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**Datasheet for the decision  
of 8 March 2016**

**Case Number:** T 0830/11 - 3.4.01

**Application Number:** 98114047.8

**Publication Number:** 0977301

**IPC:** H01P5/18, H03G3/30

**Language of the proceedings:** EN

**Title of invention:**

Mobile phone

**Patent Proprietor:**

IPCom GmbH & Co. KG

**Opponent:**

Microsoft Mobile Oy

**Headword:**

**Relevant legal provisions:**

EPC Art. 54(3)

EPC 1973 Art. 54(1), 54(2), 54(4), 84, 56

EPC 1973 R. 29(2)

**Keyword:**

Remittal to the department of first instance

**Decisions cited:**

G 0001/91, T 0263/05, T 1416/04

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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Case Number: T 0830/11 - 3.4.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.01**  
**of 8 March 2016**

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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 15 February  
2011 revoking European patent No. 0977301  
pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** G. Assi  
**Members:** P. Fontenay  
C. Schmidt

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the opposition division to revoke European patent No. 977 301. The decision was remitted to the post on 15 February 2011.
  
- II. The opposition which led to the appealed decision had been filed against the patent as a whole. Although referring to the grounds for opposition of Articles 100(a), (b) and (c) EPC 1973, the opposition had been substantiated with regard to the ground of Article 100 (a) EPC 1973 only, namely for lack of novelty (Articles 52(1), 54(1), (2) EPC 1973 and Article 54(3) EPC) and inventive step (Articles 52(1) and 56 EPC 1973).

In the "Reasons" for the decision, with regard to the requests then on file, the opposition division held that the subject-matter of claim 1 of the main request, i.e. of the patent as granted, lacked novelty under Article 54(3) EPC in view of document E3 (EP-A-859 464) and that the subject-matter of claim 1 of auxiliary requests 2 and 3 was not new in the sense of Article 54(1), (2) EPC 1973 in view of document E17 (DE-C-26 07 530).

The auxiliary requests 1 and 4 were held inadmissible. In the opposition division's judgement, the amendments carried out with regard to claim 1 of auxiliary request 1 led to a fundamental lack of clarity, considering the wording of dependent claim 6. Auxiliary request 4 was held inadmissible because it contained three independent apparatus claims 1, 2 and 4 in contradiction with the requirements of Article 84 EPC 1973 (conciseness) and of Rule 43(2) EPC 1973 (multiple independent claims in the same category).

III. The appellant (patent proprietor) filed the present appeal against said decision by letter dated 8 April 2011 and paid the prescribed appeal fee on the same day.

In the ensuing written statement setting out the grounds of appeal dated Monday 27 June 2011, the appellant requested, as a main request, that the patent be maintained as granted. As an auxiliary measure, the appellant requested maintenance of the patent as amended on the basis of various sets of claims according to auxiliary requests 1 to 4, as filed on 6 December 2010, or on the basis of claims according to auxiliary request 5, as filed with the statement of grounds. The main request and auxiliary requests 1 to 4 corresponded to the requests underlying the decision under appeal.

IV. In a letter dated 13 January 2012, the respondent (opponent) requested that the appeal be rejected.

The respondent held that the appellant's main request and auxiliary requests 1 to 3 were not allowable for reasons of lack of clarity, novelty and inventive step. Moreover, the respondent held that appellant's auxiliary requests 4 and 5 were not admissible.

With regard to novelty and inventive step, the respondent cited, in particular, documents E3, E4 (US-A-5 363 071), E10 (US-A-4 809 356), E17 and E18 (US-A-5 686 864).

V. With letter dated 15 December 2015, the appellant confirmed the requests filed with the statement of grounds of appeal and presented further arguments in

favour of maintenance of the patent in reaction to the respondent's reply of 13 January 2012.

- VI. At the requests of the parties, summons to attend oral proceedings were issued.
- VII. On 14 January 2016, the Board issued a communication pursuant to Article 15(1) RPBA, expressing its provisional opinion with regard to the parties' submissions and requests then on file.

