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**Datasheet for the decision
of 7 February 2013**

Case Number: T 2573/11 - 3.5.04

Application Number: 08162496.7

Publication Number: 2056595

IPC: H04N5/445

Language of the proceedings: EN

Title of invention:

Method for providing multimedia content list and sub-list, and broadcast receiving apparatus using the same

Applicant:

Samsung Electronics Co., Ltd.

Headword:

Relevant legal provisions:

EPC R. 71(4), 103(1)(a)
RPBA Art. 11

Keyword:

Substantial procedural violation - (no)
Request for amendment under Rule 71(4) EPC reached the examining division after the decision to grant the European patent had been handed over to the EPO internal postal service

Decisions cited:

G 0012/91, T 0556/95, T 0798/95, T 0394/96, T 0355/03,

Catchword:

See points 6 and 13 to 15.



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2573/11 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 7 February 2013

Appellant: Samsung Electronics Co., Ltd.
(Patent Proprietor) 129, Samsung-ro
Yeongtong-gu
Suwon-si, Gyeonggi-do, 443-742 (KR)

Representative: Fearnside, Andrew Simon
Appleyard Lees
15 Clare Road
Halifax, HX1 2HY (GB)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 17 November 2011 granting a European patent pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: F. Edlinger
Members: T. Karamanli
C. Kunzelmann

Summary of Facts and Submissions

- I. European patent application No. 08 162 496.7 was filed with the European Patent Office (EPO) on 18 August 2008.
- II. On 5 July 2011 the formalities officer on behalf of the examining division, which was located in Munich, posted a communication under Rule 71(3) EPC, essentially informing the applicant
- that the application according to the main request did not fulfil the requirements of Article 84 EPC
- and
- that the examining division intended to grant a European patent on the basis of Auxiliary Request 1 (with claim 9 amended by the examining division).
- III. On 4 November 2011 the applicant filed electronically a letter which reads as follows:

"In response to the Communication under Rule 71(3) EPC dated 5 July 2011, we enclose French and German translations of the claims. Please deduct the due fees, including particularly the grant and printing fees, from our deposit account number

We look forward to receiving notification of the decision to grant."

The sets of claims in French and German were attached to that letter.

- IV. On 11 November 2011, at 15:33 hours, the applicant filed electronically a further letter in reply to the EPO communication under Rule 71(3) EPC dated 5 July 2011, together with an amended set of claims 1 to 12 and French and German translations thereof. In this letter the applicant stated that the letter dated 4 November 2011 and the French and German translations attached thereto were withdrawn and under Rule 71(4) EPC also requested voluntary amendments of the claims under Rule 137(3) EPC and gave explanations regarding these amendments.

The letter further reads on page 1, fourth paragraph:

"Please deduct the due fees, including particularly the grant and printing fees, from our deposit account number The applicant approves the text for grant as amended."

- V. The decision to grant a European patent pursuant to Article 97(1) EPC (EPO Form 2006A 12.07) was posted to the applicant on 17 November 2011.

The footer of this automatically created decision to grant reads: "EPO Form 2006A 12.07 (**11/11/11**)" and "to EPO postal service: **11/11/11**" (emphasis added by the board).

The footer of the attached "NOTE RELATING TO THE DECISION TO GRANT A EUROPEAN PATENT (EPO Form 2006R) reads: "EPA/EPO/OEB Form 2006R 12.07" and "**08162496.7 (11.11.11)**" (emphasis added by the board).

- VI. By a communication (EPO Form 2085) dated 21 November 2011, the applicant was informed that the request for amendment of 11 November 2011 had been received on

11 November 2011, but had reached the examining division only after the decision to grant the European patent had been handed over to the EPO internal postal service and that, as the EPO was bound by its decision, the requested amendments could no longer be considered. Additionally, the applicant's attention was drawn to the possibility of appeal against the decision to grant.

