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Datasheet for the decision of the Enlarged Board of Appeal of 8 July 2013

Case Number: R 0017/12

Appeal Number: T 0501/11 - 3.5.03

Application Number: 99903846.6

Publication Number: 1077007

IPC: H04Q 7/32, H04B 1/38

Language of the proceedings: EN

Title of invention:
Improved GSM cellular terminal

Patent proprietor:
S.I.SV.EL. Societa Italiana per lo Sviluppo dell'Elettronica S.p.A.

Opponent:
Nägerl, Joël

Headword:
-

Relevant legal provisions:
EPC Art. 112a(2)(c), 113
EPC R. 106, 109(2)(a)

Keyword:
"Petition for review - not clearly inadmissible - clearly unallowable"
"Violation of right to be heard"

Decisions cited:
R 0002/08, R 0012/09, R 0015/10

Europäisches Patentamt | European Patent Office | Office européen des brevets

Große Beschwerdekammer | Enlarged Board of Appeal | Grande Chambre de recours

Case Number: R 0017/12

D E C I S I O N
of the Enlarged Board of Appeal of 8 July 2013

Petitioner: (Patent Proprietor)
S.I.SV.EL.
Societa Italiana per lo Sviluppo dell'Elettronica S.p.A.
Via Sestriere 100
I-10060 None (TO) (IT)

Representative:
Dini, Roberto
Metroconsult S.r.l.
Via Sestriere 100
I-10060 None (TO) (IT)

Other Party: (Opponent)
Nägerl, Joël
Zimmermann & Partner
Josephspitalstr. 15
D-80331 München (DE)

Representative:
Zimmermann & Partner
Postfach 330 920
D-80069 München (DE)

Decision under review: **Decision of the Technical Board of Appeal 3.5.03 of the European Patent Office of 11 July 2012.**

Composition of the Board:

Chairman: W. van der Eijk
Members: G. Weiss
G. Eliasson

Summary of Facts and Submissions

I. The petition for review concerns decision T 501/11 of Board of Appeal 3.5.03 revoking the patent.

II. The proceedings in case T 501/11 can be summarised as follows:

(a) Appeals were filed by the patent proprietor and the opponent against the decision of the opposition division to maintain the patent in amended form. After the written phase of the appeal proceedings, Board of Appeal 3.5.03 summoned the parties to oral proceedings scheduled to take place on 11 July 2012.

(b) In reaction to the remarks made by the Board of Appeal in the annex to the summons to oral proceedings, the patent proprietor filed with letter dated 11 June 2012 new sets of claims, and especially the "5th auxiliary request" to "11th auxiliary request". The fifth auxiliary request corresponds to the set of claims maintained by the opposition division.

(c) Oral proceedings were held on 11 July 2012 before the board. At the end of the oral proceedings the board announced that the decision under appeal was set aside and that the patent was revoked. The reasoned decision T 501/11 was notified to the parties by registered letter with advice of delivery on 3 August 2012.

III. The invention concerns a GSM cellular terminal with a plurality of SIM card readers. The object of the invention is to provide a GSM cellular terminal which is apt to allow a simultaneous use in transceiving mode of at least two service types associated with respective SIM cards (cf. the patent specification, paragraphs 0001 and 0010).

IV. On 12 October 2012 the patent proprietor (referred to below as the petitioner) filed a petition for review of this decision pursuant to Article 112a EPC. The corresponding petition fee was paid on the same day. The petition was based on the ground referred to in Article 112a(2)(c) EPC, namely that a fundamental violation of Article 113(1) EPC had occurred in the appeal proceedings.

V. On 24 April 2013, as an annex to the summons to oral proceedings, a communication was issued informing the petitioner of the provisional view of the Enlarged Board of Appeal.

VI. With letter dated 10 June 2013 the petitioner filed submissions taking account of the provisional view of the Enlarged Board of Appeal.

VII. Oral proceedings before the Enlarged Board of Appeal in its composition pursuant to Rule 109(2)(a) EPC took place on 8 July 2013.

VIII. The petitioner's arguments as put forward in the petition can be summarised as follows:

Concerning the admissibility of the petition

The board had considered Figure 1 of the revoked patent as prior art according to Article 54 EPC for arguing the lack of inventive step of claim 1 of the fifth auxiliary request. This state of the art combined with the document E2 was raised for the first time in the decision. Thus, the petitioner had become aware of this highly relevant line of argumentation of the board, on which the decision revoking the patent was based, only when reading the decision. Thus, no objection under Rule 106 EPC could have been raised at an earlier stage.

Concerning the allowability of the petition

The petition only concerns the violation of the right to be heard by the Board's assessment of the fifth auxiliary request (which corresponds to the set of claims maintained by the opposition division) as well as the sixth to twelfth auxiliary requests.

