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**Datasheet for the decision
of 25 February 2016**

Case Number: T 0736/14 - 3.5.05

Application Number: 09163209.1

Publication Number: 2134049

IPC: H04L27/26

Language of the proceedings: EN

Title of invention:

Frequency division multiple access for wireless communication

Applicant:

Qualcomm Incorporated

Headword:

Selecting invention to be examined/QUALCOMM

Relevant legal provisions:

EPC 1973 Art. 21(3) (a), 82, 113(1)
EPC R. 137(3), 103(1) (a)
RPBA Art. 11
Guidelines for examination H-II, 7.1

Keyword:

Competence of the Legal Board of Appeal - (no)
Violation of principle of good faith - (no)
Correct exercise of first-instance discretionary power - (no)
Violation of right to be heard - (yes)
Remittal to first instance for further prosecution - (yes)
Reimbursement of appeal fee - (yes)

Decisions cited:

G 0002/92, G 0002/97, R 0004/09, J 0008/81, J 0007/82,
T 0162/82, T 0169/96, T 1561/05, T 1705/07, T 1854/08,
T 1060/13

Catchword:

If an applicant whose application is non-unitary responds unclearly and/or in a misleading way to an invitation from the examining division to designate which searched invention it wishes to prosecute further (e.g. by submitting a main request covering one invention and an auxiliary request covering the other invention searched), it cannot be automatically assumed that the applicant selected the invention covered by the main request for examination. Rather, the examining division must clarify, e.g. via a further communication, which of the searched inventions the applicant actually wants it to examine. Confronting the applicant with an irrevocable decision not to admit an auxiliary request covering one of the inventions searched, without giving an opportunity to comment on its admissibility beforehand, is regarded as a substantial procedural violation (see Reasons, point 3).



**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 0736/14 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 25 February 2016

Appellant: Qualcomm Incorporated
(Applicant) 5775 Morehouse Drive
San Diego, CA 92121-1714 (US)

Representative: Dunlop, Hugh Christopher
RGC Jenkins & Co.
26 Caxton Street
London SW1H 0RJ (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 31 October 2013
refusing European patent application
No. 09163209.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair A. Ritzka
Members: K. Bengi-Akyuerek
G. Weiss

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse the present European patent application (divided out from parent application No. 06760244.1) on the grounds that there was no request on file proposed by the applicant and admitted by the examining division (Article 113(2) EPC). This decision was announced at the end of oral proceedings held in the absence of the applicant.

- II. A partial European search report for the present application was issued on 26 October 2009. In an annex to this search report ("sheet B"), the search division indicated that it had drawn up a partial search report because the application contained two inventions and thus did not meet the requirements of unity of invention within the meaning of Article 82 EPC. The search division found that claims 1 to 5 on file related to the first invention and claims 6 to 15 to the second invention, and it conducted a search for the first invention (i.e. claims 1 to 5) pursuant to Rule 64(1) EPC. In addition, the applicant was invited via Form 1507U to pay a further search fee within one month in order to have the second invention (i.e. claims 6 to 15) searched as well.

- III. After payment of the further search fee a complete extended European search report covering both inventions was issued on 2 September 2010, together with reasons for the non-unity objection and a search opinion on novelty and inventive step for both inventions.

- IV. By letter dated 6 April 2011 and along with the payment of the examination fee, the applicant submitted an

amended set of claims 1 to 15, indicating that claims 1 and 5 had been amended "to address clarity objections" and that reference numbers had been added throughout the claims. Oral proceedings were subsidiarily requested.

- V. With its first communication pursuant to Article 94(3) EPC dated 17 May 2011, the examining division confirmed the non-unity objection under Article 82 EPC raised by the search division. Moreover, this communication comprised - apart from the non-unity reasoning regarding both inventions (i.e. claims 1 to 5 and claims 6 to 15) - the following statement (cf. point 2):

"The applicant is asked to state upon which invention further prosecution of this application should be based and to limit the application accordingly (Guidelines, C-III, 7.10). Other inventions are to be excised from the claims, description and drawings if any."

