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**Datasheet for the decision  
of 15 June 2015**

**Case Number:** T 1775/12 - 3.4.02

**Application Number:** 08000126.6

**Publication Number:** 1914578

**IPC:** G02B6/44, H04Q1/14

**Language of the proceedings:** EN

**Title of invention:**

Fiber distribution hub with pivotally mounted chassis

**Applicant:**

ADC Telecommunications, Inc.

**Headword:**

Second oral proceedings/ADC Telecommunications

**Relevant legal provisions:**

EPC Art. 116(1) sentence 2

EPC R. 103(1) (a), 137(3)

**Keyword:**

Power to refuse second oral proceedings (no)

Substantial procedural violation (yes)

**Decisions cited:**

T 0573/12, T 2193/09, T 0573/09, T 1837/07, T 1707/07,  
T 1064/04, T 0078/98, T 0298/97, T 0194/96, T 0556/95,  
T 0529/94, T 0731/93, T 0692/90, T 0614/90, T 0547/88

**Catchword:**

The procedural issue of admission under Rule 137(3) EPC of amendments filed in response to a communication under Rule 71(3) EPC constitutes a "subject of the proceedings" within the meaning of Article 116(1), second sentence, EPC which is distinct from the discussion of matters of substantive law that has previously taken place at oral proceedings.



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Case Number: T 1775/12 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 15 June 2015**

**Appellant:** ADC Telecommunications, Inc.  
(Applicant) 13625 Technology Drive  
Eden Prairie, MN 55344 (US)

**Representative:** Bohnenberger, Johannes  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 23 March 2012  
refusing European patent application  
No. 08000126.6 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** F. J. Narganes-Quijano  
**Members:** H. von Gronau  
L. Bühler

## **Summary of Facts and Submissions**

- I. The present appeal lies from the decision of the examining division posted on 23 March 2012 refusing European patent application No. 08000126.6 pursuant to Article 97(2) EPC.
  
- II. In the exercise of its discretionary powers pursuant to Rule 137(3) EPC, the examining division did not admit the amendments to the claims requested with letter dated 30 September 2011 in reply to the communication under Rule 71(3) EPC of the examining division's intention to grant a patent. As a consequence, there was no text of the application which had been agreed by the applicant and upon which the examining division could take a decision (Article 113(2) EPC). The patent application was thus refused. The examining division also refused the request for second oral proceedings made by letter dated 20 February 2012. The examining division considered that it was not necessary to hold further oral proceedings, because no substantially new situation had arisen in terms of Article 116(1), second sentence, EPC.
  
- III. With the statement of grounds of appeal filed on 23 July 2012, the appellant (applicant) requested that the decision under appeal be set aside, that the amended claims filed with letter dated 30 September 2011 be admitted into the proceedings, and that a patent be granted on the basis of these claims. Oral proceedings were requested.
  
- IV. In its statement of grounds of appeal, the appellant took issue with the examining division's finding that the amendments to the set of claims filed on 30 September 2011 required a new analysis of inventive

step of the claimed invention, thus leading to an appreciable delay in the preparations for grant of the patent. The appellant argued that the examining division had only to consider whether the deleted features in claim 1 contributed to the inventiveness of the subject-matter of claim 1. It also asserted that the omitted features were not relevant for inventive step of the amended claims and that their admission into the proceedings would not have unduly delayed the examining proceedings.

- V. With communication posted on 20 March 2015, the board expressed its preliminary opinion that there was no need to review the exercise by the examining division of its discretionary powers under Rule 137(3) EPC, since the refusal of the examining division to hold further oral proceedings as requested by the appellant constituted a fundamental deficiency in the first-instance proceedings. The appellant was informed that the board was minded to set aside the contested decision, to remit the case to the department of first instance for further prosecution (Article 111(1), second sentence, EPC and Article 11 RPBA), and to order reimbursement of the appeal fee (Rule 103(1)(a) EPC).
- VI. In its reply of 16 April 2015, the appellant declined to comment further on the preliminary opinion of the board, and withdrew its request for oral proceedings on the understanding that the final decision would not deviate from the preliminary opinion.
- VII. The appellant requests that the decision under appeal be set aside, that the case be remitted to the department of first instance for further prosecution and that the appeal fee be reimbursed (Rule 103(1)(a) EPC).