– The reasoning made by the Board in its written decision for arguing the lack of inventive step of claim 1 of the fifth auxiliary request was strongly based on Figure 1 of the revoked patent (see paragraph bridging page 12 and 13 of the decision, paragraph bridging page 13 and 14 of the decision and paragraph bridging page 14 and 15 of the decision). The combination of document E2 with Figure 1 of the revoked patent by the Board as state of the art according to Article 54(2) EPC

and raised for the first time in the written decision was never discussed before. Furthermore, it had never been discussed whether or not Figure 1 of the revoked patent belonged to the prior art according to Article 54(2) EPC. The Board of appeal had surprisingly based its decision of revoking the patent on the features outlined by Figure 1. The Board had the duty to discuss in its turn the issue of Figure 1 either in the summons to the oral proceedings or in the oral proceedings, if the Board intended to combine Figure 1 with other prior art documents. Such discussion was never held, thereby resulting in a violation of the petitioner's basic procedural rights. In this respect affidavits signed by the persons who attend the oral proceedings had been filed.

- From the excerpts of the description of the revoked patent it could not be derived that Figure 1 of the revoked patent was prior art according to Article 54(2) EPC. On the contrary Figure 1 was an internal prior art known only to the applicant and to the inventors designated in the revoked patent.
- The jurisprudence of the Boards of appeal confirmed that art which was known to the applicant but which was not public at the claimed priority date must be ignored in the assessment of inventive step. Therefore, the assessment of inventive step could not be made by combining a prior art document with an internal prior art like Figure 1 of the revoked patent.
- There was never any statement, neither in written nor orally, by the opponent, alleging that

Figure 1 of the revoked patent was pre-published prior art. There was never any attack by the opponent starting from one document in combination with Figure 1 of the revoked patent. The Board in its written decision constructed a case which was never the subject of any written proceedings or oral discussion. The Board never mentioned to discuss the combination of document E2 with the Figure 1 or to consider Figure 1 and the description thereto as published knowledge of the skilled person.

- Also a combination of document E2 with Figure 1 considered as general common knowledge would still represent a fundamental violation of Article 113 EPC.
- Since the assessment of the inventive step of claim 1 of the fifth auxiliary request is incorrect, this also applies for the assessment of the inventive step of claim 1 of the sixth to twelfth auxiliary requests. Furthermore, the eleventh auxiliary request was refused in the decision by citing Figure 1 of the revoked patent (see paragraph 5.2 of the decision). Also to this regard, the petitioner had become aware of this line of argumentation only when reading the decision.

IX. Taking account the observations made by the Enlarged Board of Appeal in its annex to the summons to oral proceedings, the petitioner has completed its arguments during the oral proceedings as follows:

- It was a fair way, as the Enlarged Board expressed in its communication, to consider Figure 1 as "an illustration" of the common general knowledge;

however, the proprietor (petitioner) had no reasons to argue with general common knowledge and this issue was never discussed. Also such an issue would need to be substantiated, but the petitioner had no chance to argue on this crucial holding. The Board made no indications that the decision would be based on document E2 combined with common general technical knowledge. Thus, the reasons given in the written decision could only take the petitioner by surprise.

- Although the Board of Appeal has to respect the principle of neutrality above all in inter-partes cases, the right to be heard in the present case would have required the Board to inform the petitioner that Figure 1 was considered to represent common general technical knowledge. This was not the case.
- The opponent had in his statement of grounds of appeal alleged that the features v) and vi) were implicitly known from document E2. The proprietor disputed that these features were commonly known. A discussion whether the features v) and vi) were part of common general knowledge in the art never took place. It is also disputed that implicit features of a prior art document necessarily would belong to common general knowledge, as the assessment of novelty would be fundamentally different from that of assessing inventive step.
- Although the summons referred to the issue of inventive step with respect to "E2 alone", this only applied to auxiliary requests 1 to 4 filed with the proprietor's statement of grounds of appeal, none of which corresponded to auxiliary request 5 considered in the decision under review.

– Since Figure 1 of the patent was never discussed before in the appeal proceedings, the board and not the proprietor would have had the duty to inquire at the oral proceedings whether or not Figure 1 represented prior art.

X. The petitioner requested that decision T 501/11 to revoke the patent be set aside and the proceedings be re-opened before the Board of appeal.

Reasons for the decision

1. Admissibility of the petition for review

1.1 The petitioner is adversely affected by decision T 501/11-3.5.03 revoking the patent. The petition for review was filed on the ground referred to in Article 112a(2)(c)EPC. The petition therefore complies with the provisions of Article 112a(1)and (2) EPC.