In view of the various objections and issues raised by the parties, a prerequisite consisted in deciding on the interpretation of the characterising feature in granted claim 1 according to which the two control loops were *"realized as control loops **for** a first and a second one of two voltage oscillators, each voltage controlled oscillator generating signals at a frequency in a different frequency band"* (emphasis in bold added by the board). In the respondent's view, the term *"for"* implied, according to the rules of interpretation applicable to patent terminology and specified in the guidelines for examination, that the control loops were merely adapted for the claimed purpose and that the voltage controlled oscillators (VCO), therefore, did not form part of the claimed mobile phone. For the appellants, in the contrary, the context of the claim made it clear that the VCOs defined an essential element of the claimed subject-matter.

The Board was not convinced by the interpretation relied upon by the respondent and observed that such interpretation implied that the claimed mobile phone was actually deprived of an essential constituting element. The feature of dependent claim 6 according to which *"the two control loops are realized as power*

*control loops for a first and a second one of two power amplifiers...*", however, led to an apparent contradiction as to the subject-matter actually claimed, hence, allowing a broad interpretation of claims 1 or 6.

As to the first auxiliary request, it was stressed that the apparent contradiction which exists between claim 1 and claim 6 of the main request was further emphasized by the replacement of the preposition "for" by the preposition "of" in the characterising feature of claim 1. The Board thus inclined to concur with the respondent and the opposition division that the claims of the first auxiliary request as a whole were not clear.

The Board was also not convinced by the arguments put forward by the appellant according to which the subject-matter of claim 1 according to the second auxiliary request was limited to the transmitting aspect of a mobile phone. In this respect, it was observed that the claims wording was not limited to this specific functionality and encompassed both the emitting and transmitting aspects of a mobile phone.

The Board further indicated that it did not share the finding of the opposition division relied upon to reject auxiliary request 4 as inadmissible.

VIII. In reply to the Board's communication, by letter of 15 February 2016, the respondent submitted further arguments against the appellant's requests then on file and in support of its request to reject the appeal. Moreover, the respondent again requested that appellant's auxiliary request 5 of 27 June 2011 be rejected as inadmissible or, alternatively, that the

case be remitted to the opposition division for further prosecution, should said auxiliary request 5 of 27 June 2011 be admitted into the appeal proceedings.

Also in reply to the Board's communication, by letter of 15 February 2016, the appellant submitted a new auxiliary request 5 and stated that previous auxiliary request 5 of 27 June 2011 became new auxiliary request 6.

IX. Oral proceedings before the Board took place on 8 March 2016 in presence of the representatives of both the appellant and respondent.

During the oral proceedings, the allowability of appellant's main request and auxiliary requests 1 and 2 was considered. After respective discussions, the Board held that appellant's main request and auxiliary requests 1 and 2 were not allowable.

Following the discussion of appellant's auxiliary request 2, the appellant filed an additional auxiliary request 2a.

In reaction, the respondent requested that this request be rejected as inadmissible. Should the Board admit this request into the appeal proceedings, the respondent requested that the case be remitted to the opposition division.

After discussion, the Board did not admit appellant's additional auxiliary request 2a into the proceedings.

The allowability of appellant's auxiliary request 3 was considered. After discussion, the Board held that appellant's auxiliary request 3 was not allowable.



The admissibility of appellant's auxiliary request 4 was discussed.

The respondent stated that this request should not be admitted into the proceedings. The respondent further requested that the case be remitted to the opposition division in the case that the Board would admit appellant's auxiliary request 4 into the proceedings. The respondent made no comments in this respect.

After deliberation, the Board admitted appellant's auxiliary request 4 into the proceedings.