## **Reasons for the Decision**

### *Applicable law*

1. The present application was filed on 4 January 2008 as a divisional application to application No. 04811128.0. It was refused with decision posted on 23 March 2012.

Therefore, Rule 71 EPC in the version in force as of 13 December 2007 (Article 4(2) of the decision of the Administrative Council of 26 October 2010 amending the Implementing Regulations to the European Patent Convention and the Rules relating to Fees [CA/D 2/10], OJ EPO 2010, 637) and Rule 137(3) EPC in the version in force as of 13 December 2007 (Article 2(2) of the decision of the Administrative Council of 25 March 2009 amending the Implementing Regulations to the European Patent Convention [CA/D 3/09], OJ EPO 2009, 299) apply.

### *Second oral proceedings*

2. In the present case, oral proceedings were held before the examining division on 7 April 2011. At the oral proceedings, the main request filed on 4 March 2011 was found not to be allowable. However, the examining division informed the applicant of its intention to grant a patent on the basis of the auxiliary request filed at the oral proceedings. The communication to that effect under Rule 71(3) EPC was posted on 23 May 2011.
3. With letter of 30 September 2011, the applicant filed amended claims. In a communication of 24 October 2011, the examining division informed the appellant that it did not consent to the amendments (point 4 of the communication). In its reply dated 20 February 2012, the appellant disagreed with the examining division on this

issue (points 1 and 2 of the letter) and requested oral proceedings "as a matter of precaution". The request for oral proceedings did not specify what the applicant wished to discuss at the oral proceedings. However, the request is to be interpreted in the light of the requester's objectively discernible will and taking account of the particular circumstances of the case. Since the applicant was taking issue with the examining division's exercise of its discretion under Rule 137(3) EPC, this procedural issue was encompassed by the request for oral proceedings.

4. Without holding further oral proceedings, the examining division refused the patent application. In its decision, the examining division stated that second oral proceedings had been refused pursuant to Article 116(1), second sentence, EPC, because they would have dealt with issues that had already been the subject of the oral proceedings of 7 April 2011, namely examination of claim 1 with respect to the requirements of Article 56 EPC. No substantially new situation had arisen to justify second oral proceedings.
5. According to Article 116(1), second sentence, EPC, the European Patent Office may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same (German: "wenn die Parteien und der dem Verfahren zugrunde liegende Sachverhalt unverändert geblieben sind"; French: "pour autant que les parties ainsi que les faits de la cause soient les mêmes").

The point of law to be decided in the present case is whether the examining division had the power pursuant to Article 116(1), second sentence, EPC to refuse further oral proceedings. The answer hinges on the question of

whether the procedural issue of admission under Rule 137(3) EPC of amendments filed in response to a communication under Rule 71(3) EPC constitutes a "subject of the proceedings" within the meaning of Article 116(1), second sentence, EPC which is distinct from the discussion of matters of substantive law that has previously taken place at oral proceedings.

The board sought guidance on this point of law in the preparatory work to the EPC (point 6 below) and the jurisprudence of the boards of appeal (point 7 below).

6. Since Article 116 EPC was not revised in 2000, the preparatory work on the EPC 1973 is still pertinent as a supplementary source for the interpretation of said Article.
- 6.1 The aim of what ultimately became Article 116(1), second sentence, EPC 1973 is set out in the minutes of the Main Committee (M/PR/I, p. 55, points 523 to 528). It was considered that the draft under consideration did not provide assurance against abuse of the right to request oral proceedings. It was thus proposed to clarify that the European Patent Office was not required to grant an application for more than one set of oral proceedings on the same question and could refuse to hold further proceedings (M/PR/I, p. 55, point 523). The Main Committee adopted the proposal and referred some comments on drafting to the Drafting Committee (M/PR/I, p. 55, points 524 to 526). The Drafting Committee submitted a text allowing the European Patent Office to refuse a request for further oral proceedings before the same body if the basic facts on which the proceedings were based remained unchanged (M/PR/I, p. 55, point 527). Upon a further proposal, it was clarified that the



right to refuse applied only if the parties concerned also remained unchanged (M/PR/I, p. 55, point 528).