- VII. On 23 November 2011 the applicant (appellant) filed an appeal against the decision of the examining division to grant a European patent, paid the corresponding appeal fee and submitted a statement setting out the grounds of appeal.
- VIII. In a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536) annexed to the summons to oral proceedings posted on 10 October 2012, the board referred *inter alia* to decisions G 12/91, OJ EPO 1994, 285, point 9.3 of the Reasons; T 798/95, point 6 of the Reasons; and T 355/03, point 2 of the Reasons, and informed the appellant of the board's provisional opinion that the applicant's letter dated 11 November 2011 had been filed after completion of the proceedings before the examining division and that therefore the examining division was not competent to consider this letter even if, as submitted by the appellant, it contained a request under Rule 71(4) EPC, and thus no procedural violation within the meaning of Rule 103(1)(a) EPC had occurred in the proceedings before the examining division.
- IX. With a reply dated 4 January 2013, the appellant filed further submissions and referred in particular to decisions T 556/95 and T 394/96, the Guidelines for

Examination in the EPO and to "The Annotated European Patent Convention", Derk Visser, nineteenth revised edition, updated till 15 November 2011, page 593 (of which a copy was attached to the letter).

- X. Oral proceedings before the board took place on 7 February 2013.

The appellant requested that the decision be set aside, that examination of the application be re-opened and that the amendments filed on 11 November 2011 be fully considered by the examining division pursuant to Rule 71(4) EPC (and Rule 71(5) EPC, if necessary). The appellant also requested that the appeal fee be reimbursed.

- XI. The appellant's submissions can be summarised as follows:

The date on which proceedings before the examining division were completed was three working days before the date (17 November 2011) stamped on the decision, i.e. in the present case 14 November 2011. The date on which proceedings before the examining division were completed was after the date (11 November 2011) on which the applicant requested amendments to be considered by the examining division. Therefore the examining division should have considered the requested amendments and the applicant had a legitimate expectation that they would be considered.

The date on which proceedings before the examining division were completed had to be calculated in accordance with decision G 12/91, established case law and established practice within the profession.

Decision G 12/91 referred to the "point in time" and not "the date" as far as the completion of proceedings before the decision-making department was concerned and it determined the point in time at which a first-instance department's decision-making process was completed. This date had to be clearly definable, both in the interests of ensuring that proceedings before the EPO were carried out correctly, as well as of the parties to the proceedings, to ensure that both the decision-taking department and the parties knew the precise moment at which account could still be taken of new amendments to the application. Decision G 12/91 concluded that the date of termination of proceedings was the date of the (final) handing over by the formalities section to the EPO postal service of the decision to be notified, bearing the date-stamped, post-dated date of despatch of the decision by the EPO postal service. From the wording of point 9.1 of the Reasons it was clear that decision G 12/91 was unambiguous about the date of termination of proceedings being three days prior to the despatch date finally stamped on the decision (e.g. after any re-dating of the decision). This corresponded with the date of the final (not always the first) handing-over of the decision (e.g. after any previous returns/re-dates) to the EPO postal service by the decision-making department.

In decisions T 556/95 and T 394/96, the respective board of appeal had referred to decision G 12/91 and concluded that first-instance proceedings were terminated three days prior to the date of despatch stamped on the decision. It was clear from the facts and the ruling of these decisions (T 556/95, point 6 of the Reasons, T 394/96, point 4 of the Reasons) that the determinative date was the date (of despatch) stamped

on the decision which appeared in the box marked "Datum/Date" at the upper right-hand side of the decision, and not the date appearing in the box marked "to EPO postal service" at the bottom-right side of the decision. In case T 556/95 the date of termination of proceedings (i.e. 10 February 1995 minus three working days) coincided with the date the decision was first handed to the EPO postal service (i.e. 7 February 1995 which was shown at the bottom-right side of the decision). However, this was not always the case, as explained in G 12/91. In the case of T 394/96, the date of the decision was 6 March 1996 and the date of termination of proceedings (i.e. 1 March 1996) did not coincide with the date the decision was first handed to the EPO postal service (i.e. 29 February 1996), shown at the bottom-right side of the decision. The three-day rule applied also in accordance with decision G 12/91 and EPO practice as explained by the President of the EPO in case G 12/91 and described in the DG 2 Staff Notice 1/88-III dated 22 February 1988, i.e. that if the EPO postal service was unable to despatch a decision on the date originally stamped, it was returned to the examining/opposition division where it was given a new date which again pre-dated the date of actual despatch by three working days.

Decision G 12/91 of the Enlarged Board of Appeal was more important than decisions T 798/95 and T 355/03 cited by the present board, which did not apply the three-day rule of decision G 12/91.

