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Datasheet for the decision of 14 November 2014

Case Number: T 2157/10 - 3.5.06

Application Number: 02739716.5

Publication Number: 1309926

IPC: G06F17/00, G06F1/00

Language of the proceedings: EN

Title of invention:
METHOD AND SYSTEM FOR SUBSCRIPTION DIGITAL RIGHTS MANAGEMENT

Patent Proprietor:
ContentGuard Holdings, Inc.

Opponents:
VODAFONE GROUP PLC
Nokia Corporation

Headword:
Admissibility of appeal/CONTENTGUARD

Relevant legal provisions:
EPC 1973 Art. 107
EPC R. 76(1)

Keyword:
Admissibility of appeal (no) -
party not adversely affected by decision

Decisions cited:

Catchword:

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Case Number: T 2157/10 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 14 November 2014

Appellant: (Patent Proprietor)	ContentGuard Holdings, Inc. 103 Foulk Road, Suite 200-M Wilmington, Delaware 19803 (US)
Representative:	Grünecker, Kinkeldey, Stockmair & Schwanhäusser Leopoldstrasse 4 80802 München (DE)
Appellant: (Opponent 1)	VODAFONE GROUP PLC VODAFONE HOUSE THE CONNECTION NEWBURY, BERKSHIRE RG14 2FN (GB)
Representative:	Boult Wade Tennant Verulam Gardens 70 Gray's Inn Road London WC1X 8BT (GB)

Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 11 August 2010 concerning maintenance of the European Patent No. 1309926 in amended form.**

Composition of the Board:

Chairman	W. Sekretaruk
Members:	M. Müller
	A. Teale

Summary of Facts and Submissions

I. The appeal lies against the interlocutory decision of the opposition division dated 11 August 2010 that, account being taken of the amendments made by the patent proprietor during the opposition proceedings, namely the set of claims filed as "Main Request" during oral proceedings before the opposition division, European patent No. EP1309926 and the invention to which it related were found to meet the requirements of the EPC.

II. This decision was appealed against by the proprietor and opponent I, the opposition by opponent II having been withdrawn before the decision was issued.

III. The proprietor's notice of appeal was filed on 21 October 2010, the appeal fee being paid on the same day. A statement of grounds of appeal was received from the proprietor on 21 December 2010. The proprietor requested that the impugned decision be set aside and that the opposition be rejected and the European patent be maintained on the basis of the claim, description and drawings as granted.

IV. Later on, opponent I withdrew first its appeal and then its opposition. The proprietor, being the only remaining appellant, is consequently referred to merely as the "appellant" below.

V. In an annex to a summons to oral proceedings the board informed the appellant of its preliminary opinion according to which the appeal was inadmissible pursuant to Article 107 EPC 1973 because the appellant was not adversely affected by the decision under appeal. The board also indicated that it tended to consider the opposition admissible.

VI. Oral proceedings were held on 14 November 2014. The appellant's final request was that the decision under appeal be set aside and that the European patent be maintained as granted because the opposition was inadmissible. At the end of the oral proceedings the chairman announced the decision of the board.

Reasons for the Decision

1. In preparation for the oral proceedings before the opposition division, with a letter dated 11 November 2009, the proprietor filed six sets of claims as then auxiliary requests 1-6. During those oral proceedings the appellant made the 4th auxiliary request its main request and withdrew the four higher ranking requests (see minutes of oral proceedings, page 1, first para.; decision, facts and submissions, 8).

1.1 During those oral proceedings, the proprietor also raised the issue of whether the opposition was admissible (see minutes, p. 2, 7th par.). After discussion with the parties and deliberation, the opposition division stated that it "consider[ed]" the opposition to be admissible (see minutes p. 3, 5th par.). The board takes this to mean that the opposition division expressed its conclusion on this issue, but did not pronounce a decision at this point.

1.2 Thereafter, the minutes (p. 3, pars. 2 and 3 from the bottom) report that "[t]he chairman asked the proprietor to clarify the requests on file: the rejection of the opposition or to maintain the patent in amended form" and that "[t]he proprietor said that his request was to maintain in amended form."

1.3 Hence, the interlocutory decision of the opposition division found in favour of the highest-ranking substantive request of the appellant.

1.4 Moreover, in the board's view, the minutes must be understood to imply that the proprietor no longer requested the opposition division to find the opposition to be inadmissible. Any request to this effect which may have been made before was thereby withdrawn.

2. The appellant argued as follows.

2.1 During the oral proceedings before the opposition division the appellant had expressed its doubts as to whether the opposition was admissible, effectively requesting the opposition division to find that it was not, and this point was extensively discussed.

2.2 The subsequent request by the chairman of the opposition division that the proprietor clarify its request was exclusively related to substantive requests. It was clear at the time that what the proprietor was asked to clarify was on the basis of which *sets of claims* it requested that the patent be maintained. It was also clear, so the argument, that by making the *substantive request* that the patent be maintained in amended form, and irrespective of the fact that the basis for the amended patent was labelled "main request", the proprietor did not intend to withdraw its *procedural request* that the opposition be found inadmissible. Rather, maintenance in amended form was requested merely if the opposition division decided that the opposition was admissible.

