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**Datasheet for the decision  
of 21 July 2015**

**Case Number:** T 1436/12 - 3.5.06

**Application Number:** 03739486.3

**Publication Number:** 1504344

**IPC:** G06F9/46

**Language of the proceedings:** EN

**Title of invention:**

PLATFORM SYSTEM FOR MOBILE TERMINALS

**Applicant:**

Telefonaktiebolaget LM Ericsson (publ)

**Headword:**

Platform system/ERICSSON

**Relevant legal provisions:**

EPC 1973 Art. 111(1), 111(2), 113(1), 114(1)

EPC 1973 R. 111(2)

EPC Art. 123(2)

EPC R. 139

RPBA Art. 11, 15(6)

**Keyword:**

"Correction of reference to a document incorporated by referen  
ce not allowed as a correction or as an amendment"

**Decisions cited:**

G 0003/89, G 0001/99, G 0002/10, T 0689/90, T 0737/90,

T 0160/09

**Catchword:**

See points 7-12.



**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 1436/12 - 3.5.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.06**  
**of 21 July 2015**

**Appellant:** Telefonaktiebolaget LM Ericsson (publ)  
(Applicant) 164 83 Stockholm (SE)

**Representative:** Andersson, Björn E.  
Ström & Gulliksson AB  
P.O. Box 793  
220 07 Lund (SE)

**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 25 January 2012 refusing European patent application No. 03739486.3 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** W. Sekretaruk  
**Members:** M. Müller  
S. Krischer

## Summary of Facts and Submissions

I. The appeal lies against the decision of the examining division to refuse the European patent application no. 03739486.3 for lack of inventive step over the document D1 = WO 01/50282. In a section entitled "Obiter dictum", the decision also contained the finding that the claims were unclear.

II. A notice of appeal was filed on 14 March 2012, the appeal fee being paid on the same day. A statement of grounds of appeal was received on 10 May 2012. The appellant requested that the decision under appeal be set aside because the decision was insufficiently reasoned, Rule 111 (2) EPC, and based on hindsight, and because the inventive step assessment of the decision was incorrect. The board understood the appellant to request the grant of a patent based on the documents on file, namely:

description, pages

1-7, 9-11 as originally filed

8 received with letter of

10 November 2011

claims, no.

1-31 received with letter of

10 November 2011

drawings, sheets

1/4-4/4 as originally filed

Alternatively, the appellant requested that the case be remitted to the examining division for further examination. The appellant also criticized the decision for not dealing with its so-called "change request", that is whether the amendment to the description on page 8 was allowable; this request was relevant for potential

further clarification of the claims (see grounds of appeal, p. 7, 2nd para.).

III. Page 8 of the description as originally filed contained the following paragraph:

"Further specific features and details of the layered architecture, including the SwBP software structure that enables the internal communication between modules within the mobile platform assembly are described in commonly assigned, U.S. Patent Application Serial No. [Attorney Docket No. 53807-00023USPT] filed concurrently herewith, the disclosure of which is hereby incorporated by reference."

Page 8 as filed with letter dated 10 November 2011 was amended so that it now referred to a "[...] commonly assigned, PCT Patent Application [Attorney Docket No. 53807-00023USPT] filed concurrently herewith [...]".

IV. With a summons to oral proceedings, the board informed the appellant of its preliminary opinion, according to which no substantial procedural violation appeared to have occurred. The board also tended to consider that the "change request" could not be granted because amended description page 8 contained matter that went beyond the application as originally filed, Article 123(2) EPC. As a consequence, amended claim 1 (relying for some features exclusively on the amended page 8) also appeared not to comply with Article 123(2) EPC. In addition, the board raised a number of clarity objections, Article 84 EPC 1973, questioned whether the claimed invention had any discernible technical effect, and raised an inventive step objection, Article 56 EPC 1973. The board also introduced three documents from a related case, T 160/09, into the procedure.

V. In response to the summons to oral proceedings, the appellant argued that the board should remit the case for further prosecution or, at least, to continue the appeal proceedings in writing. It also indicated its willingness to further amend the pertinent passage on page 8 to refer either to

"[...] commonly assigned, PCT Patent Application WO 03/069463 filed concurrently herewith, [...]", to

"[...] commonly assigned, PCT Patent Application claiming priority from Serial No US 60/357291 filed concurrently herewith, [...]", or to

"[...] commonly assigned, U. S. Patent Application Serial No US 60/357291 filed concurrently herewith, [...]".

