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D E C I S I O N
of 17 October 1995

Case Number: T 0478/94 - 3.5.1

Application Number: 88901461.9

Publication Number: 0300061

IPC: H04L 11/20

Language of the proceedings: EN

Title of invention:
Self-routing switching system

Applicant:
FUJITSU LIMITED

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 111(1)
EPC R. 67

Keyword:
"Substantial procedural violation (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 0478/94 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 17 October 1995

Appellant:

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Decision under appeal:

Decision of the Examining Division of the European
Patent Office dated 28 January 1994 refusing
European patent application No. 88 901 461.9
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. The Appellant contests the decision of the Examining Division, given at oral proceedings held on 6 October 1993, refusing European patent application No. 88 901 461.9, Publication No. 0 300 061.
- II. The reason given for the refusal in the written Decision dispatched on 28 January 1994 was that the subject-matter of the independent claim of a main and two auxiliary requests was held not to involve an inventive step, having regard primarily to the disclosure of the following document:

D1: IEEE Journal on Selected Areas in Communications, volume SAC-4, no. 8, November 1986, IEEE, New York, US, pages 1373 to 1380; J. S. TURNER: "Design of an integrated services packet network".

The claimed features not disclosed in D1 were held to be obvious in view of the following documents:

D4: IEEE Global Telecommunications Conference, Atlanta, Georgia, 26 to 29 November 1984, IEEE, New York, US, pages 105 to 113; R. J. MCMILLEN: "A survey of interconnection networks";

D5: The 5th International Conference on Distributed Computing Systems, Denver, Colorado, 13 to 17 May 1985, IEEE, New York, US, pages 210 to 217; S. M. REDDY et al.: "On multipath multistage interconnection networks";

D8: 1986 International Zurich Seminar on Digital Communications, 11 to 13 March 1986, IEEE, New York, US, pages 141 to 148; P. GONET et al.: "Asynchronous time-division switching: the way to flexible broadband communication networks".

III. D8 is not mentioned in the application file before the written decision; in particular, there is no indication in the minutes of the oral proceedings that it was discussed there. The section of the decision in which it is cited (II.2.c) reads as follows:

"The system of claim 1 is further different from the system disclosed in D1 in that it includes the features relating to the distinction between a call setting and a call transfer phase (claim 1, paragraph 3).

However, the path selection procedure commonly used in ATM systems and called 'virtual connection' already includes these features (e.g. International Zurich Seminar on Digital Communications March 11-13, 1986 D5.1-D5.8, page 141 to 148).

The design of ATM systems is common general knowledge and therefore, these features of claim 1 do not involve an inventive step."

IV. On 28 March 1994 the applicant lodged an appeal against this decision and paid the appeal fee. On 30 May 1994 a statement setting out the grounds of appeal was filed, together with amended sets of claims. The statement included arguments that a procedural violation had occurred and made the requests that the appeal fee be refunded and the examination resumed.

V. Oral proceedings took place before the Board on 17 October 1995. The Appellant requested remittal of the case for further consideration by the Examining Division.

VI. The Appellant argued essentially as follows in support of the main request:

A critical aspect of the invention was the introduction of the two distinct call phases, call setup and call transfer, into an Asynchronous Transfer Mode (ATM) system. The Examining Division had asserted in the oral proceedings that these two phases had been common knowledge in the context of ATM systems at the relevant date. During the oral proceedings no document proving this had been put forward, but it had been stated that various documents showed this assertion to be true and that one would be cited to illustrate this fact in the written decision. However, document D8, referred to in the written reasons to cover this point, in fact did not relate to ATM systems and further did not show the two distinct phases of a call defined in the refused claim. Hence, had the document been put forward before the decision was announced, as it should have been, the Appellant would have been able to refute the arguments of the Examining Division. There had thus been a clear violation of Article 113(1) EPC.

It was further argued that the statement in the Appellant's submission received 30 December 1994, that D8 had been "first mentioned during oral proceedings on October 6, 1993", had been an error.

Reasons for the Decision

1. The appeal is admissible.
2. Having examined the file and questioned the Appellant's representative, the Board concludes that document D8 was indeed cited in the written decision for the first time in the proceedings before the Examining Division. No reference to this document occurs in the minutes of the oral proceedings; nor is it mentioned in the Summary of Facts and Submissions in the written decision. The Appellant's representative has stated that it was not mentioned and that the contrary statement in the submission received 30 December 1993 was made in error; the Board notes that the reference in this submission to the citation being mentioned in the oral proceedings contradicts the position which the Appellant has otherwise consistently held.
3. The Examining Division's finding of lack of inventive step is primarily based on the disclosure of D1; it was considered obvious to modify the routing network known from D1 to provide a "multipath speech path" as known from D4 and D5. Not disclosed by this combination were said to be features relating to the distinction between the call setting and call transfer phases and also the setting of an "optimum path" through the network.
4. It appears that D8 was introduced by the Examining Division in support of an assertion that the former feature - the call setting and call transfer phases - was common general knowledge. In fact, the relevant passage at point 2(c) of the written Decision makes three separate interrelated assertions, namely (in logical sequence) that: (1) The design of ATM systems was - at the claimed priority dates - common general

knowledge; (2) a path connection procedure known as "virtual connection" was commonly used in ATM systems; and (3) "virtual connection" includes the features claimed relating to the distinction between a call setting and a call transfer phase.

5. The fact that the decision cites D8 only as an example ("e.g. International Zurich ...") may indicate that the Examining Division felt that its assertions could be established from a variety of sources; it may on the other hand be that the Examining Division considered the points so notorious that it was unnecessary to cite a reference at all. Whatever the Examining Division's motivation, the Board is unable to derive from D8 the conclusion that facts said to be known from it were common general knowledge. It therefore takes the view that the assertions noted at point 4 above have not been backed up by adequate evidence and in consequence that the Examining Division's conclusion that the subject-matter of the independent claims did not involve an inventive step is unsupported. Moreover, as noted above, the Appellant has not been given the opportunity to comment on the contents of D8.

6. However, the mere absence of evidence supporting a link in the chain of reasoning cannot, on the facts of the present case, be seen as a substantial procedural violation in the sense of Rule 67 EPC, as opposed to an error of judgement. The Board considers that a refund as requested by the Appellant in the statement of grounds would not therefore be equitable. In view of this error of judgement however the Board considers it appropriate to remit the case for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

M. Kiehl

The Chairman:

P. K. J. van den Berg