- VI. By its letter of reply, faxed on 10 November 2011, the applicant filed a new set of claims as a main request (claims 1 to 8) and an auxiliary request (claims 1 to 5). It indicated in section 1, first paragraph of this letter:

"The Applicant hereby selects the second group invention (claims 6 to 15) ... as a Main Request ... Any subject-matter deleted by these amendments is not to be regarded as abandoned. The amendments are made without prejudice to the later reinstatement or dividing out of any deleted subject-matter."

and in section 2, first sentence of the letter:

"The Applicant hereby selects the first group invention (claims 1 to 5) ... as an Auxiliary Request."

VII. The second communication under Article 94(3) EPC dated 11 June 2012 comprised the following observations as to the admissibility of the auxiliary request on file (cf. point 1):

"The applicant was requested to state upon which invention further prosecution of this application should be based and to limit the application accordingly ... The applicant, however, filed a Main Request corresponding to the second invention and an Auxiliary Request corresponding to the first invention with his letter dated 10.11.2011. The Auxiliary Request is not admissible in this case (R. 137(3) EPC) because

- it is non-unitary with the Main Request (G2/92) ...; and*
- its subject-matter is prima facie not new and inventive (see Search Opinion).*

Further prosecution will thus base upon the Main Request, i.e. the second invention."

The communication also included objections under Articles 54 and 56 EPC as regards the claims of the main request (i.e. the second invention).

VIII. By letter of reply dated 15 October 2012, the applicant re-submitted the former auxiliary request as its main request and requested the examining division to comment on the arguments submitted in its previous letter of

reply.

- IX. With an annex to the summons to oral proceedings, the examining division stated that the new main request was not admissible under Rule 137(5) EPC and concluded that at present there was no admissible pending request. The annex also included the following statement (cf. point 1, first paragraph):

"... Since the auxiliary request was not admissible (see point 1 of the communication dated 11.06.2012), examination was performed for the main request. Furthermore, it was clear from the order of this filing that further prosecution should be based upon the invention corresponding to the main request."

Moreover, it indicated that "[d]uring the Oral Proceedings the objections raised in the present communication will be considered" (cf. section 4.1).

- X. Following further communications and telephone consultations, in which additional arguments as to the admissibility of the pending requests were exchanged and the applicant requested cancellation of the scheduled oral proceedings and continuation of examination in writing (cf. applicant's letter dated 23 August 2013, page 6 and its letter dated 6 September 2013, page 5, last paragraph and page 6), oral proceedings were held on 26 September 2013 in the absence of the applicant (as pre-announced by the applicant; see "result of consultation" of 9 September 2013).

XI. In the decision under appeal, the following observation was made as regards the matter of non-admittance of the former auxiliary request:

"The 2. communication was issued on 11.06.2012 where the auxiliary request was not admitted based on R. 137(3) EPC ..." (cf. Summary of Facts and Submissions, section 7).

and in the Reasons, page 5, first paragraph:

"... The applicant simply filed a main request directed to one single invention ... By doing that (and even if he has not stated it explicitly) he indicated his wish to continue with that single invention. The filing of an auxiliary request directed to the other invention ... does not change this fact. The auxiliary request was thus not admitted (R 137(3) EPC), because the applicant is not allowed to have more than one invention examined in the frame of one examination fee. If he wants to have the other invention examined he has to file a divisional ...".

and on page 6, antepenultimate paragraph:

"... By replying to the invitation to restrict the claims to one of the searched inventions (the first communication) with a main request and an auxiliary request relating to different inventions, the applicant has indicated his preference. The examination can then only continue with the invention relating to the main request;"

XII. Notice of appeal was received on 27 December 2013. The appeal fee was paid on the same day. With the statement

setting out the grounds of appeal, received on 10 March 2014, the appellant essentially contended that not admitting its former auxiliary request by the examining division constituted a violation of its right to be heard and the protection of legitimate expectations. Furthermore, Rule 137(3) EPC as well as Guideline H-II, 7.1 in the version of 20 June 2012 had been applied wrongly to the present case. Lastly, the appellant requested that

- 1) the matter be put to the Legal Board of Appeal for decision;
- 2) the decision of the examining division of 11 June 2012, refusing the auxiliary request under Rule 137(3) EPC, be set aside and that the matter be remitted to the examining division for examination of that request;
- 3) a ruling be given that Guideline H-II, 7.1, as amended in September 2013, was contrary to the jurisprudence of the Boards of Appeal;
- 4) oral proceedings be held if the board was minded not to set aside the decision of the examining division.