- 6.2 It emerges from the initial proposal, which used the term "same issues", and the comments on drafting in the Main Committee (namely the comment by FICPI, M/PR/I, p. 55, point 525) that the EPO should not be entitled to refuse further oral proceedings if the issue (e.g. inventive step) remained the same but the underlying basic facts did not. The diplomatic conference did however not adopt a formulation which made a refusal of further oral proceedings dependent upon the "basic facts" remaining unchanged (as reported in M/PR/I, p. 55, point 527), but used the words "subject of the proceedings" which can be understood as combining the factual basis and the legal issues discussed at the first oral proceedings. In contrast, the German and French texts refer to the facts underlying the proceedings. There is however no statement in the preparatory work which would allow it to be inferred from this divergence that the legislator intended to empower the EPO to refuse further oral proceedings if, based on the same facts, further legal issues were raised. But nor is any legislative intent apparent that the prevention of "abuse of the right to request oral proceedings" should encompass more than just avoiding repetition of oral proceedings on identical matter.

7. The board has taken the following jurisprudence of the boards of appeal into consideration:

- 7.1 In T 529/94 of 9 October 1997, the applicant submitted amended sets of claims each comprising two additional dependent claims, namely claims 3 and 4, which were received by the EPO shortly after the dispatch of the communication under Rule 51(4) EPC 1973 and after oral

proceedings. The applicant also requested that a second oral proceedings be scheduled in the event that the amendments were not accepted by the examining division. In two communications, the examining division raised objections under Article 123(2) EPC 1973. Furthermore, making use of its discretionary power under Rule 86(3) EPC 1973, it refused consent to the amendments requested. Further, the examining division held that the subject-matter of the dependent claims had already been properly discussed during the first oral proceedings, and there was therefore no reason for a second hearing. On appeal, the applicant argued *inter alia* that the examining division had committed a substantial procedural violation in refusing further oral proceedings to discuss the allowability under Article 123(2) EPC 1973 of claims 3 and 4.

The relevant finding of the board reads as follows (point 3.1 of the Reasons):

"In the board's opinion, the examining division, in exercising the discretionary power under Rule 86(3), has considered newly filed claims 3 and 4 as inadmissible (letter of 29 October 1993 and decision). The legal consequence of this measure was that claims 3 and 4 were never integrated into the text of the application and never became part of it.

For this reason denying a second oral proceedings intended to discuss the allowability of proposed amendments already judged as inadmissible cannot constitute a procedural violation."

From the latter statement that "second oral proceedings [were] intended to discuss the allowability of proposed amendments" it is however apparent that the board in

T 529/94 understood the applicant's request for second oral proceedings to be limited to matters of substantive law, that is the allowability under Article 123(2) EPC 1973 of claims 3 and 4. This is corroborated by the summary of the appellants arguments (see point III of the decision). The applicant thus did not intend to discuss the procedural issue of the admission of the amendments at the second oral proceedings it had requested. Further support for this interpretation is the board's finding that the examining division had properly exercised its discretion under Rule 86(3) EPC 1973 (point 4 of the Reasons) and that, as a consequence, the amendments were not within the proceedings. The need for second oral proceedings was thus considered against the background that admission of the amendments into the proceedings had already been discussed and decided. The *ratio decidendi* of decision T 529/94 cannot therefore be applied to the present case, where the request for oral proceedings is not confined to matters of substantive law but encompasses the procedural question of admission of the amendments pursuant to Rule 137(3) EPC.

- 7.2 In decision T 1837/07 of 3 May 2011 the board held that the examining division should have admitted the second auxiliary request into the proceedings, which would have changed the subject of any further oral proceedings. Relying on a procedural situation where the request filed in response to a communication under Rule 71(3) EPC had to be regarded as being within the proceedings, the board found that oral proceedings should have been held as requested by the applicant. Because the board in T 1837/07 disagreed with the examining division's exercise of its discretion over the admission of amended requests before considering the need for further oral proceedings on matters of substantive law, the decision

does not give guidance on the issue to be considered in the present case.

7.3 Decisions T 731/93 of 1 December 1994 and T 194/96 of 10 October 1996 also differ from the present case. Both decisions deal with the interpretation of Article 116(1), second sentence, EPC 1973, but concern cases in which the factual circumstances underlying the proceedings had changed in the meantime. According to T 731/93, if fresh evidence has been admitted into the proceedings, the "subject" of such proceedings in the meaning of Article 116(1), second sentence, EPC 1973 can no longer be the same. In that case the fresh evidence amounted to experimental evidence (see point 5 of the Reasons). In T 194/96, new citations were submitted, at least one of which was regarded as more pertinent than the documents on file. This document changed the nature of the decision. Therefore, the subject of the proceedings within the meaning of Article 116(1), second sentence, EPC 1973 was considered to no longer be the same (point 3 of the Reasons).