1.2 The written decision was notified to the parties by registered letter with advice of delivery posted on 3 August 2012. The two-month period for filing the petition for review expired on 15 October 2012 (13 October 2012 is a Saturday; time limit extended, Rule 134(1) EPC). As the petition was filed and the fee was paid on 12 October 2012, it also complies with Article 112a(4) EPC. The other conditions in relation to the contents of the petition as foreseen in Article 112a(4) in conjunction with Rule 107 EPC are also fulfilled.

1.3 No objection under Rule 106 EPC was raised during the appeal proceedings. This poses the question of whether the exception in Rule 106 EPC applies.

1.4 The present petition is based on the allegation that the reasoning made by the Board in its written decision for arguing the lack of inventive step of claim 1 of the fifth auxiliary request is strongly based on Figure 1 of the revoked patent (see paragraph bridging page 12 and 13 of the decision, paragraph bridging page 13 and 14 of the decision and paragraph bridging page 14 and 15 of the decision). The combination of document E2 with Figure 1 of the revoked patent belonging in the Board's decision to the state of the art according to Article 54(2) EPC was raised for the fist time in the decision of the board of appeal. Therefore the petitioner could not have raised any objection (Rule 106 EPC) during the appeal proceedings. The petitioner has become aware of this line of argumentation of the Board of appeal only when reading the decision.

Therefore, the exception under Rule 106 EPC applies.

1.5 The petition for review is therefore not clearly inadmissible.

2. *Allowability of the petition for review*

2.1 In the present case the petitioner argues that the board committed two fundamental violations of Article 113 EPC which justify a re-opening of the appeal proceedings. Firstly the board's decision based its finding of lack of inventive step on a combination

of document E2 with the "prior art" device illustrated in Figure 1 of the patent in suit, although this combination was never discussed in the appeal proceedings. Secondly, the question whether or not the device shown in Figure 1 of the patent belongs to the prior art was never raised in the oral proceedings before the board. Hence the petitioner was not given the opportunity to clarify that Figure 1 represented internal prior art known to the applicant only and not available to the public. This was already indicated by the fact that the petitioner had made the request with the statement of the grounds of appeal to delete any passages in the patent specification which could suggest that Figure 1 would represent public prior art within the meaning of Article 54(2) EPC. Established case law made it clear that internal state of the art must be ignored in the assessment of inventive step.

2.2 As the petitioner correctly notes, the decision under review refers to Figure 1 of the patent in suit three times when discussing the fifth auxiliary request, and once with regard to the eleventh auxiliary request. The appellant alleges that the issue whether the content of Figure 1 belonged to the prior art or not was never discussed in the appeal proceedings. The issue whether or not Figure 1 of the patent represents public prior art is only relevant if the decision under review bases its finding of lack of inventive step on Figure 1 of the patent. It is therefore important to establish the context in which Figure 1 of the patent in suit was referred to in the decision under review.

2.3 In its decision, the board held that the subject matter of claim 1 of the first auxiliary request did not

involve an inventive step over document E2 alone, i.e. in combination with general technical knowledge of the skilled person (reasons, 1).

2.4 As the main request and the second to fourth auxiliary requests had been withdrawn by the proprietor, the decision went on to assess inventive step on the fifth auxiliary request (facts and submissions, IX; reasons, 2). Claim 1 of the fifth auxiliary request is identical to claim 1 as maintained by the opposition division. The board noted that with respect to the first auxiliary request, claim 1 of the fifth auxiliary request contained three further features, labelled iv), v) and vi), respectively (reasons, 2.1). Out of these three further features, feature iv) was found to be known from document E2 (reasons, 2.2, first paragraph).

2.5 Concerning the two remaining features v) and vi), the board noted that feature v) ("the control means comprise program memory means associated with a management program of the two SIM card readers and of the corresponding signal reception and transmission means") represented a well-known measure at the priority date of the patent in suit. In this respect, the board made the following reference "(cf. the patent in suit, Figs 1, which shows a block diagram of a GSM cellular terminal according to the prior art, which includes a control block including a microcontroller unit J, a key board unit K, ROM program memory unit M and EEPROM memory O)" (reasons, 2.2, end of the second paragraph). A further reference to Figure 1 of the patent with regard to feature v) occurs later in the decision dealing with the proprietor's argument as to which further functionalities the control means for the

switching means could take on ("(see the patent in suit, Fig. 1, power controller C connected to microcontroller unit J)") (reasons, 2.4, last paragraph). The latter reference to Figure 1 was made to illustrate that not only were certain further functionalities of the control means already foreseen in document E2 but that such an arrangement was commonplace in the art.

