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Datasheet for the decision of 31 January 2017

Case Number: T 1753/14 - 3.5.05

Application Number: 03028105.9

Publication Number: 1398898

IPC: H04L5/14, H04L29/06, H04M11/06, H04L29/08

Language of the proceedings: EN

Title of invention:
Activation of multiple xDSL modems with implicit channel probe

Applicant:
SISVEL International S.A.

Headword:
Postponement of oral proceedings/SISVEL

Relevant legal provisions:
EPC Art. 111(1), 113(1)
EPC R. 103(1)(a), 111(2), 116, 132(2)
EPC 1973 R. 71a(1)
RPBA Art. 11
Guidelines for examination D-VI, 3.2

Keyword:

Substantial procedural violation - (yes): lack of substantiation as to refusal of request for postponement of final date under Rule 116(1) EPC
Remittal to the first instance for further prosecution - (yes)
Reimbursement of the appeal fee - (no)

Decisions cited:

J 0008/81, J 0004/03, T 0755/96, T 0037/97, T 0798/05, T 1705/07, T 0309/09

Catchword:

Interpretation of Rule 116(1) EPC in conjunction with Rule 132(2) EPC; see points 1.2.2 to 1.2.4 of the Reasons.

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Case Number: T 1753/14 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 31 January 2017

Appellant: (Applicant)	SISVEL International S.A. 44, rue de la Vallée 2661 Luxembourg (LU)
Representative:	Baroni, Matteo Metroconsult S.r.l. Foro Buonaparte, 51 20121 Milano (IT)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 20 March 2014 refusing European patent application No. 03028105.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair	A. Ritzka
Members:	K. Bengi-Akyuerek
	F. Blumer

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division to refuse the present European patent application on the grounds that the independent claims of a sole claim request lacked clarity (Article 84 EPC), comprised added subject-matter (Article 123(2) EPC) and lacked inventive step (Article 56 EPC) having regard to the disclosures of

D1: ITU-T: "Recommendation V.8 *bis*", pp. 1-43, 1996;
D4: ANSI: "Network and Customer Installation Interfaces - Asymmetric Digital Subscriber Line (ADSL) Metallic Interface", pp. 1-170, 1995;
D5: EP-A-0 820 168.

The present application is divided out from its parent application No. 99914300.1 underlying the appeal case T 2125/08 and is co-related with further divisional applications No. 03007771.3, 03007772.1, 03007773.9 and 03028106.7 underlying appeal cases T 2122/08, T 1750/14, T 1751/14 and T 1754/14 respectively. The present application and those underlying T 1750/14, T 1751/14 and T 1754/14 were discussed and decided by the examining division on three consecutive days (i.e. 4 to 6 February 2014).

The present decision of refusal was announced at the end of oral proceedings held on 5 February 2014 in the presence of the then applicant.

II. Those oral proceedings had been convened with a summons, dispatched on 2 October 2013, to attend oral proceedings pursuant to Rule 115(1) EPC, including objections under Articles 84, 123(2) and 56 EPC. The final date for making written submissions under

Rule 116(1) EPC had been set to 3 January 2014. The annex to the summons included the following observations (see points 9 and 10):

"In case the Applicant files in time (Rule 116(1), (2) EPC) amended application documents meeting the requirements of the Convention, i.e. remedying all *the deficiencies listed above, the oral proceedings can be called off.*

However, in case the Applicant chooses not to present such suitable amendments within the above time limit, the above points will subsequently be discussed in oral proceedings."

III. By a fax of 30 December 2013 and a letter dated 31 December 2013, the then applicant's representative requested a postponement of the oral proceedings scheduled for 5 February 2014 and the final date for making written submissions and/or amendments on the grounds that he had been informed that the present application had been transferred from the then registered applicant, *Panasonic Systems Networks Co. Ltd.*, to the new applicant *Sisvel International S.A.*, and that he did not know whether he was to remain the representative. This request was justified since it was based on serious grounds within the meaning of the Notice from the EPO dated 18 December 2008. In particular, his letter dated 31 December 2013 included the following statement (emphasis added by the board):

"The serious grounds are the following:

The time left for the new applicant is too short for allowing the applicant to familiarize with the application and prepare the Oral Proceedings.