7.4 Several decisions have also dealt with the issue of second oral proceedings at the appeal stage. In T 614/90 of 25 February 1994, oral proceedings took place before the board, but the appeal proceedings were continued thereafter in writing. The patent proprietor (respondent) filed a second auxiliary request (in addition to a main request and a first auxiliary request filed during oral proceedings) and requested further oral proceedings or, alternatively, to be given a further opportunity to comment in writing on the board's reasons for refusing to hold further proceedings. The board did not consider further oral proceedings to be expedient. It argued that "the main and the first auxiliary requests were the subject of the proceedings

before the Board on 27 October 1993; as to the second auxiliary request, ... it is not clearly allowable and, therefore, not admitted into consideration" (point 3 of the Reasons). The board also refused the request for an opportunity to comment in writing. It seems that the board understood the request for further oral proceedings to be related to a discussion of substantive matters and not to the procedural issue of admission of the second auxiliary request.

- 7.5 In case T 692/90 of 28 September 1993, the board interpreted the term "subject" in Article 116(1), second sentence, EPC 1973 with reference to the German text as referring to facts, but not to the legal assessment of facts (point 6 of the Reasons). The board refused to hold further oral proceedings on appeal, since the purpose of continuing the proceedings in writing after first oral proceedings was to provide further clarifications with regard to the same facts as discussed during oral proceedings. Similar conclusions were reached by the boards in cases T 547/88 of 19 November 1993 (point 2 of the Reasons) and T 298/97 of 28 May 2001 (point 13 of the Reasons).
8. Neither the preparatory work to the EPC 1973 (point 6 above) nor the jurisprudence of the boards of appeal discussed above (point 7) gives clear guidance as to whether the procedural issue of admission of late-filed amendments under Rule 137(3) EPC constitutes a "subject of the proceedings" within the meaning of Article 116(1), second sentence, EPC which is distinct from the discussion of matters of substantive law that has previously taken place at oral proceedings. In the board's judgement, this question is to be answered in the affirmative, for the following reasons:

8.1 The board agrees with decision T 556/95 (OJ EPO 1997, 205) that oral proceedings can be requested for discussion of substantive **or** procedural matters and that oral proceedings have to be appointed, on request, to discuss amendments submitted after the issue of a communication under Rule 51(6) EPC 1973 (second headnote and point 4.4 of the Reasons). The board is aware that the facts underlying decision T 556/95 differ from the present case in that no oral proceedings were held prior to the examining division's decision not to admit the amendments. The *ratio decidendi* of decision T 556/95 is thus confined to the finding that Article 116(1), first sentence, EPC 1973 imposes an absolute obligation on the EPO to hold oral proceedings once these have been requested by a party to the proceedings. The principle, set forth in point 4.4 of the Reasons and in the second headnote, that oral proceedings can be requested and have to be appointed for discussion of any remaining procedural request, nevertheless holds good in the context of Article 116(1), second sentence, EPC, when considering whether or not the "subject of the proceedings" has remained the same. The term "subject of the proceedings" used in Article 116(1), second sentence, EPC, cannot be interpreted without having regard to what can be the subject of oral proceedings according to Article 116(1), first sentence, EPC. In the board's judgement, it follows from T 556/95 that the admission under Rule 137(3) EPC of amendments filed in response to a communication to Rule 71(3) EPC is a subject of examination proceedings distinct from any prior discussion on patentability. Therefore, if amendments are filed subsequent to first oral proceedings and further oral proceedings are requested for discussion of the procedural issue of admission of the amendments into the proceedings under Rule 137(3) EPC, the procedural issue of admission has to be

considered as a change in the subject of the proceedings within the meaning of Article 116(1), second sentence, EPC, requiring the appointment of second oral proceedings.