Reasons for the Decision

1. The appeal is admissible.
2. *Request to put the case to the Legal Board of Appeal*
 - 2.1 The appellant requested that this appeal case be put for decision to the Legal Board of Appeal rather than to a Technical Board, since the matters in question were procedural.

2.2 The competence of the Technical Boards of Appeal and the Legal Board of Appeal in grant proceedings is laid down in Article 21(3) EPC 1973 as follows (emphasis added by the board):

"For appeals from a decision of an Examining Division, a Board of Appeal shall consist of:

(a) two technically qualified members and one legally qualified member, when the decision concerns the **refusal of a European patent application** ... , and was taken by an Examining Division consisting of less than four members;

(b) three technically and two legally qualified members, when the decision was taken by an Examining Division consisting of four members, or when the Board of Appeal considers that the nature of the appeal so requires;

(c) three legally qualified members in all other cases."

2.3 It is only in the business distribution scheme pursuant to Rule 12(4) EPC that the boards in the composition under Article 21(3)(a) and (b) EPC 1973 are called *Technical* Boards of Appeal and that the board in the composition under Article 21(3)(c) EPC 1973 is called the *Legal* Board of Appeal. The Legal Board is competent in all cases except those specified in sub-paragraphs (a) or (b). Article 21(3)(a) EPC 1973 relates to cases decided by an examining division consisting of fewer than four members: where the decision concerns the refusal of the application, the Technical Boards of Appeal under the distribution scheme are competent to decide the appeal, otherwise the Legal Board has to

decide.

2.4 The present appeal case was lodged against the decision of an **examining division**, and the decision concerns a **refusal** of the present application. Consequently, according to Article 21(3)(a) EPC 1973, a *Technical Board*, consisting of two technically qualified members and one legally qualified member, is competent to decide on it. Whether or not the matters in question are of a procedural nature has no bearing on case allocation to the boards according to the EPC.

3. *Request to set aside the examining division's discretionary decision and to remit the case on the basis of the former auxiliary request*

3.1 In this regard, the appellant argues that the refusal to admit the then auxiliary request at that stage of the examination proceedings had come as a surprise to the applicant, and had thus infringed its right to be heard as enshrined in Article 113(1) EPC 1973. Due to that final and irrevocable act of the examining division, it had no longer been possible to submit for examination the claims of that auxiliary request, i.e. the first invention, instead of those of the main request on file, i.e. the second invention. Moreover, non-admittance of the former auxiliary request was against the principle of protection of legitimate expectations, since the examining division - contrary to the applicant's intention - had interpreted the submission of a main request together with an auxiliary request as a wish to continue examination proceedings with just one invention, namely the second invention according to the then main request. Furthermore, the Enlarged Board of Appeal decision G 2/92 relating to the examination of non-unitary inventions in one

application had not been correctly interpreted and Guideline H-II, 7.1, which had been introduced for the first time with the version of 20 June 2012, had been erroneously applied to the present case.

- 3.2 In order for this request to be examined, the board considers it necessary to first establish whether the examining division in fact took a final and binding *decision* on the admissibility of the former auxiliary request, i.e. the claims of the first invention, or whether it merely indicated its preliminary *opinion* thereon with its communication dated 11 June 2012 (cf. point VII above). The decisive question is thus whether said communication - on an objective interpretation - was to be construed by the applicant as a final and binding decision on the part of the examining division (cf. J 8/81, OJ EPO 1982, 10, Headnote I).