The current Guidelines for Examination in the EPO also made repeated reference to decision G 12/91 in support of EPO practice regarding determining the date of termination of proceedings. For example, Part C-V, 6.1 read: *"...Subsequent to the applicant's approval in*

response to the Rule 71(3) communication (see C-V,2), the Examining Division may resume the examination procedure at any time up to the moment the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant (see G 12/91). This will seldom occur, but may be necessary if e.g. the applicant files further prior art which necessitates further substantive examination, if the Examining Division becomes aware of very relevant prior art following observations by third parties under Art. 115, if the applicant files amendments or corrections (having already approved the text), or if the Examining Division becomes aware in some other way of circumstances which are such as to cause the subject-matter claimed to fail to comply with the EPC ...".

Thus, it remained consistent EPO practice to follow decision G 12/91 regarding the date of termination of proceedings. It allowed both the applicant and the examining division to continue examination proceedings after approval of the text for grant provided that proceedings were still pending at that time, as defined by decision G 12/91 (i.e. before the decision despatch date, minus three working days).

A further example in the Guidelines was Part C-V,4.7.1 which stated: *"...Requests for oral proceedings must be allowed as long as proceedings before the EPO are still pending, i.e. until the decision to grant has been handed over to the internal post (see G 12/91 and T 556/95) ..."*. Both of the decisions referred to in this passage clearly stated that proceedings were pending until three days before the date (of despatch) stamped on the decision.

That the proceedings of a first-instance department of the EPO were pending up to three days prior to the despatch date stamped on the decision to be notified was also explained in established texts on the European Patent Convention, such as in "The Annotated European Patent Convention", Derk Visser, nineteenth revised edition, Part VII, *Implementing Regulations to Part VII of the Convention*, page 593 where it was stated:

"Therefore, in written proceedings of the first instance the department can take submissions into account and amend the already taken decision up to three days prior to the date stamped on the decision, ... The date is easy to ascertain by a party, albeit only once the decision has been notified, which provides legal certainty. ... As an example, the first instance decision was stamped 06.03.1996 (Wednesday) and, hence, was handed over to the EPO postal service three working days prior to that date, i.e. on 01.03.1996 (Friday); therefore, a party could expect account to be taken of a submission filed before 01.03.1996 (T394/96, r. 4)..."

In the present case the date of despatch stamped on the decision was 17 November 2011 and the examining division had received the applicant's submissions on 11 November 2011. The date of termination of proceedings was 14 November 2011 which did not coincide with the date (11 November 2011) the decision was first handed to the EPO postal service. This was in accordance with decision G 12/91 whereby, if the EPO postal service was unable to despatch a decision on the date originally stamped, it was returned to the examining division where it was given a new date (14 November 2011) which again pre-dated the date of actual despatch (17 November 2011) by three working days.

Once proceedings had been completed the decision-making department could no longer amend its decision. Of course, if after initially having handed over a decision to the EPO postal service, that decision was returned to the department that issued it, then the department was competent once more and was therefore able to amend the decision by re-dating it in accordance with decision G 12/91, for despatch/ notification. Proceedings in the present case were thus clearly still pending when the examining division received the applicant's request for voluntary amendments on 11 November 2011 and therefore it should have considered this request.

Decision T 798/95, referred to by the present board, stated in points 5 and 6 of the Reasons that proceedings before the examining division in that case *"... were completed not later than at the end of the official working time on that date..."* and a letter from an applicant filed at 18:47 hours was considered to be filed *" ... after the completion of the proceedings before the Examining Division..."* which occurred at some earlier point during that working day. Notwithstanding that, in the present case, examination proceedings had still been pending on 11 November 2011, the applicant's letter of 11 November 2011 had been received during the working day of the examining division at the EPO. It had arrived electronically at a time of 15:33 hours (CET), which was three minutes after EPO staff in Munich completed their working day. However, the electronic filing receipt showing the time of 15:33 hours (CET) also showed that the receiving office of the electronic transmission was "European Patent Office, The Hague". The Hague branch of the EPO had been open for business until 18:00 hours (CET) on that day. The examining division was sited at all three

offices of the EPO, including The Hague, and was therefore still competent to receive the applicant's letter at 15:33 hours (CET) on 11 November 2011.

In refusing to consider the request for voluntary amendments filed by the applicant on 11 November 2011, the examining division had not followed the established correct practice and therefore had committed a procedural violation which justified reimbursement of the appeal fee.