X. The final requests of the parties are as follows.

The appellant requested that the decision under appeal be set aside and the patent be maintained as granted, as a main request, or, in the alternative, that the patent be maintained according to one of the following auxiliary requests:

auxiliary requests 1 and 2, filed with the ground of appeal,

auxiliary request 2a, filed at the oral proceedings before the Board,

auxiliary requests 3 and 4, filed with the grounds of appeal,

auxiliary request 5, filed with letter dated 15 February 2016,

auxiliary request 6 corresponding to auxiliary request 5 filed with the grounds of appeal.

The respondent requested that the appeal be dismissed.

XI. Claim 1 of the appellant's main request reads as follows:

"1. Mobile phone (25) for multiple frequency bands, with a coupler (1) having two input ports (30,35) and a common coupling port (40), a first one of the two input ports (30, 35) being connected to an output port of a first one of at least two control loops (5, 10, 15, 20), a second one of the two input ports (30, 35) being connected to an output port of a second one of the at least two control loops (5, 10, 15, 20), the two control loops (5, 10, 15, 20) sharing a common loop control (55), an input (85) of the common loop control (55) being connected to the common coupling port (40), the coupler (1) coupling signals received at the first and the second one of the two input ports (30, 35) to the common coupling port (40), characterized in that the two control loops (15, 20) being realized as control loops (15, 20) for a first and a second one of two voltage controlled oscillators (145, 150), each voltage controlled oscillator (145, 150) generating signals at a frequency in a different frequency band."

Claims 2 to 7 of the appellant's main request are dependent claims.

In view of the role played by claim 6 of the appellant's main request in the present proceedings, its wording is herewith reproduced. It reads:

"6. Mobile phone (25) according to claim 1, characterized in that the two control loops (5, 10) are realized as power control loops (5, 10) for a first and a second one of two power amplifiers (95, 100), each

*power amplifier (95, 100) amplifying transmission signals in a different frequency band, the coupler (1) having two output ports (125, 130), connected to an antenna (135), especially via an antenna switching circuit (140)."*

Appellant's auxiliary request 1 differs from the main request in that the term "for" in the characterising part has been replaced by the term "of", as follows:

*"characterized in that the two control loops (15, 20) being realized as control loops (15, 20) **of** a first and a second one of two voltage controlled oscillators (145, 150), each voltage controlled oscillator (145, 150) generating signals at a frequency in a different frequency band", (emphasis in bold added by the Board).*

Appellant's auxiliary request 2 differs from auxiliary request 1 in that dependent claim 6 has been deleted and former claim 7 renumbered accordingly.

Appellant's auxiliary request 2a differs from auxiliary request 2 in that the definition "Mobile phone (25) for multiple frequency bands, with a coupler (1) having ..." has been amended to read "Mobile phone (25) for multiple frequency bands, with a coupler (1) **in a transmission path of the mobile phone, said coupler (1) having ...**" (emphasis in bold added by the Board).

Appellant's auxiliary request 3 differs from auxiliary request 2 in that claims 1 and 2 have been combined and the dependent claims renumbered accordingly.

Appellant's auxiliary request 4 comprises 3 independent claims (claims 1, 2 and 4) and one dependent claim (claim 3). The independent claims 1, 2 and 4

correspond, respectively, to a combination of claims 1, 2 and 3, claims 1, 2 and 4, and claims 1, 2 and 7 of auxiliary request 2.

Appellant's auxiliary request 5 differs from auxiliary request 4 in that independent claims 1, 2 and 4 have been specified by introducing following feature after the definition of the three transmission lines "*with a neglectable signal coupling between the first and the second transmission lines (60 and 65, respectively)* [read "*(60 and 65), respectively*"].

Appellant's auxiliary request 6 consists of a single independent claim which differs from claim 1 of the main request in that the expression "*control loops for ... voltage control oscillators*" has been replaced by the expression "*control loops **of** ... voltage control oscillators*" (emphasis in bold added by the Board) and in that the claim has been further amended so as to refer to the embodiment of the three control loops, with three VCOs and four transmission lines, the positions of which have been specified.