*The **deadline for written submissions and/or amendments** of January 3, 2014 is extremely close (less than one week). The new applicant is thus not given the time needed for carefully studying the opinion of the Examining Division and the relevant prior art.*

Both, the current deadline for written submissions and/or amendments and the date fixed for the Oral Proceedings do not allow the new applicant to exercise the applicant's right effectively."

IV. In a telephone conversation of 2 January 2014, the first examiner of the examining division informed the then representative that he did not at present consider the change of applicant as a serious ground justifying the postponement of the oral proceedings and added that it could have been assumed that, when acquiring the rights as to the present application, the new applicant was familiar with the case including the fact that oral proceedings were scheduled, as this belonged to the normal obligations of an acquirer, referring to J 4/03, Reasons 5. The minutes of the phone conversation ("Result of conversation" dated 9 January 2014) ends with the following remark (emphasis added by the board):

*"Hence, neither the date of the oral proceedings nor the **final date for making submissions** is changed."*

V. By letter of 3 January 2014, i.e. at the final date, the newly appointed representative of the new applicant reiterated the request for postponement in the following manner:

"Sisvel International S.A. hereby reiterates his request, already filed on December 31, 2013, of

postponement of the Oral Proceedings scheduled for the subject European patent applications.

It is respectfully submitted that not only the new Applicant, but also the new representatives, have not had sufficient time to study the cases and prepare reasoned written submissions before the Oral Proceedings.

Time is actually not sufficient for duly preparing the Oral Proceedings either.

The new Applicant and his representative believe that the postponement of the Oral Proceedings scheduled for the four subject European patent applications is a necessary consequence of observance of the right to be heard set forth by Art. 113 EPC."

VI. In a further telephone conversation on 13 January 2014, i.e. after the expiry of the final date, between the first examiner and the new representative, in which additional arguments as to the postponement of oral proceedings were advanced, the first examiner informed the representative of the following (cf. "Result of conversation" dated 17 January 2014, point 3):

"The examiner also informed the representative that he cannot expect to receive every time the same request for postponement is reiterated a letter informing him that the date for the oral proceedings is maintained. Only in case the oral proceedings are canceled he will be informed. But he can expect that during the oral proceedings he will have again the opportunity to present his arguments and in case the examining division is convinced, then the oral proceedings will be terminated and probably a new date will be arranged.

However, if the examining division is not convinced, then the oral proceedings will be continued."

VII. By letter dated 20 January 2014, the former representative of the old applicant requested a correction of the minutes of the telephone conversation conducted on 2 January 2014. He stated that the first examiner explicitly announced that he would have to discuss the matter with the other members of the examining division, and in particular with the chairman who was expected to return to work on 8 January 2014. In particular, he made the following statement (emphasis added by the board):

"... the applicant's representative had at the time of the telephone conversation definitely not been informed of the Primary Examiner's decision that neither the date of the oral proceedings nor the ***final date for making submissions*** *will be changed; this was definitely not made during the telephone conversation. Rather, the Primary Examiner conveyed the impression that the decision was to be taken by the Examining Division as a whole and would not be taken before Wednesday January 8, 2014."*

VIII. By letters dated 22 and 23 January 2014, the new representatives of the new applicant requested "a postponement by two months of the scheduled Oral Proceedings and of the relevant term for written submissions" and "an extension of two months (to 3 March 2014) of the term for making written submissions".