2.3 Furthermore the appellant argued that the opposition division was obliged *ex officio* to decide on the ad-

missibility of the opposition, *i.e.* irrespective of whether a corresponding request was made, and indeed such a decision was delivered (see decision under appeal, reasons 1).

2.4 The proprietor did not expressly request the maintenance of the patent as granted because it did not wish to defend the patent as granted in substance once the opposition division had come to the conclusion - and on the condition that it was to find - that the opposition was admissible. An obligation on the proprietor to request maintenance of the patent as granted so as to be able to raise the inadmissibility of the opposition in appeal would interfere with the appellant's freedom to steer the proceedings according to its requests.

2.5 Hence, the decision rejected the proprietor's unambiguously expressed opinion that the opposition was inadmissible so that the proprietor was clearly adversely affected by the decision and its appeal must be considered admissible.

3. The board cannot follow the appellant's arguments.

3.1 The fact that admissibility of the opposition had been discussed in oral proceedings before the opposition division is not sufficient to imply that a corresponding request was maintained. It is noted for illustration that it is common-place for parties not to maintain a particular set of claims after they have have been discussed oral proceedings and found not to be allowable.

3.2 While it is true that the minutes do not report that the proprietor explicitly withdrew its request to have the opposition be found inadmissible, the board does

not share the appellants view that this request was thus implicitly maintained.

3.3 In the board's view, the minutes are unambiguous as they stand. According to the minutes, a discussion about the admissibility of the opposition took place, after which the chairman of the opposition division, "asked the proprietor to clarify its requests on file". Further according to the minutes, the proprietor clearly stated that it did not want to defend the patent in unamended form. Had the opposition been found inadmissible, the patent as granted would have stood. Hence, the express requests as reported in the minutes are, in the board's view, inconsistent with the appellant's view that the request to find the opposition inadmissible was maintained.

3.4 The appellant argued that it was clear to the opposition division at the time that the appellant's "main request" was meant to complement its request to have the opposition found inadmissible, not to replace it. The board however considers that the minutes do not allow the conclusion that the opposition division may have thought and silently understood anything other than what is explicitly reported. Moreover, the decision itself appears to contradict the appellant's position. The decision states that the opposition was found admissible but did not provide reasons why the proprietor's arguments in this respect were dismissed. The board understands this to mean that the opposition division considered the admissibility of the opposition to no longer be at issue.

3.5 In view of Rule 76(1) EPC 1973, the board must assume that the minutes report accurately what happened during the oral proceedings before the opposition division, in

particular which requests were made and which decisions were issued. The board also notes that the appellant has not requested that the minutes be corrected. Not even during oral proceedings before the board, when it was explained that the literal wording in the minutes contradicted the appellant's position as to what its requests were at the time, did the appellant argue that the minutes were incorrect or request that they should be corrected now, even if late.

3.6 Therefore, the board concludes that the proprietor did not maintain its request that the opposition be found inadmissible before the opposition division.

4. The board agrees with the appellant that the opposition division is obliged to establish *ex officio* whether an opposition is admissible and, according to the decision (reasons 1), they indeed fulfilled this obligation.

4.1 The reasoning given in the decision is very brief and does not explain why the pertinent arguments by the proprietor were dismissed by the opposition division. The appellant argues (letter dated 7 October 2014, p. 2, 3rd para.) that it "cannot be to the disadvantage of the Proprietor that the interlocutory decision is not properly accompanied by the discussion and arguments put forward by the Proprietor". The board agrees insofar as the brevity of the reasoning in the decision must not adversely affect a party. However, it also considers that insufficient reasoning in a decision may only adversely affect an appellant if the decision itself is taken against the appellant's requests. In the present case, had the admissibility of the opposition been a contentious issue, the board might have found the decision to be insufficiently reasoned in this respect, see Rule 68(2) EPC 1973, and have considered

immediate remittal to the opposition division pursuant to Article 11 RPBA due to a fundamental procedural deficiency in the opposition proceedings. The board notes in passing that the appellant did not argue that such a fundamental procedural deficiency had occurred, in particular not in its grounds of appeal. Moreover, since there is no evidence that the question was indeed contentious, the board considers the short reasoning in the decision to be sufficient.

4.2 Furthermore, since the admissibility of the opposition was no longer expressly challenged by the proprietor when the decision was delivered, it must be concluded that the appellant was not adversely affected by the opposition division's decision in this respect.

5. The board therefore comes to the conclusion that the proprietor is not adversely affected by the decision under appeal so that the appeal is inadmissible according Article 107 EPC 1973.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar: The Chairman:

B. Atienza Vivancos W. Sekretaruk

Decision electronically authenticated