## **Reasons for the Decision**

### 1. *Applicable law*

This decision is issued after the entry into force of the EPC 2000 on 13 December 2007 whereas the application was filed before this date. Reference is thus made to the relevant transitional provisions for the amended and new provisions of the EPC, from which it can be derived which Articles and Rules of the EPC 1973 are still applicable to the present application and which Articles and Rules of the EPC 2000 are to apply. When Articles or Rules of the former version of

the EPC are cited, their citations are followed by the indication "1973" (cf. EPC, Citation practice).

2. *Admissibility of the appeal*

The notice of appeal and the statement of grounds of appeal comply with the requirements of Articles 106 to 108 EPC and Rule 99 EPC. The appeal is thus admissible.

3. *Appellant's main request - Novelty (Article 54(1) EPC 1973, Article 54(3) EPC, Article 54(4) EPC 1973)*

3.1 Document E3 is a European patent application that was published on 19 August 1998, i.e. after the filing date of the patent in suit. E3 claims a priority of 13 February 1997, i.e. before the filing date of the patent in suit, which does not claim the benefit of any priority right. Document E3 thus forms part of the prior art relevant for the question of novelty (Articles 54(3) EPC and 54(4) EPC 1973).

3.2 Document E3 discloses a mobile station having dual band RF detector provided with gain control means ensuring that the RF signals on both transmitting paths are amplified (cf. E3, abstract). Figure 4 illustrates a preferred embodiment of the RF detector of E3 with details of its coupler.

As illustrated in Figure 4, the coupler comprises two input ports and a common coupling port (left hand side of elements SL1, SL2 and SL3, respectively). The first and second input ports are connected to an output port of a first and second control loops (output ports of PA1 and PA2, respectively). The two control loops disclosed in E3 share a common loop control (14C, D<sub>com</sub>, R3, C2, A<sub>com</sub> ...) with an input (input of matching

circuit 14C) of the common loop control being connected to the common coupling port (left hand side of item SL3). The coupler of E3 thus couples signals received at the first and the second one of the two input ports (left hand side of SL1 and SL2) to the common coupling port (left hand side of SL3), as recited in claim 1 of the main request.

In E3, the two control loops are realized as control loops for a first and a second one of two power amplifiers (PA1 and PA2), and not, as recited in claim 1, for voltage controlled oscillators with each voltage controlled oscillator generating signals at a frequency in a different frequency band.

3.3 The question to be answered with regard to the issue of novelty hinges thus on the interpretation of the characterising feature in claim 1 of the granted patent:

*"the two control loops (15, 20) being realized as control loops (15, 20) for a first and a second one of two voltage controlled oscillators (145, 150), each voltage controlled oscillator (145, 150) generating signals at a frequency in a different frequency band".*

More specifically, it should be established whether the claimed wording implies that the VCOs are part of the claimed subject-matter or not.

During the oral proceedings, the appellant reiterated the view that said VCOs indeed constituted integral parts of the claimed mobile phone and that no contradiction resulted from dependent claim 6, which related to:

*a "Mobile phone according to claim 1, characterized in that the two control loops (5, 10) are realized as*

*power control loops (5, 10) for a first and a second one of two power amplifiers (95, 100) ...".*

In the appellant's view, the combination recited in claim 6 of the granted patent, was equivalent to the mobile phone of original claims 6, 7 and 8 considered in combination. It reflected the embodiment disclosed in paragraph [0013] of the application as published where it was specified that *"Figure 2 shows a transmission stage of the mobile phone 25 preceding the amplification stage shown in Figure 1"*.

The Board acknowledges that the literal interpretation of paragraph [0013], which had never before been put forward by the appellant, is technically sensible. It corresponds to a mobile phone with two coupling stages, each provided with its own coupler, for controlling, respectively, the frequencies generated by the oscillators and the gain of the amplifiers on each of the two transmitting paths. This interpretation appears, however, to contradict the very purpose of the disclosed invention which seeks to save space and costs (cf. paragraph [0004] of the published application). More fundamentally, this interpretation is not consistent with the very wording of claim 6 of the granted patent which refers to *"the two control loops (5, 10)"* and to *"the coupler (1)"*. In the absence of any definition of these items in claim 6, the use of the definite article *"the"* implies, namely, that reference is made to the control loops and coupler of claim 1 on which claim 6 depends.