In the present case, the board holds that already the formulation ("The auxiliary request was thus not admitted (R 137(3) EPC)") in the decision under appeal (cf. point XI above) sufficiently demonstrates that the examining division indeed did take a binding decision on the admissibility of the auxiliary request *before* it issued the above communication, rather than merely providing a provisional assessment (see also "result of consultation" of 27 August 2013, page 1, second paragraph, fourth sentence: "... The auxiliary request was thus not admitted (R 137(3) EPC) ...").

- 3.2.1 With regard to the proper interpretation of G 2/92 (OJ EPO 1993, 591) and the practice of the EPO concerning examination of non-unitary inventions, the board concludes that, in the present case, the examining division upon confirmation of the non-unity objection of the search division was correct in insisting that

the applicant chose only *one* invention for further prosecution, in particular because G 2/92 requires the following (cf. Reasons, point 2, second paragraph):

*"... At the examination stage, having regard to the requirement of unity of invention and the fact that only **one examination fee** can be paid for each application, clearly only **one invention** in each application is to be examined for conformity with the patentability and other requirements of the EPC"* (emphasis added by the board).

This conclusion is also summarised in the Guidelines for Examination in the EPO (cf. Guidelines C-III, 3.1.2, e.g. in the version of September 2013) and is - contrary to the appellant's view - not to be regarded as only an *obiter* comment. Therefore, the examining division was indeed allowed to examine only *one* of the two inventions in the examination proceedings.

- 3.2.2 Concerning the alleged breach of the principle of protection of legitimate expectations ("good faith"), the board notes, firstly, that protection of legitimate expectations is indeed a well-established principle in the proceedings before the EPO (see e.g. G 2/97, OJ EPO 1999, 123, Reasons, point 1). In the present case, however, the board cannot discern any erroneous information or misleading communication received by the applicant from the EPO, nor any obligation for the examining division to warn the applicant or clarify an uncertain situation to prevent any inevitable loss of rights. In this context, the board also adds that the requirement to act in good faith in proceedings before the EPO is not limited to the EPO organs; it applies also to the parties (see e.g. G 2/97, Reasons, points 4.1 and 4.2).

The appellant argued that, by selecting the claims of the second invention as its main request and the claims of the first invention as auxiliary request with its letter of reply faxed on 10 November 2011, it was not indicating the wish to continue the examination procedure with one invention alone, contrary to the interpretation of the examining division (cf. point XI above). Rather, it had *explicitly* expressed the wish to continue with one invention as a preferred request and the other invention as an alternative. This was also backed up by its statement that the corresponding amendments were made "without prejudice to the later reinstatement of any deleted subject-matter" (cf. point VI above) and by the fact that, although instructed to do so by the examining division, it did not excise the other invention from the claims, description and drawings.

However, it is apparent to the board that the applicant in fact reacted to a legitimate and unequivocal invitation from the examining division to select the invention to be further prosecuted by filing an unclear and misleading reply in the form of two claim requests, which actually implied the examination of both inventions. The applicant - and in particular its professional representative - must or should have known when choosing the order of its requests that, according to the established practice of the EPO, if the examining division did not find the main request allowable (which was highly likely, given the search opinion provided; see point III above), it had to examine the auxiliary request then on file (see e.g. T 169/96 of 30 July 1996, Reasons, point 2; Guidelines H-III, 3.1, e.g. in the version of September 2013). In other words, the applicant replied to a clear

question from the examining division, i.e. whether the first or the second invention was to be examined, by expressing the wish that it first examined the first invention and then, if applicable, the second one. Such a behaviour is however not to be regarded as a procedural act in good faith in respect of which the applicant could reasonably rely on the protection of legitimate expectations. Nor can the applicant plead lack of knowledge as an excuse ("*ignorantia legis non excusat*") in seeking to gain a procedural advantage or benefit from an omission of its own, pursuant to the legal principle "*nemo auditur propriam turpitudinem allegans*" (cf. R 4/09 of 30 April 2010, Reasons, point 2.3.3; T 1705/07 of 10 June 2010, Reasons, point 8.7).

