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Datasheet for the decision of 5 September 2017

Case Number: T 1972/13 - 3.5.03

Application Number: 08290801.3

Publication Number: 2159926

IPC: H04B1/707, H04B7/185

Language of the proceedings: EN

Title of invention:
Methods, apparatuses and system for asynchronous spread-spectrum communication

Applicant:
AGENCE SPATIALE EUROPEENNE

Headword:
Spread spectrum communication/ASE

Relevant legal provisions:
EPC Art. 113(1)
EPC R. 103(1)(a)
RPBA Art. 11

Keyword:
Right to be heard - substantial procedural violation (yes)
Reimbursement of appeal fee - (yes)
Remittal to the department of first instance - (yes)
Second decision after decision to refuse null and void

Decisions cited:
T 2373/11, T 1257/08, T 0830/03

Catchword:
see points 1.4, 1.5, and 2.3

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Case Number: T 1972/13 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 5 September 2017

Appellant: (Applicant)	AGENCE SPATIALE EUROPEENNE 8-10, rue Mario Nikis 75735 Paris (FR)
Representative:	Gevers & Orès 41 avenue de Friedland 75008 Paris (FR)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 9 April 2013 refusing European patent application No. 08290801.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	F. van der Voort
Members:	T. Snell
	O. Loizou

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division dated 9 April 2013 refusing European patent application No. 08290801.3, with publication number EP 2159926 A.

The refusal was based on the ground inter alia that the subject-matter of claim 1 of a main request and claim 1 of an auxiliary request did not involve an inventive step.

II. On 5 June 2013 the appellant filed a notice of appeal against the above decision.

III. In a separate decision dated 10 June 2013 (henceforth, "second decision"), the examining division refused a request pursuant to Rule 64(2) EPC for reimbursement of an additional search fee in respect of claims 8 and 9.

IV. The appellant subsequently filed a statement of grounds of appeal. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request or the claims of one of two auxiliary requests as filed with the statement of grounds of appeal.

In the statement of grounds of appeal, the appellant also requested reimbursement of the appeal fee due to an alleged violation of the right to be heard under Article 113(1) EPC.

The appellant conditionally requested oral proceedings "in case the Board of Appeal envisages to refuse the appeal".

V. The essential steps (i.e. those most relevant to the board's present decision) leading to the refusal of the application may be summarised as follows:

(i) In a letter of reply, referred to in the impugned decision as "R1", to an earlier communication of the examining division ("C1"), the applicant inter alia requested a refund of an additional search fee for claims 8 and 9 pursuant to Rule 64(2) EPC.

(ii) In a communication, referred to in the impugned decision as "C2", the examining division raised inter alia an inventive step objection based on the disclosure of document D1, and indicated that the additional search fee would not be refunded.

(iii) With a response referred to as "R2", the applicant filed amended claims of respectively a main and an auxiliary request, together with arguments, and maintained the request for refund of the additional search fee.

(iv) In a communication (referred to as "C3") accompanying a summons to attend oral proceedings (which had not been requested by the applicant), the examining division inter alia raised a new inventive step objection in respect of both main and auxiliary requests, starting out from document D2 and taking into account the teaching of document D1.

(v) With a response dated 9 July 2012, referred to as "R3", the applicant filed amended claims of respectively a main and an auxiliary request, together with arguments. In addition, the applicant requested "cancellation of the oral proceedings and the

continuation of the examination in writing, possibly supplemented by a telephone interview with the primary examiner, if the Examination Division deems it expedient". Subsidiarily it was requested "that the oral proceedings are conducted by video-conference, using IP technology; and that the date of the oral proceedings is changed".

(vi) On 11 October 2012, the applicant's representative contacted the primary examiner by telephone asking "whether the proceedings could be cancelled, and if not whether they could be postponed ... or held by visio *[sic]* conference" (cf. the minutes dated 30 October 2012 of the telephone conversation of 11 October 2012). The examiner replied "that he would have a look at the case and at the internal instructions before giving an answer" (idem).

(vii) With a communication dated 23 October 2012, the applicant was informed that the oral proceedings scheduled for 14 November 2012 were cancelled and that the procedure would be continued in writing.

