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**Datasheet for the decision  
of 8 January 2009**

**Case Number:** T 0091/08 - 3.5.03

**Application Number:** 93302420.0

**Publication Number:** 0562890

**IPC:** H04Q 7/32

**Language of the proceedings:** EN

**Title of invention:**

Mobile communication network with remote updating of  
subscriber identity modules in mobile terminals

**Patentee:**

ORANGE PERSONAL COMMUNICATIONS SERVICES LIMITED

**Opponent:**

SWISSCOM MOBILE AG

**Headword:**

Mobile communication network/ORANGE

**Relevant legal provisions:**

EPC Art. 113(2)  
EPC R. 103(1)(a)

**Relevant legal provisions (EPC 1973):**

EPC R. 58(4), (5)

**Keyword:**

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**Decisions cited:**

T 0601/02

**Catchword:**

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Case Number: T 0091/08 - 3.5.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.03  
of 8 January 2009

**Appellant:** ORANGE PERSONAL COMMUNICATIONS SERVICES  
(Patent Proprietor) LIMITED  
St. James Court  
Great Park Road  
Almondsbury  
Bristol BS12 4QJ (GB)

**Representative:** Spaargaren, Jerome  
Electronic Intellectual Property  
Fairfax House  
15 Fulwood Place  
London WC1V 6HU (GB)

**Respondent:** SWISSCOM MOBILE AG  
(Opponent) Viktoriastrasse 21  
CH-3050 Bern (CH)

**Representative:** Saam, Christophe  
Patents & Technology Surveys SA  
Rue des Terreaux 7  
Case Postale 2848  
CH-2001 Neuchâtel (CH)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 26 October 2007  
maintaining European patent No. 0562890 in  
amended form pursuant to Article 102(3) EPC  
1973.

**Composition of the Board:**

**Chairman:** A. J. Madenach  
**Members:** R. Moufang  
F. van der Voort

## Summary of Facts and Submissions

- I. This is the second appeal in the opposition proceedings concerning European patent No. 0 562 890. In the first appeal proceedings (T 601/02), this board, in a different composition, decided to remit the case to the department of first instance with the order to maintain the patent on the basis of claims 1 to 5 of the proprietor's main request.
  
- II. Upon remittal the opposition division immediately sent out a communication under Rule 58(5) EPC 1973 requesting the proprietor to pay the printing fee for the printing of a new specification and to file translations of the claims in the two other official languages of the EPO. As an annex to the communication, the opposition division attached a copy of the documents for the maintenance of the patent as amended, consisting of pages 2 to 5 of the description, claims 1 to 5 and figures 1 to 3c. The description contained handwritten amendments on page 2 and did not include the amendments according to the replacement pages 1, 2A, 2B and 2C which were filed by the proprietor on 19 September 2006 during the first appeal proceedings (see section VIII of decision T 601/02).
  
- III. The proprietor paid the printing fee and filed the translations of the claims as requested in the above communication. On 19 October 2007 the opposition division handed over to the internal EPO postal service its decision to maintain the patent in amended form. It was stated in the decision that the maintenance was "based on the documents as specified and notified previously".

- IV. By fax letter dated 23 October 2007, i.e. three days before the decision was dispatched to the parties on 26 October 2007, the proprietor requested a correction of the amended specification either under Rule 88 or Rule 89 EPC 1973. With a communication dated 7 December 2007 of a formalities officer of the EPO acting on behalf of the opposition division, this request was refused. On 4 January 2008, the same formalities officer sent out a further communication stating: "We confirm that your request for correction sent on 23.10.2007 has been accepted and that the patent specification will be reprinted in due time."
- V. On 7 January 2008 the proprietor filed an appeal against the decision dated 26 October 2007 to maintain the patent in amended form. It requested that the decision be cancelled and that, due to the incorrect and unapproved text of the documents on which the decision was based, the appeal fee be reimbursed. On 5 March 2008 the appellant filed its grounds of appeal setting out reasons why the appeal should be allowed and requesting an expedited handling of the case.
- VI. In a communication dated 4 September 2008 the board informed the parties about its preliminary view according to which the appeal was admissible and, due to a substantial violation of the procedural principles enshrined in Article 113(2) EPC, the contested decision had to be set aside and the appeal fee must be reimbursed.
- VII. By fax letter dated 10 November 2008, the respondent requested that the appeal be allowed in order to arrive

again at the text of the description to which both parties had agreed in the first appeal proceedings.

## **Reasons for the decision**

### *Admissibility of the appeal*

1. The appeal is admissible. The appellant is adversely affected by the contested decision which did not take into account the amended description as submitted by the appellant during the first appeal proceedings. The appellant cannot be treated as having implicitly approved the description referred to in the contested decision since the procedure followed by the opposition division was defective. After having made amendments to the description which did not correspond to the amendments submitted by the proprietor, the opposition division was legally obliged to observe the procedure provided for in Rule 58(4) EPC 1973 and could not "skip" one step by immediately requesting the appellant to pay the printing fee and to file translations of the amended claims according to Rule 58(5) EPC 1973.
  
2. The communication dated 4 January 2008 according to which the "request for correction was accepted" did not retroactively remove the adverse effect of the decision. This communication, which is in contradiction with the previous communication dated 7 December 2007, contains neither reasons nor an indication of its legal basis and was sent out without having heard the other party. Thus, the legal nature of the communication is far from being clear, and it cannot be regarded as a decision unambiguously rectifying the contested decision.

*Allowability of the appeal*

3. As already set out above, the contested decision was taken on the basis of an amended description which was not approved by the appellant. This amounts to a substantial violation of the procedural principles enshrined in Article 113(2) EPC. Thus the contested decision has to be set aside and the appeal fee is to be reimbursed according to Rule 103(1)(a) EPC.

*Further procedure*

4. In order to expedite the procedure and to obviate the need for a communication under Rule 82(1) EPC by the opposition division after remittal, the board notes that the amendments to the description as submitted by the appellant during the first appeal proceedings and as agreed upon by the respondent are correctly adapted to the amended claims. The documents on which the patent is to be maintained are specified in the following order.

**Order**

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

1. The decision under appeal is set aside.
  
2. The case is remitted to the department of first instance with the order to maintain the patent in amended form on the basis of the following documents:

Description: Description of the patent as granted with the amendments according to pages 1, 2A, 2B, 2C filed with the proprietor's letter dated 19 September 2006;

Claims: Claims 1 to 5 of the Main Request filed with the proprietor's letter dated 19 September 2006; and

Drawings: Figures 1, 2, 3a, 3b and 3c of the patent as granted

3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

D. Magliano

A. J. Madenach