The appellant added that US 60/357291 was the application with docket number No. 53807-00023USPT as cited on page 8 as originally filed. The appellant did not provide any arguments regarding the board's objections under Articles 84 or 56 EPC 1973.

VI. During oral proceedings, the appellant maintained its request as summarized above. In particular, it confirmed its request that the patent should be granted based on a description containing amended page 8.

VII. At the end of the oral proceedings, the chairman announced the decision of the board.

## **Reasons for the Decision**

### *Alleged insufficient reasoning, Article 11 RPBA*

1. According to Article 11 RPBA, the board shall, absent special reasons to the contrary, remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings.
  
2. The appellant argued (see grounds of appeal, p. 7, 4th para.) that the decision under appeal was insufficiently reasoned, contrary to Rule 111(2) EPC, because it
  - i) relied on an inappropriate number of alleged implicit disclosures in D1 (grounds of appeal, p. 4, 6th para.), and
  - ii) did not deal with the appellant's "change request", i.e. its request to accept the amendment on page 8 as the correction of an error (see the grounds of appeal, p. 7, 2nd para.; and the letter of 10 November 2011, p. 1, 3rd para. - p. 2, 3rd para.).
  
- 2.1 *Regarding i)* The examining division gave its arguments as to why it considered some of the claimed features to be implicitly disclosed in D1. In the board's view, these arguments were sufficiently detailed and, moreover, sufficient to enable the appellant to address them in its grounds of appeal. Therefore, the board considers the decision to be sufficiently reasoned in this regard. It is immaterial for this finding whether or not the board agrees in substance with the examining division on this point.

- 2.2 *Regarding ii)* The board first notes that the EPC does not provide for a "change request" separate from the request for the grant of a European patent based on a specific set of application documents (see Article 78(1) EPC). Any amendment to the application documents must comply with Article 123(2) EPC. However, this issue need not be assessed in every decision, but may be left unanswered if the decision does not depend on it. This was presently the case. The examining division correctly listed page 8 amongst the application documents on file but, since it came to the conclusion that the application lacked an inventive step, could leave the question of whether it considered amended page 8 to comply with Article 123(2) EPC or not unanswered.
3. Furthermore, the appellant argued that the decision was based on hindsight because the examining division had overstated the similarities between the claimed architecture and figure 2 of D1 and had read more into D2 than was already there, as was evident from its inappropriate assumptions about what D2 implicitly disclosed (see grounds of appeal, p. 2, 3rd para. - p. 4, 4th para.). The board however cannot see any indication that the reasons given by the examining division were based on hindsight. In particular, the fact that the examining division disagreed with the appellant on the explicit or implicit disclosure of D1 and on the overall assessment of inventive step is insufficient to establish this.
4. In summary, no fundamental deficiency in the first instance proceedings is apparent to the board. Therefore, the board decided not to remit the case to the first instance under Article 11 RPBA, *i.e. without assessment of its merits.*



*Request for remittal or for continuation of the appeal proceedings in writing*

5. In response to the board's summons, the appellant requested that the case be remitted to the examining division. It argued as follows:
- a) In its summons, the board had established that the decision under appeal was wrong to assume that certain features were implicitly disclosed in the prior art (see letter dated 29 June 2015, p. 2, 3rd para.).
  - b) The examination procedure was the appropriate place for the appellant to take into account the new prior art cited by the board in its summons (p. 2, 5th para.).
  - c) The application would, in view of the newly raised objections, require extensive amendments for which the appeal proceedings gave little opportunity, as it was "aimed at wrapping up cases not to discuss them in detail" (p. 2, 4th and 6th para.). Under the special circumstances of the case, the appellant's right to be heard, Article 113(1) EPC, could not be properly exercised if the case was not remitted.
  - d) During the oral proceedings, the appellant also argued that the prohibition of *reformatio in peius* barred the board from deciding the case based on Article 123(2) EPC, an issue that had not been discussed, let alone decided, by the examining division.

Alternatively, the appellant requested that the proceedings before the board be continued in writing (p. 2, 7th para.).

6. The board notes that, since a direct remittal under Article 11 RPBA was not required under the circumstances, the only possible basis for a remittal could be Article 111(1) EPC 1973. According to Article 111(1) EPC 1973, the board shall decide on the appeal, and then may either exercise any power within the competence of the department which was responsible for the decision or remit the case to that department for further prosecution. Moreover, under Article 114(1) EPC 1973, the board is not restricted to the facts, evidence and arguments provided by the appellant. Once the board has raised new objections, indicating that the appeal might not be allowable, a remittal would be inappropriate. *Inter alia*, the board's objections raised in the summons would normally not be part of the *ratio decidendi* of a decision to remit, and would therefore not be binding on the examining division, Article 111(2) EPC 1973. In case of a remittal at this point, it could therefore not have been guaranteed that the board's objections were discussed in the first instance at all.