- 3.2.3 As to the applicability to the present case of Guideline H-II, 7.1 in the version as of 20 June 2012, it is *prima facie* evident to the board that neither the second communication of 11 June 2012, notifying the binding decision not to admit the former auxiliary request into the examination proceedings (cf. point VII above), nor the decision under appeal effectively refers to that guideline to substantiate the non-admittance decision. Rather, it appears from the file that the examining division quoted said guideline for the first time in the "result of consultation" dated 27 August 2013, as an additional legal basis for not admitting the former auxiliary request and then the later main request, i.e. the first invention in both cases (cf. "result of consultation" of 2 September 2013, second and fourth paragraphs). Consequently, this matter is irrelevant for the purpose of deciding on the present appeal.

3.2.4 As regards the question whether the examining division infringed the applicant's right to be heard, the board holds however that it did indeed fail to give the applicant any opportunity to provide arguments in favour of the admissibility of the former auxiliary request *before* taking its decision and notifying it with the communication dated 11 June 2012. Rather, it confronted the applicant with its irrevocable decision that the auxiliary request then on file was not admitted. As a consequence, that decision is based on grounds on which the applicant did not have an opportunity to present its comments. This constitutes a substantive violation of the applicant's right to be heard, contrary to Article 113(1) EPC 1973, which *per se* justifies that the **decision under appeal be set aside** (see e.g. T 1854/08 of 15 September 2009, Reasons, point 2.2).

3.2.5 The decision under appeal cites Rule 137(3) EPC, Article 82 EPC and decision G 2/92 as the legal basis for not admitting the claims of the first invention into the examination proceedings (cf. point XI above). The board is aware that the current EPC contains no explicit provisions about how to proceed if an applicant whose application is non-unitary responds unclearly or in a misleading way to an invitation from the examining division to specify which searched invention it wishes to prosecute further (in contrast to the invitation from a search division to pay further search fee(s) pursuant to Rule 64(1) EPC). The board also considers that the applicant might well be expected to react to the unequivocal invitation in an equally unambiguous way and to clearly indicate the searched invention it wants to be examined.

Nonetheless the board finds that, in view of the fact

that this issue was procedurally essential for further prosecution of the application, the examining division should have clarified it - possibly by setting an appropriate time limit under Rule 132 EPC - instead of immediately taking a binding and irrevocable decision on the matter of admittance. This is even more so since, in the present case, the examining division must have objectively assumed that a clarification of that issue was outstanding in order to base its further examination on the "correct" claims. Therefore, it should have invited the applicant, according to Article 94(3) EPC, "as often as necessary" to file its observations and/or amend the application to meet the requirements of Article 82 EPC 1973.

This was however - for whatever reasons - not done. By failing to clarify the matter the examining division *de facto* tacitly accepted the direct procedural consequence that in view of G 2/92 the first invention could no longer be examined for this application, but only through filing a further divisional application. However, neither the EPC nor the Guidelines for Examination in the EPO provide for the examining division to proceed in this way.

- 3.3 For the above reasons, the board regards the decision of the examining division not to admit the former auxiliary request into the examination proceedings, without giving the applicant an opportunity to comment on its admissibility, as a substantial procedural violation of the applicant's right to be heard. As this moreover constitutes *per se* a fundamental deficiency in the sense of Article 11 RPBA and since there are no special reasons discernible against a remittal, the board decides to **remit the case immediately to the examining division for further prosecution on the basis**

of the first invention, filed as auxiliary request, or the second invention, filed as main request, with the letter faxed on 10 November 2011.

4. *Request to rule that Guideline H-II, 7.1 contradicted the jurisprudence of the Boards of Appeal*

4.1 The appellant contends that Guideline H-II, 7.1, as amended with the version of September 2013, is at odds with the jurisprudence of the Boards of Appeal, since it does not appropriately balance the interests of the applicant. This guideline is entitled "Restriction to a single, searched invention" and deals with the exercise of discretion under Rule 137(3) EPC as regards admittance of claim requests in the event of non-unitary inventions. It reads as follows:

*"In reply to an objection of lack of unity, the applicant must restrict the claims to a single invention which has been searched. The examination can then be continued as for a unitary application but limited to that invention ... However, if in response to a negative opinion concerning that invention the applicant later amends the claims to **switch** to a different searched invention, the Division will exercise its discretion under Rule 137(3) and refuse to admit the amendments since only one invention in each application can be examined for conformity with the requirements of the EPC ..."* (emphasis added by the board).

