the COMPCON 86 document (D1). This finding has not been contested by the Appellant either in the proceedings before the Examining Division or in the present appeal. Any invention must therefore lie in the newly introduced subject-matter. As an example the following feature may be mentioned: status and control registers with the arrangement of various status conditions in probability-dependent bit positions. This feature is included in both current independent claims and was explicitly excluded from the Partial European Search Report. Hence the Appellant is seeking to pursue the application for subject matter for which he declined the opportunity to pay an additional search fee when the Search Division requested him to do so.

3.6 The Board accordingly concludes that at least Claim 1 is directed to subject-matter for which search fees have not been paid.

4. *Refund of Appeal Fee*

4.1 The Appellant has indicated a willingness to withdraw the appeal if the Examiner is prepared to offer the option of paying an additional search fee. Refund of the appeal fee is requested in this case.

4.2 Once an application is refused the only discretion remaining to the Examining Division is to allow or refuse interlocutory revision in accordance with Article 109 EPC, sub-paragraph (1) of which starts by stating:-

"If the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision".

Interlocutory revision can therefore only be allowed if the appeal is well-founded; implicitly this requires that any valid substantive objections raised in the appealed decision have been met.

4.3 However, it follows from paragraphs 2.1 to 2.3 above that once the Search Division's request for additional fees was not met there was no subsequent mechanism by which this fee could have been paid; it was thus never open to the Examining Division to rectify its decision.

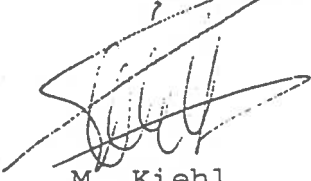
4.4 There is therefore no legal basis for a refund of the appeal fee.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:



M. Kiehl

The Chairman:



P. K. J. van den Berg

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