(viii) The decision to refuse the application was issued on 9 April 2013. In the reasons for the decision, in points 18 and 21 concerning the oral proceedings, it is stated that "The applicant never requested oral proceedings to be hold" *[sic]* and "The examining division consented to the request of the applicant to cancel the oral proceedings and to continue the examination in writing, thereby issuing this decision [board's underlining].". Further, in point 27.1 of the reasons, the examining division gives a response to an argument said to have been submitted in the applicant's response "R3".

(ix) The second decision (see point III above) concerning refusal of the request for refunding the additional search fee was issued on 10 June 2013.

VI. In view of the board's decision, it is not necessary to reproduce the wording of any claim.

Reasons for the Decision

1. The right to be heard (Article 113(1) EPC)

1.1 In the statement of grounds of appeal, the appellant submits two main arguments as to why its right to be heard has been infringed:

(i) The response "R3" contained a "detailed" reasoning and "actually new arguments" to which "no answer has been provided by the Examining Division until the refusal notification in item 27.1. Thus the applicant had no opportunity to present his comments on this new ground stated in item 27.1 in the notification under appeal".

(ii) "Moreover, in reply R1 *[sic]* to the first communication C2 of the Examining Division, the Applicant has filed at least one admissible request and provided a reasoned statement in support to the patentability of its subject-matter, that following the Applicant’s reply, the Examining Division has adopted a different approach to assess the patentability of the invention: while in the first communication of April 5, 2011 document D1 was considered as the primary reference and the subject-matter of claim 1 was held to lack an inventive step over document D1 alone, in the Preliminary Opinion accompanying the Summon *[sic]* to attend oral proceedings C3, D2 is considered as the

closest prior art, and D1 is used as a secondary reference. Thus the applicant demonstrated his good will concerning the progress of the written proceedings.

Thus, the continuation of the examination in writing would have consisted in the present case in giving the possibility for the applicant to respond to a notification pursuant 94(3) EPC or to oral proceedings [board's underlining]".

1.2 It is not necessary to consider argument (i), because the board agrees with the appellant that the examining division should either have issued a communication or have held oral proceedings (argument (ii)), for the reasons set out below.

1.3 In the applicant's response R3, it substantiated its request for cancellation of the oral proceedings and continuation in writing as follows:

> "I. Oral proceedings would be untimely and unnecessary
>
> It is not contended that the Examining Division can arrange for oral proceedings *ex officio* whenever it consider *[sic]* it expedient, even against the will of the Applicant.
>
> However, the Examining Division should also bear in mind the need for economy, since oral proceedings (even in the form of video-conference) give rise to very significant costs for both the EPO and the Applicant.

Oral proceedings are expedient when the written proceedings are in a dead end, and no progress is made toward grant or rejection [board's underlining].

This is not the case here [board's underlining]. In reply to the first communication of the Examining Division, the Applicant has filed at least one admissible request and provided a reasoned statement in support to the patentability of its subject-matter.

It is worth noting that, following the Applicant's reply, the Examining Division has adopted a different approach to assess the patentability of the invention: while in the first communication of April 5, 2011 document D1 was considered as the primary reference and the subject-matter of claim 1 was held to lack an inventive step over document D1 alone, in the Preliminary Opinion accompanying the Summon *[sic]* to attend oral proceedings D2 is considered as the closest prior art, and D1 is used as a secondary reference.

This provides evidence that the examination is not stuck and can continue in writing, at a lesser cost for both the EPO and the Applicant [board's underlining].

Subsidiarily, the Applicant requires *[sic]* that the oral proceedings are conducted by video-conference, using IP technology, in order to save time and costs [board's underlining].

> Moreover, a change to the date of the oral proceedings is required *[sic]* [board's underlining]."