IX. In the decision under appeal, the following observation was made as regards the issue of an extension of the term for making written submissions (see Summary of

Facts and Submissions, point 5, emphasis added by the board):

"In a telephone conversation on 02-01-2014 [one day before the final date], the representative was informed that the change of the applicant is not considered as a serious ground justifying postponement of the oral proceedings. It was also referred to the decision J 4/03. Hence, neither the date of the oral proceedings nor the ***final date for making submissions*** *was changed."*

and in its Reasons, point 1.2.5, second paragraph:

"One may argue that, in view of T 0408/91 in the present situation at least concerning the ***final date for making written submissions*** *the examining division should have been more liberal. However, since the applicant never requested any amendment of the application after this final date, this question did not arise."*

X. With the statement setting out the grounds of appeal, the appellant filed two new sets of claims according to a main request and a first auxiliary request. It essentially requested

1) as a "main request", that a patent be granted on the basis of the claims of the main request or,
2) as a "first auxiliary request", that a patent be granted on the basis of the claims of the first auxiliary request or,
3) as a "second auxiliary request", that the case be remitted to the examining division in order to arrange new oral proceedings before it, and the appeal fee be reimbursed or,

4) as a "third auxiliary request", that oral proceedings before the board be scheduled.

XI. In an annex to the summons to oral proceedings pursuant to Article 15(1) RPBA, the board expressed its preliminary opinion on the appeal. In particular, it raised objections under Articles 123(2) and 76(1) EPC, made some (negative) observations on the questions of novelty and inventive step in view of D1, D4 and D5, and expressed concerns about the admissibility of the first auxiliary request under Article 12(4) RPBA. The appellant was also informed that, as to its second auxiliary request, the board was presently not minded to overrule the way in which the examining division exercised its discretion and to order reimbursement of the appeal fee under Rule 103(1)(a) EPC, since in refusing the postponement of the date for oral proceedings the examining division exercised its discretion on the basis of the relevant facts, according to the right principles and in a reasonable way. In addition, the board expressed its preliminary opinion that a newly appointed professional representative could indeed be expected, before taking on the mandate, to have made sure that he/she is able to prepare for such oral proceedings with all due care within a month in this not exceptionally difficult case.

XII. By letter of reply dated 30 December 2016, the appellant filed amended claims according to a second auxiliary request, replacing all claims on file, alongside counter-arguments to the objections raised in the board's communication under Article 15(1) RPBA. It now requested

1) as a "main request", that the case be remitted to the first-instance department since the examining division should have not denied the postponement of the oral proceedings scheduled for 5 February 2014 or,
2) as a "first auxiliary request", that the case be remitted and a question (see point XIII below) be referred to the Enlarged Board of Appeal, in order to assess that the applicant's right to be heard and the request for postponement of first-instance oral proceedings should not have been denied or,
3) as a "second auxiliary request", that a patent be granted on the basis of the claims of the second auxiliary request.

XIII. Oral proceedings were held on 31 January 2017 during which only the appellant's main request needed to be discussed.

The appellant's final requests were that,

1) as its "main request", the decision under appeal be set aside, the case be remitted to the department of first instance for further prosecution and the appeal fee be refunded or,
2) as its "first auxiliary request", the following question of law be referred to the Enlarged Board of Appeal:

"In exercising its discretion to grant a request for postponement of oral proceedings, could a bona fide change of applicant and change of representative (e.g. due to a transfer of right) just a month before the oral proceedings amount to a serious reason justifying

postponement of the oral proceedings?", or

3) as its "second auxiliary request", a patent be granted on the basis of the claims of the second auxiliary request as filed with letter dated 30 December 2016.

At the end of the oral proceedings, the board's decision was announced.

Reasons for the Decision

1. MAIN REQUEST

This procedural request is directed to setting aside the decision under appeal, to remitting the case to the examining division for further prosecution and to reimbursing the appeal fee (cf. point XIII above).

1.1 *Alleged substantial procedural violation as regards refusal of the request to postpone the date for oral proceedings*

1.1.1 The appellant argued that the refusal of its request for postponing the date for oral proceedings before the examining division was tainted with a violation of its right to be heard under Article 113(1) EPC, and was not sufficiently substantiated within the meaning of Rule 111(2) EPC.