6.1 In addition to this, the board considers the following on the appellant's individual points.

6.2 *Regarding point a)* As expressly stated in the summons to oral proceedings, all observations made therein were made without prejudice to the final decision of the board. Moreover, the board did not take a firm position on the implicit disclosure of the features in question (see point 25 of the summons). Thus, the summons were insufficient for the appellant's conclusion that the appeal was successful in this regard.

6.3 *Regarding point b)* The newly introduced prior art was cited from a related case by the same applicant for

which a decision on appeal had already been issued (T 160/09, not published) and was meant for possible future reference in the interest of coming to a consistent decision in both cases. The objections raised in the summons, however, did, for the most part, not depend on these documents. The introduction of the new prior art thus did not prevent the appellant from addressing the board's objections which were based on the document relied on by the examining division or on no document at all (Articles 84 EPC 1973, Article 123(2) EPC, and Article 56 EPC 1973 for lack of a technical contribution over common knowledge in the art).

6.4 *Regarding point c)* The board considers that the time between the summons to oral proceedings, dated 21 April 2015, and the oral proceedings held on 21 July 2015, was sufficient for the appellant to address the board's objections. Moreover, had it turned out that the case was not ready for a decision at the conclusion of oral proceedings, no decision would have been issued, see Article 15(6) RPBA. The board therefore concludes that the appellant's right to be heard was not infringed by holding the oral proceedings as summoned.

6.5 *Regarding point d)* The prohibition of *reformatio in peius* is based on the principle that a decision may not be reached which would put the appellant in a worse position than it was in before it appealed (see G 1/99, OJ EPO, 2003, 381; reasons 2.1). The appeal was against the decision to refuse the European patent application. The appellant can therefore not be worse off after the board's decision to dismiss the appeal. That a dismissal might be based on different reasons than the decision under appeal, as is presently the case, is not excluded by the prohibition of *reformatio in peius*.

*The amendment on page 8, Article 123(2) EPC*

7. The amendment on page 8 relates to a document in which "[f]urther specific features and details of the layered architecture are described" and "the disclosure of which is [to be] incorporated by reference" into the application as originally filed.
- 7.1 It is established jurisprudence of the boards of appeal that the content of a European patent application may, in principle, be supplemented by information incorporated by reference from a cross-referenced document, if only under very limited conditions (see in particular T 689/90, OJ EPO, 1939, 616, headnotes; and T 737/90, not published, reasons 3).
- 7.2 Since the content of the present application as originally defined depends, at least in part, on the disclosure of the document referred to on page 8 of the description, any amendment to that reference is governed by Article 123(2) EPC.
- 7.3 According to established jurisprudence of the Enlarged Board of Appeal (see e.g. G 3/89, OJ EPO 1993, 117 and G 2/10, OJ EPO 2012, 376), an amendment to a European patent application is only allowable under Article 123(2) EPC if it is made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed.
- 7.4 The appellant requested that the amendment be accepted as the correction of an obvious error (see the letter dated 10 November 2011). The board notes that corrections are a special form of amendment so that the cited

- general requirement for allowable amendments still applies (see also G 3/89, OJ EPO 1993, 117; headnote 1). Moreover, Rule 139 EPC requires that a request for correction may only be allowed if the correction is obvious in the sense that it is immediately evident that nothing would have been intended other than what is offered as the correction.
8. On page 8 as originally filed, a document to be "incorporated by reference" was identified as a "U.S. Serial Patent Application No." and referred to by its "Attorney Docket Number". Even though, according to the USPTO, U.S. patent applications can be searched and retrieved by their docket number, this only applies under the general rule that U.S. patent applications are confidential before publication (35 U.S. Code §122).
  9. The present application was originally filed as International Application No. PCT/EP2003/001429 on 13 February 2003.
    - 9.1 Therefore, the reference on page 8 of that International Application to a U.S. patent application "filed concurrently herewith" refers to a U.S. patent application filed on 13 February 2003, too.
    - 9.2 At that date, its filing date, the U.S. patent application cannot have been available to the public from the USPTO, via its docket number or otherwise.
  10. The appellant argues that the cross-reference on page 8 constituted an obvious error.
    - 10.1 The appellant explained that it was common practice before the USPTO to use docket numbers to refer to U.S.