1.4 It follows from the above submission, especially those passages underlined by the board, that the applicant's main request for continuing in writing with a subsidiary request concerning oral proceedings, although imprecisely worded, did not embrace the issuing of an immediate decision without holding oral proceedings. This is clear from the reasons given as to why continuing in writing was regarded as preferable to the holding of oral proceedings. In particular, oral proceedings would be "untimely", i.e. premature, inter alia because the examination procedure was not "stuck", i.e. still in a state of flux. Further, it lacks any semblance of logic to request as a first preference the issuing of a direct written decision, as the examining division apparently interpreted the appellant's main request, and, as a second preference, the holding of oral proceedings (in this case, by video conference on a different date). In the board's view, the only logical interpretation of the applicant's submission R3 is that it did not consider the examination procedure as being at an end but wished it to continue, preferably in writing by issuing a communication or, if not, by holding oral proceedings (in this case by video conference on a different date). The board further considers that having read the applicant's letter, the examining division at the very least should have been in doubt as to the status of the applicant's requests regarding the continuation in writing and the oral proceedings and should have requested clarification from the applicant in order to avoid committing a substantial procedural violation (cf. T 2373/11, points 2.5 to 2.8 of the reasons). The board notes finally

that, in view of the new situation brought about by the letter R3, it is not relevant that oral proceedings were initially arranged *ex officio* and not in response to a request by the applicant.

1.5 The board concludes that the examining division infringed the applicant's right to oral proceedings, thereby infringing the applicant's right to be heard enshrined in Article 113(1) EPC. The violation of the right to be heard constitutes a substantial procedural violation justifying the reimbursement of the appeal fee (Rule 103(1)(a) EPC).

2. The second decision issued by the examining division refusing a request for refunding an additional search fee - decision null and void

2.1 The applicant's request for refunding an additional search fee was refused in a second decision issued by the examining division (see point III above). Before the second decision was issued, an appeal had been filed against the first decision.

2.2 The board considers that the first decision refusing the application pursuant to Article 97(2) EPC terminated the proceedings before the examining division. After notification of the decision, the examining division had no power to go beyond a correction of errors in the decision pursuant to Rule 140 EPC (cf. T 830/03, point 1.2 of the reasons), or, considering that an appeal had been filed, granting interlocutory revision pursuant to Article 109 EPC. It follows that the second decision taken by the examining division after the notification of the first decision, and *a fortiori* after the filing of the appeal, was *ultra vires* and thus without any legal effect. The

second decision is therefore null and void. The board notes that the correct procedure would have been either to have dealt with the request for refund of the additional search fee in the decision refusing the application, or to have decided on the matter earlier by issuing an interlocutory decision not terminating proceedings (cf. Article 106(2) EPC).

2.3 The board notes here that it is in principle not relevant whether or not a separate appeal against the second decision was filed, given that an appeal against a legally void decision could logically have no legal effect (cf. T 1257/08, point 1 of the reasons). Further, given that the case is to be remitted (see below), the board considers that if the second decision were not now expressly held to be null and void, it would leave an unclear legal situation before the first instance. In addition, with respect to the right to be heard on this issue at oral proceedings, the same considerations apply, mutatis mutandis, as set out in points 1.1 to 1.5 above with respect to the first decision (cf. Article 113(1) EPC).

2.4 The second decision on refund of the additional search fee being null and void, the board considers it appropriate that the matter be reconsidered by the examining division.

3. Remittal (Article 111(1) EPC and Article 11 RPBA)

In accordance with Article 11 RPBA, the board shall remit a case if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise. The boards' consistent practice is to remit the case where the examining division failed to hold oral proceedings

requested by the applicant, since it cannot be known if the examining division would have come to a different decision if oral proceedings had been held. The same situation applies where it is not clear whether a request for oral proceedings has been made. The board sees no special reason to diverge from the existing practice, especially in the light of the further procedural irregularities mentioned above with respect to the second decision (cf. point 2).

4. Conclusion

For the above reasons, the decision under appeal is to be set aside and the case is to be remitted to the examining division for further prosecution (Article 111(1) EPC). Further, the second decision refusing the request for refunding an additional search fee is to be held null and void.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The second decision issued on 10 June 2013 is null and void.

The case is remitted to the examining division for further prosecution.

The appeal fee is reimbursed.

The Registrar: The Chairman:

G. Rauh F. van der Voort

Decision electronically authenticated