1.1.2 As to the exercise of the examining division's discretion in not allowing the postponement of the date for oral proceedings before it, it is true that a change of both the applicant and the representative after having been summoned to those oral proceedings is not expressly mentioned in the list of examples of

serious reasons within the meaning of the "Notice from the European Patent Office dated 18 December 2008 concerning oral proceedings before the EPO", OJ EPO 1/2009, 68, point 2.3. The board takes note of the examining division's arguments (cf. appealed decision, Reasons 1.2.3 and 1.2.4) that the new applicant could have instructed, already *before* the assignment regarding the transfer of the present application was signed, a patent attorney to prepare for the oral proceedings, and that the newly appointed professional representative could be expected, before taking on the mandate, to make sure that he was indeed able to prepare for such oral proceedings within a one-month period (cf. T 37/97, Reasons 2.2; J 4/03, Reasons 5). The examining division also took into account, *inter alia*, the complexity of the case.

1.1.3 In that regard, the board considers that, under the hypothetical assumption that there had been no request for postponement of the final date for making submissions in preparation for the oral proceedings (henceforth "final date") or that such request had no relation whatsoever to the request for postponement of the date for oral proceedings, it would appear that all the arguments presented by the then applicant as regards the postponement of the date for oral proceedings were properly addressed and treated in the appealed decision (see point 10 of the Summary of Facts and Submission and point 1 of the Reasons).

1.1.4 However, the appellant repeatedly requested that the final date of 3 January 2014 be postponed, arguing that the new applicant, represented by the newly appointed representative, could not reasonably be expected to file amendments less than one week after the change of applicant and representative. These arguments were not

addressed in the entire decision under appeal (see point 1.2.5 below). It is not clear whether the examining division in fact saw any relationship between the request for postponement of the final date and the request for postponement of the date for oral proceedings. If the examining division did see any such relationship (such as a strict link between the two dates), the request for postponement of the final date and the supporting arguments should have been addressed, at least, in the context of the refused request for postponement of the date for oral proceedings (see point 1.2.6 below).

1.2 *Alleged substantial procedural violation as regards refusal of the request to postpone the final date*

1.2.1 The appellant submitted that the time available between the conclusion of the application-transfer agreement and the final date set by the examining division was too short for studying the case and for preparing reasoned written submissions (cf. points III and V above).

1.2.2 The final date for making written submissions in preparation for the oral proceedings is codified in Rule 116 EPC as follows (emphasis added by the board):

> *"(1) When issuing the summons, the European Patent Office shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a* ***final date*** *for making written submissions in preparation for the oral proceedings shall be fixed.* ***Rule 132*** *shall not apply. New facts and evidence presented after that date need not be considered, unless admitted on the grounds that the*

subject of the proceedings has changed.

(2) If the applicant ... has been notified of the grounds prejudicing the grant ..., he may be invited to submit, by the date specified in paragraph 1, second sentence, documents which meet the requirements of the Convention. Paragraph 1, third and fourth sentences, shall apply mutatis mutandis."

Rule 116(1) EPC hence stipulates that Rule 132 EPC shall not apply. In particular, Rule 132(2) EPC reads as follows:

"Unless otherwise provided, a period specified by the European Patent Office shall be neither less than two months nor more than four months; in certain circumstances it may be up to six months. In special cases, the period may be extended upon request, presented before the expiry of such period."

Thus, Rule 132(2) EPC, on the one hand, establishes that, in the absence of specific provisions, periods specified by the EPO normally shall be between two and four months (first sentence). On the other hand, it stipulates that, in special cases, such periods may be extended upon request (second sentence). From that wording alone it is not clear to the board whether the non-applicability of Rule 132(2) EPC to Rule 116(1) EPC relates only to the above limitations for periods specified by the EPO (allowing e.g. that a final date less than two months ahead of the date for oral proceedings be set) or whether it should also preclude the possibility of extending specified periods, implying that the final date set under Rule 116(1) EPC

could not be changed. In fact, according to a literal reading of the provisions of Rule 116(1) EPC in conjunction with Rule 132(2) EPC as done in the Guidelines for Examination in the EPO (see D-VI, 3.2, last sentence e.g. in the applicable version of September 2013), said final date may not be extended.