Although the Board refuses to equate the term *"for"* with the expression *"suitable for"*, observing that the passage of the Guidelines for examination (part F, Chapter IV, 4.14) referred to by the respondent relates to an apparatus or product and not to a specific

feature of a claimed apparatus, it nevertheless considers that, under the present circumstances, the characterising part in claim 1 of the granted patent does not imply that the VCOs are necessarily part of the claimed subject-matter. This interpretation of claim 1 appears indeed to be the only one which permits to conciliate the wording of claims 1 and 6, even if uncertainties still persist as to the structural limitations which result from the suitability of the control loops to control VCOs (claim 1) and power amplifiers (claim 6).

It is, furthermore, considered that the signals provided by the control loops of E3 are also adapted to constitute control signals for VCOs.

It follows that claim 1 of the granted patent is anticipated by document E3.

3.4 Therefore, the appellant's main request is not allowable.

4. *Appellant's auxiliary request 1 - Clarity (Article 84 EPC 1973)*

4.1 The Board concurs with the appellant's understanding that the amendment carried out in claim 1 of auxiliary request 1, replacing the preposition "for" by the preposition "of", implies that the VCOs are part of the claimed mobile phone.

As a consequence of this amendment, the interpretation relied upon with regard to claim 1 of the main request, in order to conciliate claim 1 and dependent claim 6, is no more sustainable. As a matter of fact, claim 6 now appears to contradict the wording of claim 1 since



it suggests that the VCOs mentioned in the independent claim could somehow be replaced by power amplifiers. This interpretation would thus imply that claim 6 constitutes *de facto* a hidden independent claim.

However, should claim 6 be construed as relating to dependent subject-matter, the skilled person would then have difficulties to identify which configuration of the coupler would result from the presence of VCOs and the additional ability for the control loops to control power amplifiers. This appears all the more true since the description does not elaborate on such a configuration.

For these reasons, the skilled person is unable to identify what subject-matter is actually defined in claim 6. The claims of auxiliary request 1 are therefore not clear as a whole contrary to Article 84 EPC 1973.

- 4.2 Therefore, appellant's auxiliary request 1 is not allowable.
- 5. *Auxiliary request 2 - Novelty (Article 54(1), (2) EPC 1973)*
  - 5.1 Auxiliary request 2 differs from auxiliary request 1 in that claim 6 has been deleted, thus obviating the objection of lack of clarity relied upon by the Board to reject auxiliary request 1.
  - 5.2 Document E17 was made available to the public on 1 September 1977. It forms part of the prior art according to Article 54(2) EPC 1973.

E17 discloses a RF device for receiving and transmitting signals on different frequency bands (cf. column 2, lines 35-43; column 3, lines 52-63). An oscillator is provided for each band and is selected by appropriate control of switching means provided to that effect. The device of E17 comprises two coupling loops dedicated to the receiving functionality of the RF device and two coupling loops for the emitting functionality. The analysis which follows focuses on two of these four loops, namely, the loops incorporating the oscillator units 2 and 3, respectively.

The RF apparatus of E17 is considered to disclose a mobile phone in the sense of the present invention. E17 thus discloses a mobile phone for multiple frequency bands (cf. column 2, lines 35-43, Figure 1) with a coupler. The coupler disclosed therein comprises two input ports (left hand side of transformers 23 and 30) and a common coupling port (output of amplifier 31). The first and second input ports are connected, respectively, to an output port of a first and second control loops (oscillator units 2 and 3, respectively; phase comparator 20; frequency divider 21). As shown in Figure 1, the two control loops share a common loop control (line incorporating phase comparator 20 and frequency divider 21) with an input (input of frequency divider 21) of the common loop control being connected to the common coupling port (right hand side of amplifier 31). The coupler couples signals received at the first and the second one of the two input ports (left hand side of 23 and 30) to the common coupling port (right hand side of amplifier 31). Moreover, the two control loops of E17 are realized as control loops for a first and a second one of two VCOs (2 and 3),

with each VCO generating signals at a frequency in a different frequency band (cf. column 3, lines 52-63).