XII. At the end of the oral proceedings the chairman announced the board's decision.

Reasons for the Decision

1. The appeal is admissible.
2. The appellant argues that, pursuant to Rule 71(4) EPC (and Rule 71(5) EPC, if necessary), the examining division should have taken account of the amendments filed with the EPO at 15:33 hours on 11 November 2011, since at that point in time the examining division had not yet completed the decision-making process following written proceedings. The essential question therefore is when exactly the proceedings before the decision-making department of first instance had been completed in the present case.
3. In its decision G 12/91 (OJ EPO 1994, 285), the Enlarged Board of Appeal decided that the decision-making process following written proceedings is completed on the date the decision to be notified is

handed over to the EPO postal service by the decision-taking department's formalities section (see Order and Headnote). The Enlarged Board of Appeal based its decision on the fact that, when a decision is handed over by the formalities section to the EPO postal service for notification, it is taken from the file and is therefore removed from the power of the department that issued it, and that this moment marked the completion of proceedings before the decision-making department (G 12/91, loc. cit., point 9.3 of the Reasons). It further held that once proceedings have been completed the decision-making department can no longer amend its decision but must disregard any fresh matter the parties may submit to the EPO thereafter (G 12/91, loc. cit., point 9.3 of the Reasons). According to established jurisprudence this finding applies to decisions of opposition divisions and examining divisions (see e.g. T 556/95, T 798/95, T 394/96 and T 355/03).

4. It follows from the above that, for determining the completion of proceedings before the decision-making department, it has to be established when the decision was handed over by the formalities section to the EPO postal service for notification.

5. The appellant submitted that, in accordance with established case law (G 12/91, loc. cit., point 9.1 of the Reasons; T 556/95, point 6 of the Reasons; T 394/96, point 4 of the Reasons) as well as with established EPO practice, the date of termination of proceedings was three days prior to the date of actual despatch of the decision which was stamped in the box marked "Datum/Date" at the upper right-hand side of the decision, irrespective of the date appearing in the box

marked "to EPO postal service" appearing in the footer of the decision.

6. The board, however, is of the view that, if it is clearly indicated in the decision on which date the formalities section handed the decision over to the EPO postal service, this date is directly brought to the knowledge of the parties and is thus the date on which written proceedings before the decision-making department are completed. This conclusion is in line with the findings in decision G 12/91 for the following reasons.
7. According to the facts underlying the referral decision in case G 12/91, it was not indicated in the decision of the first-instance department on which date the formalities section had handed over the decision to the EPO postal service (see G 12/91, loc. cit., point II of the Summary of Facts and Submissions). At that time, this date was never indicated in the EPO decisions despatched to the parties or otherwise discernible for the parties. Only the date on which the decision was to be despatched was stamped on the decision.
8. This conclusion is supported by several text passages of decision G 12/91 (loc. cit.):

- Point VI of the Summary of Facts and Submissions:

This section concerns the reply of the President of the EPO who had been asked by the Enlarged Board of Appeal to outline EPO practice at that time with regard to decisions following written proceedings before the opposition divisions. According to the submissions of the President of the EPO, at that time only two dates

were important with regard to the taking of a decision of an opposition division. The first date was the date on which the decision was signed by the members of the opposition division; this was indicated in the original copy of the decision (Form 2339), which was kept on file. This date was usually not communicated to the parties, unless a party questioned whether the composition of the opposition division was correct. The second date was the date on which the decision was to be despatched and which was entered in the decision notified to the parties. This date was of more importance to the parties because it indicated at what point in time the EPO had posted the decision, the point which under Rule 78(3) EPC 1973 was decisive for calculating time limits. To ensure that the date entered in the decision was indeed the date the decision was actually posted, decisions were systematically post-dated by three days. This practice was established by DG 2 Staff Notice 1/88-III dated 22 February 1988. If the decision could not be despatched on that date as intended, the EPO postal service returned it to the opposition division's formalities officer for the date to be changed accordingly.

- points 9 and 9.1 of the Reasons which read:

*"9. This only leaves date 4.(c), the **date** on which the date-stamped, post-dated decision is handed over to the EPO postal service by the formalities section.*

*9.1 At first sight, the fact that it is not directly brought to the knowledge of the parties would seem to militate against choosing this **date**. On the other hand it is a **date** the parties can ascertain very easily, because, as the President of the EPO explained, it is*

always three days prior to the date stamped. Internal EPO instructions make clear that a period of three days always elapses between the date-stamping of a decision and its despatch. If, for whatever reason, the EPO postal service is unable to despatch the decision on the date stamped, it returns the decision to the formalities section where it is given a new date, which again pre-dates the date of actual despatch by three days. This practice ensures that the date of despatch is always stamped on the decision three days before it is actually despatched. This date is therefore very easy to ascertain, both for the EPO and the parties. It thus fulfils the need for strict legal certainty which the handing down of a decision must ensure." (emphasis added by the board)