4.2 The board judges that the present appellant's request is not admissible for several reasons:

- Firstly, the question whether or not this guideline was correctly applied and whether or not

its version of September 2013 is in line with the jurisprudence of the Boards of Appeal has no bearing on the decision in this appeal case (cf. point 3.2.3 above).

- Secondly, the Boards of Appeal of the EPO are neither bound by nor accountable for the Guidelines for Examination in the EPO (see e.g. T 162/82, OJ EPO 1987, 533, Reasons, point 9; T 1561/05 of 17 October 2006, Reasons, 1.5); in their decisions, they are required to comply only with the provisions of the EPC (Article 23(3) EPC 1973). Accordingly, they are in no way competent to rule on whether the Guidelines for Examination in the EPO, which are adopted by the President of the EPO in view of Article 10(2)(a) EPC, are consistent with their established jurisprudence. Pursuant to Article 20(2) RPBA, a board may at best state the grounds for giving a different interpretation of the EPC to that given in these Guidelines, if a board considers that this would be more readily understood (see e.g. T 1060/13 of 16 December 2013, Reasons, point 4.3). But this is not the case here.

- Thirdly, said guideline is concerned merely with a possible *switch* of the invention to be examined to another one *after* the applicant has indicated that it wants a specific searched invention to be further prosecuted and the examining division considers the subject-matter of the selected invention to be unallowable. However, the board takes the view that this guideline should not have been applied at all when refusing to admit the former auxiliary request, since the applicant did *not* clearly indicate the invention to be further

examined at that stage of the examination proceedings. Rather, by selecting and examining the second invention (i.e. the applicant's former main request), the examining division created a *fait accompli*, which later led to the non-admittance of the claims of the first invention (i.e. the applicant's new main request) under Rule 137(5) EPC (cf. point IX above). This in turn gave rise to the refusal of the application under Article 113(2) EPC 1973 (which should have been accompanied by a reference to Article 78(1)(c) EPC 1973) on the grounds that there was no claim request on file which had been proposed by the applicant and admitted by the examining division.

5. *Reimbursement of appeal fee*

5.1 Even though the appellant did not explicitly request reimbursement of the appeal fee in its statement setting out the grounds of appeal, the board considers it appropriate, in a case where the first-instance department committed a substantial procedural violation necessitating the case's immediate remittal, to assess whether such a reimbursement should be ordered *ex officio* (cf. J 7/82, OJ EPO 1982, 391, Reasons, point 6). As the decision under appeal is to be set aside (cf. point 3.2.4 above) and the appeal must thus be allowed, it is to be further determined under Rule 103(1)(a) EPC whether such reimbursement is equitable or whether the appellant contributed (at least partly) by an abusive conduct to the procedural shortcomings in the first-instance proceedings.

5.2 The board notes, first, that the absence of the applicant from the first-instance oral proceedings does

not play any role, in this case, for establishing whether or not the applicant's conduct constituted an abuse of the procedure, since in any event it would have had no opportunity to attack and/or reverse the examining division's decision not to admit the claims of the first invention, since that decision had already been taken well before the summons to oral proceedings (cf. point 3.2 above). Even though the applicant did not reply at all clearly to the examining division's invitation, and was obviously trying, by the back door, to have two inventions examined for the price of one, it filed this appeal as a last resort in order to have the first invention (i.e. claims 1 to 5) examined and possibly granted by the examining division, without having to submit a divisional application. Therefore and in view of the observations made in point 3.2.4 above, the board concludes that, in the present circumstances, it is also equitable to order reimbursement of the appeal fee.

6. *Request for holding oral proceedings*

As the decision under appeal is set aside, it is neither necessary nor appropriate to hold oral proceedings before the board, which the appellant has subsidiarily requested.

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 Chair:



G. Nachtigall

A. Ritzka

Decision electronically authenticated