The device of E17 reproduces, hence, all the features of claim 1 of auxiliary request 2 in combination.

5.3 The appellant objected to the interpretation of the claim relied upon by the respondent. It was stressed, in this respect, that the two control loops referred to did not form part of the transmissions path of the mobile phone, but combined a control loop for a receiving path (oscillator 2) with a control loop for a transmitting path (oscillator 3). Such an interpretation did not reflect the teaching of the patent in suit where the coupler constituted an integral part of the transmission path. The terminology used throughout the application and, in particular, the reference to concepts such as "transmission lines", "radio transmitter" or "*transmission stages of the transmission path*" was, in this respect, devoid of any ambiguity.

The Board, however, rejects this line of argumentation. It notes, in particular, that paragraphs [0004] to [0008] in the published patent specification dedicated to the "*advantages of the invention*" apply indifferently to receiving and/or transmitting functionalities within a mobile phone. The evocation of "*transmissions lines*" in this section of the description is not conclusive since it seems to refer, more generally, to the ability of the lines of the coupler to carry a signal. In any case, the Board is unable to identify in the wording of claim 1 of auxiliary request 2 any feature implying that the defined coupler is limited to the transmission path in a mobile phone.

5.4 Consequently, in the absence of any identifiable distinguishing feature between the claimed mobile phone and the mobile device of E17, the subject-matter of claim 1 is not new in the sense of Article 54(1), (2) EPC 1973.

5.5 Therefore, appellant's auxiliary request 2 is not allowable.

6. *Appellant's auxiliary request 2a*

6.1 Claim 1 of auxiliary request 2a differs from claim 1 according to auxiliary request 2 in that the claimed subject-matter relates to a "*Mobile phone for multiple frequency bands, with a coupler **in a transmission path of the mobile phone, said coupler** comprising ...*" (with emphasis in bold on the amendments vis-a-vis claim 1 of auxiliary request 2).

The appellant acknowledged that the request was filed at a late stage of the appeal proceedings, but stressed that this late filing constituted a direct reaction to the fact that the Board had rejected its view, with regard to claim 1 of auxiliary request 2, that the claimed coupler was part of the transmission path of a mobile phone. Until that moment, the appellant had namely been convinced of the validity of its argumentation and had therefore been surprised by its rejection by the Board. Moreover, the amendment in claim 1 was straightforward and did not raise any difficulties of a technical or legal nature.

The Board, however, observes that it had explicitly pointed, in section 4 of the communication according to Article 15(1) RPBA, to the fact that it was not

convinced by the restrictive interpretation relied upon by the appellant. In said communication, the Board had also explicitly referred to the consequences which would derive from the fact that the claim was, in its view, not limited to the transmission path of a mobile phone when deciding on novelty in view of E17. The Board had also made it plain that it intended, in this respect, to endorse the analysis of the opposition division under section 4.3.1 of the impugned decision where the argumentation of the appellant had already been discussed and rejected.

Auxiliary request 2a could thus have been filed, at the latest, as a reaction to the communication of the Board. Its filing during the oral proceedings is therefore not justified. Its admission at this particularly late stage of the appeal proceedings would be contrary to the principle of procedural economy of the proceedings.

Consequently, the Board, exercising its discretion under Article 13(1) RPBA, does not admit auxiliary request 2a into the appeal proceedings.