8.2 This finding is also in line with decisions on the requirement of substantiation of appeals in cases where an application was refused on the ground that there was no agreed set of claims after the examining division had refused consent under Rule 137(3) EPC (Rule 86(3) EPC 1973) to amendments filed in response to a communication according to Rule 71(3) EPC (Rule 51(4) EPC 1973). In such cases, the factual and legal framework of an appeal is confined to the procedural issue of whether the examining division lawfully exercised its discretion under Article 137(3) EPC (unless the absence of an agreed set of claims is disputed). Therefore, the applicant has to give reasons in his statement of grounds of appeal why it considers the examining division's exercise of its discretion under Rule 137(3) EPC not to admit the applicant's request to be incorrect (T 573/09 of 26 September 2012, points 2.1, 2.4 and 2.5 of the Reasons; T 1707/07 of 10 May 2011, points 5 and 7 to 9 of the Reasons; T 2193/09 of 13 July 2010, points 1.4 and 1.5.2 of the Reasons; T 1064/04 of 27 June 2008, point 2 of the Reasons; and T 78/98 of 30 October 2001, point 1 of the Reasons). A finding that the examining division did not correctly exercise its discretionary power is a prerequisite for any review of substantive matters (see e.g. decision T 573/12 of 8 May 2013 holding that the examining division did not properly exercise its discretionary power). Admission of amendments under Rule 137(3) EPC is therefore distinct from any matters of substantive law discussed before the department of first instance.

- 8.3 Indeed, if the applicant, in reply to a communication under Rule 71(3) EPC, files amendments replacing the requests discussed during oral proceedings, the factual and legal framework of the proceedings changes: the text which has formed the basis of examination is no longer agreed to, as required by Article 113(2) EPC, and cannot, therefore, serve as a basis for the grant of a patent. The amendments, on the other hand, do not become part of the proceedings with their filing but must be admitted into the proceedings by the examining division. Resumption of substantive examination thus depends on the amendments being admitted into the proceedings. This procedural question has thus to be decided before any discussion as to substance can ensue. Again, these considerations lead the board to affirm that the procedural issue of admission under Rule 137(3) EPC of amendments filed in response to a communication under Rule 71(3) EPC constitutes a "subject of the proceedings" within the meaning of Article 116(1), second sentence, EPC which is distinct from the discussion of matters of substantive law that has previously taken place at oral proceedings.
9. The board has also considered the possibility that the above interpretation of Article 116(1), second sentence, EPC may give rise to complications and delays in examining proceedings, to the detriment of legal certainty and procedural efficiency. However, Article 116(1), second sentence, EPC is one of two exceptions to the right to oral proceedings which is, according to the established jurisprudence, an absolute right. Whereas Article 116(2) EPC confers broad (although not unlimited) discretionary powers on the Receiving Section with respect to the appointment of oral proceedings, the conditions specified in Article 116(1), second sentence, EPC in which the EPO has discretion to reject a request



for oral proceedings, are limited. Since considerations of expediency and procedural economy cannot take precedence over the right to oral proceedings enshrined in Article 116(1), first sentence, EPC, such considerations cannot, in the absence of a clear intention to the contrary on the part of the legislator, warrant a broad interpretation of the exception in Article 116(1), second sentence, EPC which would limit the right to oral proceedings.

10. For the above reasons, the examining division had no power, in the circumstances of the case, to refuse the appellant's request for second oral proceedings. The examining division was thus wrong in law to issue its written decision without having appointed oral proceedings as requested by the appellant. This failure constitutes a fundamental deficiency in the first-instance proceedings which justifies remittal (Article 111(1), second sentence, EPC and Article 11 RPBA).

*Reimbursement of the appeal fee*

11. According to Rule 103(1)(a) EPC, reimbursement of the appeal fees is to be ordered in the event of interlocutory revision or where the board of appeal deems an appeal allowable, if such reimbursement is equitable by reason of a substantial procedural violation.
12. In the present case, the appellant had a right to be heard orally on the issues to be taken into account by the examining division in the exercise of its discretion under Rule 137(3) EPC. At the oral proceedings, the appellant could have presented further arguments attempting to refute the examining division's arguments.

It cannot be excluded that the opportunity to comment at oral proceedings could have influenced the examining division's decision under Rule 137(3) EPC. The failure of the examining division to hold second oral proceedings which had been clearly requested by the appellant thus constitutes, in the circumstances of the case, a substantial procedural violation that justifies reimbursement of the appeal fee.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



M. Kiehl

F. J. Narganes-  
Quijano

Decision electronically authenticated