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**Datasheet for the decision  
of 13 December 2011**

**Case Number:** T 0382/10 - 3.5.05

**Application Number:** 05004936.0

**Publication Number:** 1571786

**IPC:** H04L 12/28

**Language of the proceedings:** EN

**Title of invention:**

System and method for handover to minimize service delay due to ping pong effect in BWA communication system

**Applicant:**

SAMSUNG ELECTRONICS CO., LTD.

**Headword:**

Handover to minimize service delay/SAMSUNG

**Relevant legal provisions:**

EPC Art. 123(2)  
RPBA Art. 11

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

EPC Art. 56, 111(1), 113(2)  
EPC R. 67

**Keyword:**

"Substantial procedural violation (yes)"  
"Reimbursement of the appeal fee (yes)"  
"Remittal to the department of first instance (yes)"

**Decisions cited:**

R 0011/08, R 0014/10, J 0010/07, T 0042/90, T 0666/90,  
T 0315/92, T 0552/97, T 1439/05

**Catchword:**

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Case Number: T 0382/10 - 3.5.05

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.05  
of 13 December 2011

**Appellant:** SAMSUNG ELECTRONICS CO., LTD.  
416, Maetan-dong  
Yeongtong-gu  
Suwon-si  
Gyeonggi-do (KR)

**Representative:** Grünecker, Kinkeldey  
Stockmair & Schwanhäusser  
Anwaltssozietät  
Leopoldstrasse 4  
D-80802 München (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 12 October 2009  
refusing European patent application  
No. 05004936.0 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** A. Ritzka  
**Members:** M. Höhn  
G. Weiss

## Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division, dispatched 12 October 2009, refusing European patent application No. 05004936.0.
- II. In reaction to a summons to oral proceedings before the examining division, the then applicant filed claims 1 to 15 of a main request and two sets of claims 1 to 11 of first and second auxiliary requests, and commented on the objections of lack of inventive step raised in an annex to the summons with respect to the claims of the request then on file. The then applicant requested "a preliminary opinion on the patentability of the independent claims of the main request and the auxiliary requests."
- III. During oral proceedings before the department of first instance held on 23 September 2009, an objection under Article 123(2) EPC was raised against all independent claims of all pending requests, i.e. the main request and first and second auxiliary requests (see minutes of the oral proceedings before the first instance, page 1, paragraph 4). The objection was discussed in particular with respect to the main request, referring occasionally to the other requests, (see minutes page 2, paragraphs 2, 6, 8 and 10). The objection was maintained with respect to the main request and the auxiliary requests.
- IV. The examining division announced that it was prepared to exercise its discretion under Rule 137(3) EPC and invited the representative to file a new request.

- V. The representative filed a new auxiliary request, which is referred to as first auxiliary request, and renamed the former first and second auxiliary requests as second and third auxiliary requests, respectively.
- VI. The examining division was satisfied that the first auxiliary request overcame the objections (see minutes of the oral proceedings before the first instance, page 3, paragraph 5). A substantive examination of inventive step followed. At the end of the discussion of inventive step of claim 1 according to the first auxiliary request filed during oral proceedings, the examining division interrupted the oral proceedings in order to deliberate. According to the minutes of the oral proceedings, the chairman announced "that a decision on the four requests on file will likely be taken after the break" (see minutes of the oral proceedings before the first instance, page 5, paragraph 3 from the bottom). After the break, the chairman announced the decision that the application was refused according to Article 97(2) EPC.
- VII. The notice of appeal was received on 9 December 2009. The appeal fee was paid on the same day. With the statement setting out the grounds of appeal received on 26 January 2010, the appellant submitted six sets of claims according to a main request and five auxiliary requests. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or the auxiliary requests as submitted with the statement setting out the grounds of appeal. It was further requested that the appeal fee be reimbursed because of a substantial procedural violation during the first-instance

proceedings. Oral proceedings were requested on an auxiliary basis.

## **Reasons for the Decision**

### 1. Admissibility

The appeal complies with the provisions of Articles 106 to 108 EPC, (see Facts and Submissions, point VII). The appeal is therefore admissible.

### 2. Substantial procedural violation

2.1 In the statement setting out the grounds of appeal (see page 9, first paragraph), the appellant argued that the statement in the minutes that the chairman of the examining division announced that a decision on the four requests on file would likely be taken after the break "cannot be confirmed by the representative as it was not heard". However, 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 is therefore not formally in doubt and the board has to consider the minutes as correctly reflecting the course of the oral proceedings (see R 0011/08, reasons point 16 on p. 22).