- patent applications for which, at the day of filing, no filing number was yet available. It was therefore clear that the docket number cited on page 8 was specific for the prosecution before the USPTO and should have been replaced for prosecution before the EPO. The fact that this had not been done when the International application was filed at the EPO constituted an obvious error.
- 10.2 The board is not convinced by this argument. As the appellant explained, patent applications meant for prosecution in different jurisdictions will often, in the interest of efficiency, only be drafted once.
- 10.3 In the board's view this implies that a patent application to be filed may contain parts which are only relevant for the prosecution in one jurisdiction but not in another.
- 10.4 Given that the incorporation by reference of features from a cross-referenced document falls under a different regime before the EPO than before the USPTO, the board deems it to be conceivable that the incorporation of the reference on page 8 was meant only for the prosecution before the USPTO and was, therefore, deliberately not amended when the International application was filed at the EPO.
- 10.5 Thus the board is not convinced that the reference to a docket number in an application filed at the EPO must generally be considered to have been made in error. For that reason alone, the amendment cannot be allowed under Rule 139 EPC.
11. Even if it was assumed, for the sake of argument, that it was obvious *that* an error had occurred, the board

considers that it would not be immediately evident *what* the correction should be.

- 11.1 In its letter of 10 November 2011 (p. 1, last para. - p. 2, 2nd para.), the applicant states that the passage on page 8 was "clearly meant to indicate that a Euro-PCT application was to be filed claiming priority from the US provisional indicated by the Attorney docket number given" and that "a co-pending Euro-PCT application (WO 03/069463) was in fact concurrently filed with the present application claiming priority from the US provisional application indicated".
- 11.2 The board disagrees. From the passage on page 8 as originally referring to a "U.S. Patent Application [...] filed concurrently herewith" it is not *immediately evident* that a corresponding (Euro-)PCT application was to be filed, let alone which one, or what priority it might claim. With regard to the third alternative formulation proposed by the appellant (see point V above), the board notes that it was also not immediately evident from original page 8 that US 60/357291 was meant.
- 11.3 Assuming, still for the sake of argument, that the reference to a concurrently filed application in an International application had to be construed as the reference to a concurrently filed International application, the board notes that there were at least three of these: WO 03/069463 entitled "Layered architecture for mobile terminals", WO 03/069469 entitled "Mobile multimedia engine", and WO 03/069472 entitled "Middleware services layer for platform system for mobile terminals". The appellant argued that it would have been obvious for the skilled person that the first of these applications was the intended one since its title re-

- ferred to a "layered architecture" and because its publication number was next to the publication number in the present case (WO 03/069464).
- 11.4 The board however disagrees, noting that all three applications relate to the layered software architecture at issue in the present application and that the statement on original page 8 gives no preference to one application over another, depending on the application number.
- 11.5 The board therefore comes to the conclusion that the requested amendment to page 8 identifying the cross-referenced application as a "PCT Patent Application" cannot be allowed as a correction under Rule 139 EPC. The same applies for the alternative formulations proposed by the appellant.
12. It remains to be determined whether amended page 8 might be allowable, if not as a correction under Rule 139 EPC, then as a general amendment under Article 123(2) EPC.
- 12.1 The appellant argued that the skilled person, trying to establish which document original page 8 referred to, would have had to identify concurrently filed applications by the same applicant, retrieve them at the USPTO, obtain their associated docket numbers, identify the one disclosed on page 8, and then identify the associated International application. The appellant further argued that for an amendment to be allowable it did not have to be simple for the skilled person to establish whether it was original disclosed, provided that it was unambiguously possible.
- 12.2 The board notes that the procedure proposed by the appellant required that the U.S. patent application



identified by the docket number was published. However, since it was not published until 18 months after the filing date, the U.S. application was not available, to the public or only the EPO, on the filing day of the present application. Hence, the amendment would not have been derivable by the skilled person, directly and unambiguously, from the application on its day of filing.

12.3 The board agrees that it need not be *simple* to establish whether an amendment is allowable under Article 123(2) EPC. However, any allowable amendment must not only be unambiguously derivable from the application as originally filed, but also be *directly* so. Likewise, for a correction under Rule 139 EPC to be allowable, it must not only be clear what the correction should be but it must be *immediately evident*. Even if, therefore, the procedure proposed by the appellant were to work, it would not satisfy the strict standards for amendments under Article 123(2) EPC, let alone those for corrections under Rule 139 EPC.

12.4 The board therefore comes to the conclusion that neither the amendment on page 8 as presently on file nor any of the proposed alternatives (see point V above) comply with Article 123(2) EPC.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sekretaruk

Decision electronically authenticated