7. *Appellant's auxiliary request 3*

7.1 Claim 1 of auxiliary request 3 results from a combination of claims 1 and 2 of auxiliary request 2.

7.2 The respondent put forward that the additional features recited in claim 1 were also disclosed in E17. In this respect, Figure 1 of E17 was misleading in that the symbols used for representing elements 23 and 30 were those of transformers. It was however part of common knowledge that "Übertrager" in the field of high frequencies (HF) were realised in the form of

transmission strips, i.e. transmission lines arranged adjacent and in parallel to each other. It was also well established practise to represent such "Übertrager" as transformers because of the coupling actually taking place between the various transmission lines. No new technical teaching could thus be derived from this practise.

Although coherent and plausible, the argumentation of the respondent is not considered to be conclusive. As a matter of fact, the Board is not in a position to exclude that transformers are indeed meant under the denomination "Übertrager" in E17. As pointed out by the appellant, the explicit reference in E17, column 3, lines 35-42, to the secondary coil of "Übertrager" 23 ("*Sekundärwicklung des erstens Übertragers*") suggests, in the contrary, that at the time E17 was filed, in 1976, transformers had been intended. For this reason, the Board cannot establish from Figure 1 of E17 that the first and second one of the three transmission lines (left hand side of transformer 23 and 30) are adjacent to the third one of the three transmission lines (right hand side of transformers 23 and 30) in such a distance that at least a first predetermined part of the signal power at the first or second one of the at least two input ports is coupled to the common coupling port. In the case of transformers, the distance between the primary and secondary windings is practically not relevant since the magnetic coupling results, essentially, from the presence of the iron core and not from the distance between the windings. Applying the strict standards of so-called "*photographic novelty*" developed by the jurisprudence of the boards of appeal, the doubts as to the exact nature of the Übertragers 23 and 30 in E17 are, as

such, sufficient to reject the argumentation of the respondent.

The subject-matter of claim 1 of Auxiliary request 3 is thus new in the sense of Article 54(1), (2) EPC 1973

- 7.3 Relying on the above finding according to which the nature of the "Übertrager" in E17 is not established, the technical problem solved by the invention consists in realising coupling means for frequencies between 65 and 99 MHz.

Coupling means in the form of strip lines are disclosed in documents E4 (US-A-5 363 071) and E10 (US-A-4 809 356). Particular reference was made by the respondent to Figure 3 of E4 and Figure 1 of E10. In the respondent's view, the skilled person would have recognised the benefits resulting from these configurations in terms of coupling and space saving.

The Board shares this approach and rejects the argument of the appellant according to which the circuits illustrated in both E4 and E10 fulfilled completely different functions. In particular, in the appellant's view, the embodiment of E4 disclosed a configuration which was the reverse of the one disclosed in the present patent. The skilled person would have therefore never considered these two documents which do not even belong to the field of the invention.

Documents E4 and E10 relate, respectively, to an *"apparatus and method for varying the coupling of a radio frequency signal"* and to a *"three-way power splitter using directional couplers"*. These two documents are therefore relevant for the skilled person looking for coupling means in the domain of high

frequencies. The fact that the systems disclosed in E4 or E10 are fulfilling different functionalities with the transmission lines having reversed roles compared to the patent in suit is, in this respect, not essential. The skilled person would have known that the coupling taking place between the various strips in E4 or E10 is reciprocal and occurs thus independently of the specific role played by each of the various strips.

For these reasons, the Board considers that the skilled person, looking for HF coupling means for fulfilling the functions of elements 23 and 30 in E17, would have considered document E4 or E10. The skilled person would have recognised the advantages resulting from the configurations disclosed in Figure 3 of E4 or Figure 1 in E10.

The subject-matter of claim 1 of auxiliary request 3 thus results in an obvious manner from the prior art and is therefore not inventive in the sense of Article 56 EPC 1973.

7.4 Therefore, appellant's auxiliary request 3 is not allowable.

8. *Appellant's auxiliary request 4*

8.1 Auxiliary request 4 comprises three independent claims 1, 2 and 4. Said claims correspond, respectively, to a combination of claims 1, 2 and 3, claims 1, 2 and 4, and claims 1, 2 and 7 of auxiliary request 2.

