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**Datasheet for the decision
of 12 May 2010**

Case Number: T 0690/09 - 3.5.05

Application Number: 03020725.2

Publication Number: 1420561

IPC: H04L 29/06

Language of the proceedings: EN

Title of invention:

System and method for TCP offloading and uploading

Applicant:

Broadcom Corporation

Headword:

TCP offloading and uploading/BROADCOM

Relevant legal provisions:

EPC Art. 97(2), 113(1), 123(1)

EPC R. 78(1)(a), 137(3)

RPBA Art. 11

Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000 - Art. 1(1)

Decision of the Administrative Council of 7 December 2006 - Art. 2

Relevant legal provisions (EPC 1973):

EPC Art. 111(1), 113(1) and (2)

EPC R. 67

Keyword:

"Appealed decision based on sets of claims which were neither submitted, nor agreed by the applicant (yes)"

"Correctness of the minutes of the oral proceedings before the first instance challenged at a late stage in the appeal proceedings"

"Substantial procedural violation (yes)"

"Remittal to the department of first instance (yes)"

"Reimbursement of the appeal fee (yes)"

Decisions cited:

G 0012/91, G 0007/93, R 0011/08, J 0010/07, T 0640/91,
T 0647/93, T 0237/96, T 0946/96

Catchword:

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Case Number: T 0690/09 - 3.5.05

D E C I S I O N
of the Technical Board of Appeal 3.5.05
of 12 May 2010

Appellant: Broadcom Corporation
5300 California Avenue
Irvine, CA 92617 (US)

Representative: Jehle, Volker Armin
Bosch Jehle Patentanwaltsgesellschaft mbH
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 22 October 2008
refusing European patent application
No. 03020725.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: D. H. Rees
Members: M. Höhn
G. Weiss

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division dispatched 22 October 2008, refusing European patent application No. 03020725.2.

II. Procedure before the first instance

The original set of claims comprised 23 claims (system claims 1-17 with claim 1 being independent; method claims 18-23 with claim 18 being independent).

Following a first communication in which the set of claims was objected to because of lack of novelty and lack of clarity, the applicant filed an amended set of claims 1-5 with letter dated 7 July 2005 (comprising two independent system claims 1 and 5, but no method claims). Following a second communication in which objections were raised for lack of novelty of claim 5, lack of inventive step of claim 1, lack of clarity and failure to fulfil the requirements of Article 123(2) EPC for claims 2 and 5, the applicant filed another amended set of claims 1 to 26 with a letter dated 20 December 2006 (comprising system claims 1 to 18 and 24 to 26 with claim 1 being independent, as well as method claims 18 to 23 with claim 18 being independent).

In a third communication this amendment was not accepted under Rule 86(3) EPC 1973 applicable at that time (now Rule 137(3) EPC) as the new claims were not based on the last examined set of claims, because they reintroduced deficiencies already removed by the applicant, because there was a substantial increase in the number of claims and because new deficiencies under Article 123(2) EPC were introduced into claims 1 and 9.

Another amended set of claims 1 to 25 filed with a letter dated 3 September 2007 was again not accepted under Rule 137(3) EPC because the claims had been substantially modified by adding further 20 claims in comparison to the set of claims received by letter dated 7 July 2005 and because they did not overcome the objections under Articles 123(2) and 56 EPC, and because they introduced further deficiencies under Article 123(2) EPC, as expressed in the summons for oral proceedings dated 18 April 2008.

The applicant filed further amended sets of claims 1 to 26 according to a main request (comprising system claims 1 to 20 and method claims 21 to 26, claims 1 and 21 being independent) and claims 1 to 25 according to a first and second auxiliary request (comprising system claims 1 to 19 and method claims 20 to 25, claims 1 and 20 being independent) with a letter dated 8 September 2008. The applicant was informed in a fourth communication by fax dated 24 September 2008 before the oral proceedings on 8 October 2008 that the amendments were again not accepted under Rule 137(3) EPC because they were extensive, increased the number of claims from 5 to 26 and reintroduced deficiencies pointed out in the second communication. The fax communication further contained a prima facie analysis of independent claims 1 of the main and auxiliary requests which all appeared to lack an inventive step.

According to the minutes, during oral proceedings it was decided not to admit the claim sets submitted with the letter dated 8 September 2008 and, despite these being maintained by the applicant, to continue with the latest admitted request received with letter dated 7 July 2005. This request was further amended in the

course of the oral proceedings and the decision under appeal is based on this further amended version.