1.2.3 However, the admissibility of claim amendments filed after the final date specified in Rule 116(1) EPC is subject to the examining division's discretion. The examining division may not refuse to consider new claims on the sole ground that they had not been filed prior to the final date stated in a summons to oral proceedings (see e.g. T 755/96, OJ EPO 2000, 174, Reasons 4.1; T 798/05, Reasons 7, last two paragraphs). When Rule 71a(1) EPC 1973, the predecessor of Rule 116(1) EPC, was introduced, that rule was not intended to restrict the discretion conferred on EPO departments under Article 114(2) EPC (see Explanatory Memorandum CA/12/94 rev. 1, point 7.4, as quoted in T 755/96, Reasons 2.2). In this context, it may at least be questioned whether the non-applicability of Rule 132(2) EPC in Rule 116(1) EPC has necessarily to be understood as an exclusion of any discretionary power exercised by the examining division to postpone the final date.

1.2.4 Should the postponement of the final date under Rule 116(1) EPC indeed be excluded by the negative reference to Rule 132(2) EPC, the question arises whether the final date may be changed if the scheduled oral proceedings are cancelled and a new date for them is set by the first-instance department. While there may be situations where it is appropriate to change the date for oral proceedings while maintaining the final date, the board considers that a change of the final

date should normally be allowable when the date for oral proceedings is postponed. At least in cases where a final date is specified relative to the date for oral proceedings (usually one month before the scheduled oral proceedings), it could even be argued that the final date is postponed automatically when the oral proceedings are postponed.

1.2.5 In the present case, the final date had been set to 3 January 2014. The appellant's representatives requested a postponement of this date repeatedly and separately from their request to postpone the date for oral proceedings (cf. points III and VIII above). It is apparent to the board that the statements made by the first examiner of the examining division (cf. points IV and VII above) seem to imply that the examining division in fact took a final and binding *decision* within the meaning of J 8/81 (OJ EPO 1982, 10, Headnote I) on the request for postponement of the final date, on which the then applicant apparently had no opportunity to comment, rather than having merely expressed its preliminary *opinion* thereon. It is also evident that the specific reasons for not allowing any postponement of the final date - regardless of the refusal of the request for postponement of the date for oral proceedings - are not addressed in the decision under appeal. It is only mentioned that the question of filing amendments of the application after expiry of the final date did not arise (cf. point IX above). This remark cannot, however, be considered to be a reasoning for the refusal of the request for postponement of that final date. The fact that no submissions other than procedural requests were filed after the final date does not mean that the request for postponement of the final date has become pointless. The request for postponement of the final date was never withdrawn and

the appellant's desire to file amended claims was made clear even during oral proceedings before the examining division when it requested that the examination proceedings be continued in writing.

Hence, the examining division's decision to refuse the appellant's request for postponement of the final date lacks a reasoning required under Rule 111(2) EPC.

1.2.6 The board can only surmise that the examining division may have assumed that the final date is only to be postponed *together with* the date for the oral proceedings and that, as a consequence, the request for postponement of the *final date* and the request for postponement of the *date for oral proceedings* could not be separated from each other and could only be decided together. However, in this case or if the examining division indeed considered those two requests to be linked in any other way, the appellant's arguments presented concerning the request for postponement of the final date should have been considered at least in the context of the request for postponement of the date for oral proceedings (see point 1.1.4 above).