2.6 As to feature vi) ("the control means comprise a keyboard unit, which has an additional keyboard segment adapted to transmit signals being apt to switch among the two SIM cards") the board noted that also this feature represented a well-known measure at the priority date of the patent in suit and made a similar reference to the patent in suit: "(Cf. the patent in suit, Fig. 1, keyboard unit K)" (reasons, 2.2, fourth paragraph).

2.7 Hence, the Enlarged Board of Appeal judges that the decision to reject the fifth auxiliary request was based on a finding of lack of inventive step over document E2 in combination with common technical knowledge in the art. The references to Figure 1 of the patent only serve the purpose of illustration. This was admitted by the petitioner during the oral proceedings.

2.8 The petitioner argued further that in case the Enlarged Board would come to the conclusion that the inventive step assessment was based on document E2 combined with common general knowledge, this would still represent a fundamental violation of Article 113 EPC, since the alleged common general knowledge had not been discussed neither during the opposition proceedings nor during the appeals proceedings.

2.9 It is however noted that the above features v) and vi) were discussed by the appellant opponent in his statement of grounds of appeal when alleging that the subject matter of claim 1 as maintained (i.e. claim 1 of the fifth auxiliary request) lacked novelty over document E2. The opponent argued in particular that document E2 implicitly disclosed features v) and vi) (cf. opponent's statement of grounds, page 9, third to sixth paragraphs discussing feature v) (labelled "4" by the opponent); page 10, section "The features 5 and 5.1" discussing feature vi) (labelled "5.1" by the opponent)). Similarly, the opponent argued before the opposition division that the above features v) and vi) were implicitly disclosed in document E2 (see the decision under appeal, reasons 27.1).

The petitioner argued before the Enlarged Board that the issue whether a feature is implicitly disclosed in a prior art document was fundamentally different from the question whether the feature in question formed part of the common general knowledge of the skilled person. Without going into a discussion on the validity of the petitioner's argument in general, the Enlarged Board is not convinced by this argument in the present case where the alleged implicit features v) and vi) are elements of a device. An assertion that a particular feature is implicitly disclosed in a description of a device means that an argument is put forward that the skilled person, at the stage of reading the disclosure or while attempting to reproduce its teaching, would inevitably consider this very feature to be included in the device. Such an argument, however, is made under the (usually tacit) presumption that the skilled person

must be aware of the existence of the alleged implicit feature as such, i.e. the feature in question has to be commonly known in the art.
It its reply dated 26 September 2011, the petitioner replied to the grounds of appeal filed by the opponent. The petitioner argued that the features v) and vi) ("4" and "5 and 5.1", respectively) were not implicitly disclosed in document E2, since alternative means were conceivable, thus arguing that features v) and vi) were not inevitable to the skilled person reading document E2. The petitioner, however, did not contest the contention that features v) and vi), as such, were commonly known in the art.

From the above it follows that the issue whether features v) and vi) were commonly known in the art was raised in the appeals proceedings at least by the opponent in his statement of grounds.

It has also to be noted that at the stage of proceedings when the summons to oral proceedings were issued, none of the proprietor's requests on file corresponded exactly to the set of claims as maintained by the opposition division. The communication accompanying summons to oral proceedings dealt mainly with issues of admissibility of the requests and added subject matter. There is however an indication by the board that the issue of inventive step over document "E2 alone" could arise at the oral proceedings pending the outcome of the other issues, this implying that common general technical knowledge would be taken into account (cf. communication, 5.2).

2.10 Since the decision does not rely on a combination of document E2 and Figure 1 of the patent, but on a combination of document E2 and common technical knowledge in the art, and the issue of whether or not features v) and vi) belonged to the common general technical knowledge had been raised in the appeal proceedings, a fundamental violation of Article 113 EPC cannot be established. The same finding applies to the reference to Figure 1 made in connection with the eleventh auxiliary request (reasons, 5.2). This passage also states that the feature in question (display) was common in the art at the priority date.

2.11 In general terms the Enlarged Board would like to point out that the petitioner (proprietor) and its representative were responsible for the conduct of their case and it was for them to submit the necessary arguments to support their case on their own initiative and at the appropriate time (see R 2/08 of 11 September 2008, points 8.5 and 9.10 of the Reasons). If the petitioner was surprised in the present case by reading the decision and noting the references to Figure 1, such surprise may be an understandable subjective reaction but such subjective surprise cannot change the fact that the petitioner knew the issues which might be raised and had an adequate opportunity to comment thereon (see R 12/09 of 15 January 2010, point 13 of the Reasons; and R 15/10 of 25 November 2010, point 11 of the Reasons).

Order

For these reasons it is decided unanimously that:

The petition is rejected as clearly unallowable.

The Registrar: The Chairman:

P. Martorana W. van der Eijk