2.2 In the statement setting out the grounds of appeal (see page 9, last sentence of the first paragraph onwards), the appellant went on to argue that such a statement "could not have been expected to be made at this time". The appellant stressed that apart from the introducing remark that all requests had the same problem with

Article 123(2) EPC, an objection under Article 123(2) EPC had been discussed only with regard to the main request, however not with regard to the rest of the pending auxiliary requests, i.e. after filing a new first auxiliary request during oral proceedings the second and third auxiliary requests. This could not be considered to be a full discussion of all subsequent requests. The board notes that the discussion of the objection under Article 123(2) EPC is reported in the minutes at page 1, paragraph 4 to page 2, last paragraph. In particular in paragraphs 2, 6, 8 and 10 of page 2 reference is made to "the three requests" or "the first auxiliary request". Therefore, the board is not convinced that the objection under Article 123(2) EPC was not discussed with respect to the first and second auxiliary requests.

2.3 From the written decision (see section II. reasons for the decision) it is understood that the main request, the second auxiliary request and the third auxiliary request were considered not to fulfil the requirements of Article 123(2) EPC, whereas the first auxiliary request was considered to fulfil the requirements of Article 123(2) EPC but not those of Article 56 EPC 1973. This clearly shows that the applicant's amendments made during oral proceedings did overcome the objection raised at the beginning of the oral proceedings by the chairman.

2.4 Any party has to be prepared that a new objection may be raised by the examining division during oral proceedings in reaction to amendments to the claims made by the applicant in reaction to the summons for oral proceedings. The examining division should give

the party adequate opportunities to react to such a new objection during the course of the oral proceedings. In fact, the examining division did so when it announced that it would exercise its discretion under Rule 137(3) EPC to consent to the filing of a new request if the representative wished to do so (see minutes, page 3, first paragraph).

In reaction to this statement, the applicant filed an amended request, which was introduced into the proceedings as first auxiliary request. Since the amendments were considered to overcome the objections under Article 123(2) EPC with respect to the main request, compliance with the provisions of Article 56 EPC 1973 was discussed. At the end of the discussion the examining division announced that a decision on the four requests might be taken. After deliberation it announced the final decision. This implies that the examining division considered the four requests to be the final requests.

2.5 The appellant in the statement setting out the grounds of appeal said that these four requests were not its final requests and pointed out that "before the last break, the examining division did not ask the usual question whether the Applicant has any further submission or request, but did then immediately refuse the application at a time where this could not have been expected."

2.6 The board considers it to be common practice that a party being confronted with a new objection which is raised with respect to several requests during oral proceedings first tries to overcome this objection by

dealing with a single request only (here the main request). This is a sensible approach in the light of procedural economy and avoids filing multiple versions of all requests during oral proceedings. Thus, the board judges that the appellant did not consider the second and third requests as final requests. On the other hand, the minutes fail to provide an indication that the final requests had been established before the examining division deliberated and made the final decision.

2.7 Article 113(2) EPC 1973 requires the EPO to examine an application only in the text which the applicant has submitted or approved. In cases in which a request of a party is considered unclear, it is the duty of the deciding body to ask for clarification before deliberation (see decision of the Enlarged Board of Appeal R 0014/10, point 6.1). To avoid any misunderstanding, in particular when requests are amended during oral proceedings, the examining division should clarify the final requests before pronouncing its decision at the conclusion of oral proceedings. In accordance with prevailing case law, (see e.g. T 0666/90, T 0552/97 and T 1439/05), the fact that the final requests were not established contravenes the provisions of Article 113(2) EPC and is considered a substantial procedural violation.

3. The substantial procedural violation requires that the decision under appeal be set aside and justifies the reimbursement of the appeal fee according to Rule 67 EPC 1973 (applicable here, see J 0010/07, point 7 of the reasons).



Pursuant to Article 11 RPBA, a board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise. The board is not aware of such special reasons in the present case. With the appeal proceedings, all requests have been amended except for the fourth auxiliary request which corresponds to the former first auxiliary request before the first instance. The other present requests have been amended in different ways such that each of them comprises combinations of amended features which have not yet been examined by the department of first instance. Since the board is bound by the order of the requests submitted by the appellant, and the first instance has not carried out a complete examination of the requirement of an inventive step for the subject-matter of the second and the third auxiliary requests, which are the basis for the present second and the third auxiliary requests, the board is exercising its discretion under Article 111(1) EPC 1973 to remit the case so that a decision not vitiated by substantial procedural violations can be made by the first instance and so that the appellant does not lose an instance before the EPO.

The appellant requested grant of a patent on the basis of the main request or the auxiliary requests. However, as stated in decisions T 0042/90 of 25 February 1991, point 5 of the reasons and T 0315/92 of 27 April 1993, point 5 of the reasons, the decision to remit the case to the first instance is not to be considered as being adverse in substance to that party, so that no oral

proceedings before the board need to be appointed. With the remittal to the first instance for further prosecution, the party still has the possibility of appealing against the final decision on the substance, possibly with oral proceedings.

## **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 Chair:

K. Götz

A. Ritzka