- III. The notice of appeal was received on 16 December 2008. The appeal fee was paid on the same day. With the statement setting out the grounds of appeal received on 23 February 2009, the appellant requested that the decision under appeal be cancelled and that a patent be granted on the basis of claims 1 to 26 (main request) or claims 1 to 25 (first and second auxiliary requests) or claims 1 to 24 (third auxiliary request), all requests submitted with the statement setting out the grounds of appeal. The subject-matter claimed essentially corresponded to that of the sets of claims which had not been admitted in the first instance proceedings under Rule 137(3) EPC. It was further requested to reimburse the appeal fee because of several substantial procedural violations during the first instance proceedings and to arrange oral proceedings in case the main request was not allowed.
- IV. In a communication dated 25 September 2009 the board informed the appellant of its preliminary opinion that the applicant's right to be heard (Article 113(1) EPC 1973) was observed, but that the requirement of Article 113(2) EPC 1973 had been infringed during the first instance proceedings. The board expressed its intention to remit the case to the department of first instance according to Article 111(1) EPC 1973 and Article 11 RPBA so that a decision not vitiated by substantial procedural violations could be made by the first instance, and to reimburse the appeal fee. The appellant was invited to comment on this and to

indicate whether the auxiliary request for oral proceedings was maintained, since oral proceedings did not appear to be helpful.

- V. With a letter dated 22 January 2010 the appellant submitted its comments and declared its consent to the intention of the board to remit the case to the department of first instance and to reimburse the appeal fee.

Reasons for the decision

1. Admissibility

The appeal is admissible.

2. General procedure to follow with regard to the examining division's power not to admit further amendments according to Rule 137(3) EPC

According to Article 123(1) EPC applicable in the present case (see Article 1(1), first sentence, of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000 - OJ EPO 2007, Special Edition No. 1, 197), the applicant shall be given at least one opportunity to amend the application of its own volition. Rule 137(3) EPC applicable here (see Article 2 of the Decision of the Administrative Council of 7 December 2006 - OJ EPO 2007, Special Edition No. 1, 89) gives the applicant a right to amend the application once on its own volition after receipt of the first communication (here the first

communication dated 24 March 2005). According to Rule 137(3) EPC, last sentence, no further amendment may be made without the consent of the examining division. Also according to the case law an examining division has a discretion to allow amendments until issue of a decision to grant (see G 7/93, order 1, OJ EPO 1994, 775 and G 12/91, OJ EPO 1994, 285). If a request for amendment is refused, the examining division must inform the applicant of the reasons for not admitting the amendments in order to satisfy the right to be heard according to Article 113(1) EPC. The applicant will typically be invited to request grant on the basis of a preceding acceptable version of the claim set if such a version exists. Otherwise, if the applicant maintains his request for amendment, the application has to be refused under Article 97(2) EPC, since there is no text which has been approved by the applicant and allowed by the examining division (see Article 113(2) EPC 1973, decisions T 647/93, OJ EPO 1995, 132; T 946/96 and T 237/96; Guidelines for examination in the EPO, C-VI, 4.9).

3. A board of appeal should only overrule the way in which a first instance department has exercised its discretion in a decision in a particular case if the board comes to the conclusion that the first instance department in its decision has exercised its discretion according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see T 640/91, OJ EPO 1994, 912, point 6.3 of the reasons). After studying the case the board judges that the examining division did not exercise its discretion in such an incorrect way when

it did not admit the amended sets of claims dated 8 September 2008.

4. As can be seen from the minutes of the oral proceedings (see last paragraph on page 1) and from the written decision (see section I.) the examining division provided reasons for its refusal not to admit the sets of claims filed with letter dated 8 September 2008.

5. In contrast to the appellant's allegation (see page 4, last paragraph of the statement setting out the grounds of appeal) the applicant's representative had the possibility to present arguments relating to the novelty and inventive step of the claims submitted with its letter dated 8 September 2008. The applicant had been informed of those objections and the intention not to admit the sets of claims in the fourth communication (see the fax dated 24 September 2008), i.e. before the oral proceedings. As can be seen from the minutes of the oral proceedings, the representative in fact did present arguments (see page 1, third paragraph, "To this point the applicant explained, that the objections made by the examining division are already dealt with the latest request, as those objections are not substantiated, stating that the amendments made to the claims are all based on the originally filed claims and on the description, the claims are clear and the requirements of novelty and inventive step are fulfilled, because the prior art documents neither disclosed the features of offloading and uploading connections, nor a hardware or software stack, nor any conditions when to upload or download connections between the stacks").

6. Alleged procedural error during the oral proceedings regarding the chairman's comment before the final deliberation (see page 5, first paragraph of the statement setting out the grounds of appeal)

In the minutes of the oral proceedings it is stated that,

"After above described exchange of arguments, the chairman again interrupted the proceeding from 11:50 - 12:25 o'clock, informing the applicant that the examining division will deliberate whether or not the claims meet the requirements of Art. 56 EPC. The chairman stated that if the division finds that if the requirements are not met, the applicant can expect a refusal of the application, while if the requirements are met, the applicant will be invited to add further dependent claims to allow the applicant to specify its claimed subject matter in more detail."

After reopening the oral proceedings the chairman announced that the application was refused and closed the oral proceedings.

Since the chairman only announced that there would be the opportunity for further arguments or amendments if it was found that the requirements of Article 56 were met by the set of claims under consideration, and it was found that these requirements were not met, the examining division did exactly what was announced before the break. Hence, from the minutes it can not be concluded that the applicant's representative was taken by surprise.

7. The appellant did not question the correctness of the minutes after they were sent to the party and before

the appeal proceedings. The correctness of the minutes was therefore not formally in doubt and the board had to consider the minutes as correctly reflecting the course of the oral proceedings (see R 11/08, reasons point 16 on p. 22). Therefore, in the communication dated 25 September 2009 the board came to the preliminary conclusion that the applicant's right to be heard (Art. 113(1) EPC 1973) had been observed.

For the first time with its letter dated 22 January 2010 filed in response to the board's communication in which the board submitted that it was ready to decide on the case, and therefore late in the appeal proceedings, the appellant alleged that the minutes were not correct (see last paragraph on page 6) and not complete (see second paragraph on page 8).

The board judges that the appellant and its representative could have been expected to have carefully read the minutes upon receipt and to have reacted by directly questioning their correctness, since the minutes are the only possibility for the board to analyse what happened during the oral proceedings before the first instance. Furthermore, the appellant's representative should be aware of the fact that it is not possible to deal with a correction of the minutes in the course of the appeal proceedings, since the examining division does not participate in the appeal proceedings and, hence, has no possibility to explain their point of view of what happened during the oral proceedings before the first instance.

Especially since a judgement on this late allegation would have no effect on the outcome of this particular case, the board will therefore not consider these points further.

8. The appellant further complained that the decision under appeal was taken on the basis of claims that had not been approved in accordance with Article 113(2) EPC 1973.

In the minutes the following statement is found after the chairman announced the decision not to admit the sets of claims filed on 8 September 2008:

"Consequently the latest admitted request filed by the applicant with the letter dated and received 07.07.2005 will be the basis for further discussion during the oral proceedings. After being asked by the chairman, the applicant confirmed that the main request and two auxiliary requests dated 08.09.2008 were maintained. The applicant was informed that this decision and its reasoning will be furnished to him in written form, which may be subject to appeal" (emphasis added).

The appealed decision was finally taken on the basis of the set of claims filed with letter of 7 July 2005 with further minor amendments.

Article 113(2) EPC 1973 states that the European Patent Office shall consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent. Here the examining division refused to consent to the introduction into the procedure of the claims submitted on 8 September 2008, which had been put forward in substitution for the claims put forward with letter of 7 July 2005, and then proceeded to discuss and refuse the claims of 7 July 2005 which were, at the time, not put forward by

the appellant for consideration. Deciding to refuse an application on the ground that claims are not allowable contravenes Article 113(2) EPC 1973 if the applicant is no longer putting forward these claims, and amounts to a substantial procedural violation (see e.g. T 946/96, point 3 of the reasons; T 647/93, OJ EPO 1995, 132, point 2.6 of the reasons). If the examining division refuses consent to the latest submitted amended set of claims under Rule 137(3) EPC this does not automatically revive the previous set of claims that the examining division had consented to consider, unless the applicant has indicated that he was relying on these as an auxiliary request. There was no such indication here. A question by the chairman on the status of the "old" requests would have been necessary. In contrast the applicant had to continue with the set of claims he wanted to replace.

The fact that those claims were further amended by the applicant later during oral proceedings does not imply the applicant's consent under Article 113(2) EPC 1973.

The correct procedure would have been to notify the applicant of the grounds for intending to refuse consent to admit the latest set of claims and to ask him whether he wanted a decision on that basis. If the applicant then maintained his request solely on the basis of these claims (as was the case - see the minutes), and any further arguments by the applicant did not persuade the examining division to change its mind, then a decision should have been given in which the reasons for the refusal of consent under Rule 137(3) EPC were stated, and the application was refused under Articles 97(2) and 78(1)(a) EPC on the basis that the

application contained no claims to which the applicant had agreed.

Thus, the examining division decided on sets of claims which were neither submitted, nor agreed by the applicant, in violation of Article 113(2) EPC 1973. This provision is a fundamental procedural principle, being part of the right to be heard and is of such prime importance that any infringement of it must be considered to be a substantial procedural violation (see T 647/93, point 2.6 of the reasons).

9. The appellant declared its consent to the intention of the board to remit the case to the department of first instance and to reimburse the appeal fee (see the letter dated 22 January 2010).

The appellant's late submitted allegation that the minutes were not correct and not complete (see section 7 above) notwithstanding, the board is therefore in a position to decide without holding oral proceedings in the appeal procedure.

10. As a result of the infringement of Article 113(2) EPC 1973 (see section 8 above), the board remits the case to the department of first instance according to Article 111(1) EPC 1973 and Article 11 RPBA so that a decision not vitiated by substantial procedural violations can be made by the first instance, and orders the reimbursement of the appeal fee according to Rule 67 EPC 1973 (applicable here, see J 10/07, point 7 of the reasons).

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 for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

K. Götz

D. Rees