1.3 In view of the above, the board concludes that, due to a lack of substantiation within the meaning of Rule 111(2) EPC with regard to the request concerning the final date and/or to the request concerning the date for oral proceedings, the examining division indeed committed a substantial procedural violation which justifies the impugned decision being overturned. At the same time, this amounts to a fundamental deficiency apparent in the first-instance proceedings within the meaning of Article 11 RPBA (see e.g. T 309/09, Reasons 8). It is also worth noting that the board does not take any position as to whether the

right to be heard under Article 113(1) EPC was violated in any other way than by lack of substantiation in the decision under appeal. However, such a lack of substantiation under Rule 111(2) EPC is in itself sufficient reason to set aside the decision under appeal. Moreover, said lack of substantiation, in particular with respect to the request for postponement of the final date, prevents the board from a comprehensive assessment of the examination proceedings in view of Article 113(1) EPC.

1.4 *Remittal for further prosecution (Article 11 RPBA)*

1.4.1 Pursuant to Article 11 RPBA, a board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, "unless special reasons present themselves for doing otherwise". In this regard, it has to be established in the present case whether special reasons are discernible against such remittal.

1.4.2 Despite the fact that the filing date accorded to the present application is 31 March 1999 (i.e. eighteen years ago) and that substantive issues of the case have already been touched upon in these appeal proceedings (cf. board's communication under Article 15(1) RPBA, points 3.1 to 3.3), the board does not see any "special reason" justifying a deviation from the general rule prescribed by Article 11 RPBA. In fact, the appellant was only partially responsible for the delays in the first-instance proceedings. The present application was actually filed in December 2003 as a divisional application. After issuance of a first communication in September 2004 there was no office action until the appellant had a telephone conversation with the first examiner in September 2011. The appellant requested

remittal of the case for further prosecution, and filed amended sets of claims in the appeal proceedings. Under these circumstances, the appellant's interest in having the case examined in two instances prevails over the general interest of bringing proceedings to a close within an appropriate period of time.

1.4.3 In conclusion, the present case is to be remitted to the examining division for further prosecution under Article 111(1) EPC in conjunction with Article 11 RPBA.

1.5 *Request for reimbursement of appeal fee*

1.5.1 At the oral proceedings before the board, the appellant maintained its request for reimbursement of the appeal fee on the grounds that a substantial procedural violation had occurred in the examination proceedings, without providing further comments supporting this request. Given that the impugned decision is to be set aside and that the appeal is therefore allowable, the board has next to establish whether such reimbursement appears to be equitable under Rule 103(1)(a) EPC.

1.5.2 The board holds that the applicant - and in particular its professional representative - must or should have known, in view of Rule 116(1), last sentence, EPC that it is generally not guaranteed that any written submission is automatically admitted into the proceedings before the EPO for the sole reason that it is filed *prior to* the final date, nor is it entirely unlikely that a submission may be admitted under the department's discretion when filed *after* that date. Rather, the then applicant could have followed the invitation from the examining division (cf. point II above) and attempted to file, for example, amended sets of claims with the aim of overcoming the objections

raised in the summons to the first-instance oral proceedings *after* 3 January 2014, the final date set in the summons.

This was, however, not done by the applicant of its own volition. In the board's view, such procedural behaviour speaks against regarding the reimbursement of the appeal fee as equitable within the meaning of Rule 103(1)(a) EPC. A party cannot gain a procedural advantage from an omission of its own, pursuant to the legal principle "*nemo auditur propriam turpitudinem allegans*" (cf. T 1705/07, Reasons 8.7). The appellant should have known - in view of the rather negative opinion of the examining division set out in its communication accompanying the summons - that filing no amended claims would in all likelihood lead to a refusal of the application based on its merits, and that amendments filed at any time before oral proceedings were not *a priori* inadmissible. In other words, the substantial procedural violation alone was not causal for the need to lodge an appeal against the eventual refusal of the application. Reimbursement of the appeal fee is therefore refused.

2. FIRST AND SECOND AUXILIARY REQUESTS

Since the appellant's main request is found to be allowable, it is not necessary to consider its first and second auxiliary requests any further.

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. The request for reimbursement of the appeal fee is refused.

The Registrar: The Chair:

K. Götz-Wein A. Ritzka

Decision electronically authenticated