8.2 Auxiliary request 4 was not admitted by the opposition division into the opposition proceedings under Article 114(2) and Rule 116(2) EPC because the three independent claims did not fulfill the requirements of



Article 84 EPC 1973 as to conciseness and of Rule 43(2) EPC concerning "*multiple claims*" in the same category. In particular, the opposition division held that the claims were all of the apparatus category and related neither to interrelated products nor to different uses nor to alternative solutions to a particular problem. While claims 1 and 2 were considered to relate to different solutions of the problem of miniaturisation, claim 4 was considered to address the different problem of decoupling of the two output ports and common coupling port.

8.3 Under the circumstances, the role of the Board is, primarily, to ensure that the opposition division made a correct application of its discretion and, in particular, that it applied the correct principles when exercising said discretion.

8.3.1 In this respect, it is noted that auxiliary request 4 was filed for the first time during the oral proceedings before the opposition division (cf. minutes of the oral proceedings before the opposition division, page 5, third paragraph). The exercise by the opposition division of its discretion in order to decide on the admissibility of said late filed auxiliary request 4 was thus legitimate.

8.3.2 The Enlarged Board of appeal held in decision G 1/91 (OJ 1992, 253; Headnote) that:

*"Unity of invention (Article 82 EPC) does not come under the requirements that a European patent and the invention to which it relates must meet under Article 102(3) EPC when the patent is maintained in amended form. It is consequently irrelevant in opposition proceedings that the European patent as granted or amended does not meet the requirement of unity".*

The opposition division noted in section 6.2 of its decision that "*the requirements of Art. 84 and Rule 43(2) EPC have to be fulfilled, regardless of the fact that Article 82 EPC only relates to the European patent application*". The position adopted by the opposition division is thus tantamount to deprive the decision of the Enlarged Board of any effects, since it leads to the finding that a request including a plurality of independent claims must be rejected for this very reason.

In the Board's judgement, the condition of conciseness of Article 84 EPC 1973, as well as the dispositions of Rule 29(2) EPC 1973 (Rule 43(2) EPC), have to be construed in opposition proceedings in the light of the findings by the Enlarged Board of appeal (cf. decision G 1/91, Reasons, point 4.2) that "*the administrative purposes of unity are fulfilled in the main up to the time the patent is granted. ... In view of the object and purpose of both unity and opposition, it seems neither necessary nor appropriate to continue to attach importance to any lack of unity at the opposition stage. Once the examination procedure has been concluded with the grant of a patent, the requirement of unity has fulfilled its administrative function*".

The requirements of Rule 29(2) EPC 1973 (Rule 43(2) EPC) should therefore not constitute an obstacle for the patentee to defend the patent in all its branches (cf. decisions T 263/05 (OJ 2008, 329) and T 1416/04, not published).

In order to avoid any misunderstanding, it should be emphasized that the Board does not question the general applicability of Article 84 EPC 1973 as to conciseness

and of Rule 29(2) EPC 1973 (Rule 43(2) EPC) in opposition proceedings. The Board only considers that these norms do not apply to sets of claims whose subject-matter was already claimed in the granted version of the patent.

8.4 In conclusion, the Board considers that the opposition division did not correctly exercise its discretion when deciding on the admissibility of auxiliary request 4 then pending.

8.5 Therefore, the Board admits appellant's auxiliary request 4 into the appeal proceedings.

9. *Remittal of the case to the opposition division  
(Article 111(1) EPC)*

During the oral proceedings before the Board, the appellant requested that the case be remitted to the opposition division for further prosecution in case that the Board would admit appellant's auxiliary request 4 into the proceedings. The respondent made no comments in this respect.

In view of this, the Board has no reasons to reject the request for remittal.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



R. Schumacher

G. Assi

Decision electronically authenticated