- point 9.3 of the Reasons which reads:

*"... Seeing that it is important for the parties to know at which **point in time** the decision-making process following written proceedings is completed, this **point in time** should be clearly indicated in the decision. The formalities section should also keep a register of the **dates** on which decisions are handed over to the EPO postal service to enable these **dates** to be ascertained at any time."* (emphasis added by the board)

9. The EPO followed the first of the above recommendations of the Enlarged Board of Appeal and added the following text to the decision forms of the first-instance departments: "to EPO postal service:...". This text was added at least as from 7 February 1995, as can be seen from the first-instance decision underlying case T 556/95.

10. In the present case, the wording of the footer of the decision to grant posted on 17 November 2011 reads "*EPO Form 2006A 12.07 (11/11/11)*" and "*to EPO postal service: 11/11/11*" (emphasis added by the board) and thus clearly indicates that this decision was handed over to the EPO postal service on Friday, 11 November 2011. That on this date the appealed decision was handed over to the EPO postal service is also clear from the footer of the "NOTE RELATING TO THE DECISION TO GRANT A EUROPEAN PATENT (EPO Form 2006A) which reads: "08162496.7 (11.11.11)" (emphasis added by the board).
11. On the basis of these facts and the board's view given above (see in particular point 6 above), the board concludes that in the present case the decision-making process following written proceedings was completed on Friday, 11 November 2011.
12. However, since the applicant filed electronically its letter containing a request under Rule 71(4) EPC at 15:33 hours on Friday, 11 November 2011 (see point IV above) and thus on the same date on which the decision was handed over to the EPO postal service, the question arises whether the chronological order of events on that date could lead to the conclusion that the decision-making process following written proceedings had not yet been completed in the present case when said letter was received by the EPO.
13. The order of decision G 12/91 (loc. cit.) reads:

*"The decision-making process following written proceedings is completed on the **date** the decision to be notified is handed over to the EPO postal service by*

the decision-taking department's formalities section." (emphasis added by the board)

According to this wording the smallest time unit is the **date** (German version: der Tag; French version: la date) as such and not an hour or the chronological order of events on a specific date. This would mean that the applicant's request under Rule 71(4) EPC should have been filed with the EPO at the latest one day before 11 November 2011, i.e. the date on which the decision-making process was completed, in order to be considered by the examining division.

14. But one could also argue in favour of the appellant that the chronological order of events on 11 November 2011 must be taken into account, in view of the finding of the Enlarged Board of Appeal in point 9.3 of its decision G 12/91 (loc. cit.) which reads:

*"When a decision is handed over by the formalities section to the EPO postal service for notification, it is taken from the file and is therefore removed from the power of the department that issued it. This **moment** marks the completion of proceedings before the decision-making department. Once proceedings have been completed the decision-making department can no longer amend its decision. It must disregard any fresh matter the parties may submit to the EPO **thereafter.**"* (emphasis added by the board)

15. However, even if the chronological order of events on 11 November 2011 were taken into account in the present case, the applicant's letter was filed after the decision was handed over to the EPO internal postal service. According to the published official opening hours of the EPO's Munich site, which are the only

relevant opening hours because the examining division in the present case was located in Munich, the applicant's letter was filed after the end of the official working time and thus after the completion of the proceedings before the examining division. This is also confirmed by the communication (EPO Form 2085) dated 21 November 2011, informing the applicant that the request for amendment of 11 November 2011 was received on 11 November 2011, but reached the examining division only after the decision to grant the European patent had been handed over to the EPO internal postal service.

16. Since the applicant's letter dated 11 November 2011 was filed after the completion of the proceedings before the examining division, the examining division was not competent to consider this letter even if, as submitted by the appellant, it contained a request under Rule 71(4) EPC (see G 12/91, loc. cit., point 9.3 of the Reasons; T 798/95, point 6 of the Reasons; and T 355/03, point 2 of the Reasons).
17. It follows from the above that, in the present case, the fact that the applicant's letter dated 11 November 2011 was not considered by the examining division does not give rise to a fundamental deficiency in the first-instance proceedings within the meaning of Article 11 RPBA. Nor does it constitute a substantial procedural violation within the meaning of Rule 103(1)(a) EPC.
18. In view of the above, the appeal must be dismissed and the appeal fee cannot be reimbursed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated