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**Datasheet for the decision
of 2 March 2021**

Case Number: T 0862/16 - 3.5.03

Application Number: 12004150.4

Publication Number: 2496040

IPC: H04W76/02

Language of the proceedings: EN

Title of invention:

Methods for synchronizing PDCP operations after PRC connection re-establishment in a wireless communication system and related apparatuses thereof

Patent Proprietor:

HTC Corporation

Opponent:

Nokia Solutions and Networks Oy

Headword:

Connection re-establishment/HTC

Relevant legal provisions:

EPC Art. 23(3), 23(4), 76(1), 111(1), 112(1)(a), 113(1),
114(1), 123(3)
EPC R. 12c, 103(1)(a)
RPBA 2020 Art. 11, 12(2), 13(1), 13(2), 23

Keyword:

Added subject-matter - main and auxiliary requests 1 to 10
(yes)

Admittance of auxiliary request 11 filed at oral proceedings
(yes): exceptional circumstances

Added subject-matter - auxiliary request 11 (no, after
amendments)

Extension of protection - auxiliary request 11 (no)

Objection introduced ex officio by the board - request for
referral to Enlarged BoA (no)

Remittal to the opposition division for further prosecution -
(yes): novelty and inventive step not examined yet

Request for reimbursement of the appeal fee - (no): no
substantial procedural violation

Decisions cited:

G 0010/91, G 0010/93, G 0001/95, R 0016/13, J 0005/81,
T 0198/88, T 0453/15

Catchword:

As to raising a new objection by a Board of Appeal *ex officio*
under Article 114(1) EPC, see points 2.8 and 8 of the Reasons.



Beschwerdekammern

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Case Number: T 0862/16 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 2 March 2021

Appellant: HTC Corporation
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 5 February 2016
revoking European patent No. 2496040 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: T. Snell
R. Winkelhofer

Summary of Facts and Submissions

I. This case concerns the appeal of the proprietor (henceforth, "appellant") against the decision of the opposition division revoking the European patent on the ground of Article 100(c) EPC in conjunction with Article 76(1) EPC.

II. The appellant requests that the decision under appeal be set aside and that the patent be maintained in amended form, or remitted to the opposition division for further prosecution, on the basis of the claims of one of the

- **main request**, filed with the statement of grounds of appeal
- **first to eighth auxiliary requests**, filed with the statement of grounds of appeal
- **ninth or tenth auxiliary requests**, filed with the submission dated 22 December 2020
- **eleventh auxiliary request** filed at oral proceedings held before the board on 2 March 2021.

The appellant also conditionally requests that questions be referred to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC. In addition, they request reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC.

III. The opponent (henceforth, "respondent") requests that the appeal be dismissed, or, subsidiarily, that the case be remitted to the opposition division for further prosecution.

IV. Claim 1 of the **main request** reads as follows:

"A communication device (350, 310) of a wireless communication system (300) for synchronizing Packet Data Convergence Protocol, PDCP, operations with another communication device (310, 350), the communication device (350, 310) comprising:

means for performing an RRC Reconfiguration procedure to resume a data radio bearer, DRB, other than a signaling radio bearer 1, SRB 1, when an RRC connection is re-established;

characterized by:

means for transmitting PDCP Service Data Units, SDUs, after resetting header compression protocol and the DRB is resumed, or receiving PDCP Service Data Units, SDUs, after resetting header de-compression protocol and the DRB is resumed."

V. Claim 1 of the **first auxiliary request** is the same as claim 1 of the main request.

VI. Claim 1 of the **second auxiliary request** reads as follows:

"An Evolved UMTS Terrestrial Radio Access Network, E-UTRAN, (350) of a wireless communication system (300) for synchronizing Packet Data Convergence Protocol, PDCP, operations with a user equipment, UE, (310), the E-UTRAN (350) comprising:

means for performing an RRC Reconfiguration procedure to resume a data radio bearer, DRB, other than a signaling radio bearer 1, SRB1, when an RRC connection is re-established;

characterized by:

means for transmitting PDCP Service Data Units, SDUs, after resetting header compression protocol and the DRB is resumed."

VII. Claim 1 of the **third auxiliary request** is the same as claim 1 of the second auxiliary request except that the word "performing" is replaced by "initializing".

VIII. Claim 1 of the **fourth auxiliary request** is the same as claim 1 of the second auxiliary request.

IX. Claim 1 of the **fifth auxiliary request** is the same as claim 1 of the third auxiliary request.

X. Claim 1 of the **sixth auxiliary request** is the same as claim 1 of the second auxiliary request except that the word "transmitting" is replaced by "re-transmitting".

XI. Claim 1 of the **seventh auxiliary request** is the same as claim 1 of the sixth auxiliary request except that the word "performing" is replaced by "initializing".

XII. Claim 1 of the **eighth auxiliary request** is the same as claim 1 of the seventh auxiliary request.

XIII. Claim 1 of the **ninth auxiliary request** is the same as claim 1 of the sixth auxiliary request except that the characterising part reads as follows:

"means for re-transmitting a designated group of PDCP Service Data Units, SDUs, after resetting header compression protocol and the DRB is resumed".

XIV. Claim 1 of the **tenth auxiliary request** reads as follows:

"An Evolved UMTS Terrestrial Radio Access Network, E-UTRAN, (350) of a wireless communication system (300) for synchronizing Packet Data Convergence Protocol, PDCP, operations with a user equipment, UE, (310), the E-UTRAN (350) comprising:

means for performing an RRC Reconfiguration procedure to resume all radio bearers other than a signaling radio bearer 1, SRB 1, when an RRC connection is re-established;

characterized by:

means for re-transmitting a designated group of PDCP Service Data Units, SDUs, after resetting header compression protocol and the DRB is resumed;

wherein the radio bearers include a data radio bearer, DRB, which is mapped on Radio Link Control, RLC, Acknowledged Mode, AM, or mapped on RLC Unacknowledged Mode, UM."

XV. Claim 1 of the **eleventh auxiliary request** reads as follows:

"An Evolved UMTS Terrestrial Radio Access Network, E-UTRAN, (350) of a wireless communication system (300) for synchronizing Packet Data Convergence Protocol, PDCP, operations with a user equipment, UE, (310), the E-UTRAN (350) comprising:

means for performing an RRC Reconfiguration procedure to resume all radio bearers other than a signaling radio bearer 1, SRB1, when an RRC connection is re-established;

characterized by:

means for re-transmitting a designated group of PDCP Service Data Units, SDUs,

after resetting header compression protocol and a data radio bearer, DRB, mapped on Radio Link Control, RLC, Acknowledged Mode, AM, is resumed."

Reasons for the Decision

1. Technical context

1.1 The present patent concerns generally LTE ("Long Term Evolution") systems (although the claims as granted are not limited to LTE), and more particularly the recovery process from a disconnection due to radio link failure. The opposed patent was granted on a divisional application. The patent granted on the earlier application ("parent application") was subject to the opposition appeal case T 453/15 settled by the present board in a different composition. Some of the issues decided in that case correspond to issues to be decided in the present case, as will be indicated below.

1.2 For ease of comprehension, the meaning of certain LTE-based acronyms are listed below:

E-UTRAN = evolved universal terrestrial radio access network (NB: this includes a base station)

UE = user equipment

RRC = radio resource control

PDCP = packet data convergence protocol

SDU = service data unit

SRB = signalling radio bearer

DRB = data radio bearer.

1.3 The technical background is set out in paragraph [0003] of the parent application as published (EP 2139292 A2):

"If an RRC connection is disconnected due to radio link failure, an RRC re-establishment procedure needs to be initiated to re-establish the RRC connection. During

the RRC re-establishment procedure, a UE resumes a signal radio bearer 1 (SRB1) and configures a lower layer to re-activate security (including integrity protection and ciphering) using the previously configured algorithm immediately when receiving an RRC Connection Re-establishment message from an E-UTRAN. To resume all radio bearers other than the SRB1, the E-URTAN shall initiate an RRC Connection reconfiguration procedure after the RRC connection is re-established, wherein the RRC Connection reconfiguration procedure is to modify the RRC connection. However, it is not clearly specified how to resume SRBs and data radio bearers (DRBs) after the RRC Connection re-establishment procedure and the subsequent RRC connection reconfiguration in some scenarios. Hence, a mechanism for synchronizing PDCP operations after RRC connection re-establishment needs to be improved."

2. *Main request - claim 1 - Article 76(1) EPC*

2.1 The "gold standard" for compliance with Article 76(1) EPC is that the divisional application (and the resulting patent) must not comprise subject-matter not directly and unambiguously derivable from the parent application as filed, taking account of matter which the skilled person would regard as implicitly disclosed based on their common general knowledge.

2.2 As regards claim 1 of the main request, the respondent raises several issues with respect to compliance with Article 76(1) EPC, arguing that there is no direct and unambiguous support for the subject-matter of claim 1 in the parent application as filed in respect of the following matters:

- (i) The broadening of the terms E-UTRAN and UE to "a communication device".
- (ii) The embracing of bi-directional transmission.
- (iii) The amendment of the term "initiating" to "performing".
- (iv) The amendment of the term "re-transmitting" to "transmitting".
- (v) The broadening of "a designated group of PDCP SDUs" to "PDCP SDUs".
- (vi) The omitting of any reference to "RLC AM mode" (i.e. acknowledged mode).

2.3 **Re objections (i) and (ii):**

2.3.1 Corresponding issues have already been dealt with in appeal case T 453/15 concerning the parent application, albeit that, in T 453/15, the issue was compliance with Article 123(2) EPC. In T 453/15 (cf. point 2 of the reasons), the board came to the conclusion that the parent application as filed did not directly and unambiguously disclose a communication device for transmitting and/or receiving in the uplink direction, i.e. from UE to E-UTRAN.

That decision's reasoning applies to claim 1 of the present main request, *mutatis mutandis* (however now regarding compliance with Article 76(1) EPC rather than Article 123(2) EPC). Although the matter discussed above with respect to the parent application concerns "Solutions 6, 9 and 10" disclosed in the description thereof, whereas claim 1 of the present divisional

application concerns "Solutions 4 and 8" (cf. paragraphs [0019] and [0029] of the parent application as published), the same logic applies that the parent application as filed only provides support for an E-UTRAN as transmitting device, and that there is no basis in the parent application as filed for the general term "communication device", which embraces a UE as transmitting device as well as other non-disclosed possibilities.

2.3.2 The opposition division in the present case considered that the parent application disclosed the UE as a transmitting entity because, in Fig. 5, a status report is transmitted by the UE. However, the board does not agree, since the transmission of a status report is not the same as the transmission of a group of PDCP SDUs referred to in e.g. paragraph [0018] of the parent application as filed and therefore not a basis for generalising the E-UTRAN to any "communication device", including the UE. In fact, the transmission of the status report by the UE is rather part of the method for transmitting SDUs from the E-UTRAN to the UE.

2.4 **Re objection (iii):**

Since in the parent application as filed, it is implicit that an "RRC Reconfiguration" is performed as well as initiated, this amendment does not amount to added subject-matter.

2.5 **Re objections (iv) and (v):**

2.5.1 There is no direct and unambiguous basis in the parent application as filed for a device which is for *transmission* as well as *re-transmission*, i.e. for a device which uses the claimed reconfiguration procedure

when transmitting SDUs for the first time. Instead, the parent application is primarily directed to the problem of synchronising the E-UTRAN and the UE when re-transmitting a *designated group* of SDUs in acknowledged mode (AM). Whether or not the term "transmission" might be applicable in the case of unacknowledged mode (UM) is not clear (cf. paragraph [0029] of the parent application as published) in view of the lack of detail. However, in any case, claim 1 is not limited to UM.

- 2.5.2 The appellant argued that there was no technical difference between *re-transmission* and *transmission*, and that it made no difference whether or not a designated group was defined.

The board does not agree. *Re-transmission* of a *designated group* of SDUs (examples of how the designated group is determined are e.g. given in claim 2 of the parent application as filed) implies certain technical features going beyond what is necessary for mere *transmission*, e.g. means for identifying the SDUs of the group and means for storing SDUs until they are acknowledged. Moreover, even if an E-UTRAN configured to re-transmit SDUs clearly would also be able to transmit them for the first time, that is another context not covered by the parent application as filed.

2.6 **Re objection (vi):**

The parent application as filed is limited to either acknowledged mode (AM) or unacknowledged mode (UM) (cf. the aforementioned solutions 4 and 8), whereas present claim 1 does not include either or both of these limitations, and thus embraces potentially other modes.

The appellant argued that the mode was neither essential nor relevant. The board does also not agree here, since the mode (especially AM) is closely connected to the choice of the designated group of SDUs for re-transmission. In that context, the board refers also to the remarks made in connection with objections (iv) and (v) in point 2.5 above.

2.7 At the oral proceedings before the board, the appellant further submitted that which objections were raised by the various organs of the EPO was a "lottery". In the present case, the examining division had found no objection with respect to issues (i) and (ii), and nor had the opposition division either. Furthermore, in case T 453/15 (supra), objections (iv) to (vii) had not been raised. Furthermore, with respect to the board's approach to compliance with Article 76(1) EPC, the skilled person was held to be a "complete idiot".

In that regard, the board points out that it is quite normal that a Board of Appeal takes a different opinion to an examining or opposition division. Furthermore, objections (iv) to (vii) were not raised, discussed or decided on in case T 453/15. Hence, the facts are not the same. Finally, the question at issue is not the intelligence of the fictitious skilled person, but whether there is a direct and unambiguous disclosure of the presently claimed subject-matter in the parent application as filed, taking account of what the skilled person would recognise as implicit. The change of scope in relation to objections (i), (ii) and (iv) to (vi) does not however concern matters which are implicit. The appellant's arguments are therefore unconvincing.

- 2.8 The board raised, *ex officio*, a further objection under Article 76(1) EPC (to be referred as **objection (vii)**), namely that claim 1 uses the formulation "means for performing an RRC Reconfiguration procedure to resume a data radio bearer, DRB, other than a signaling radio bearer 1, SRB1, when an RRC connection is re-established", whereas the parent application as filed uses the formulation "all radio bearers other than a signaling radio bearer 1" (cf. claim 1 and paragraph [0003], line 10 of the parent application as published). Thus, claim 1 now embraces the possibility that not all other radio bearers will be resumed, as opposed to the teaching of the parent application as filed.
- 2.8.1 The appellant objected to the board's raising new issues in the appeal proceedings, arguing that new Article 12(2) RPBA 2020 establishes the character of the appeal proceedings as a judicial review in which the parties have only very limited room for amending their case with respect to the first-instance proceedings. The board therefore should be similarly constrained from introducing new objections of its own motion.
- 2.8.2 This is not persuasive, as will be discussed later when dealing with the request for referral to the Enlarged Board of Appeal (cf. point 8 below).
- 2.8.3 On the substance of **objection (vii)**, the appellant argued that the description of the parent application as filed contained numerous references in the singular form ("a" or "the") with respect to DRBs. In this respect, the appellant referred to, *inter alia*, paragraphs [0007], [0012] to [0017] and Figs. 5 to 10 of the parent application. From these and other

references in the parent application as filed, it was directly and unambiguously clear that not all DRBs had to be resumed.

2.8.4 This is likewise not persuasive, because claim 1 of the parent application as filed, in the characterising part, also refers to "a DRB" in the singular form, but this is claimed together with the further limitation in the preamble concerning "all DRBs ...". Consequently, the singular "a DRB" means one of the "all DRBs" that are resumed. This applies, *mutatis mutandis*, to all the references to "a DRB" or "the DRB" referred to by the appellant in the description, in view of the same context established in paragraphs [0006] and [0009] as set out in the preamble of claim 1 of the parent application as filed. At the very least, there is no *direct and unambiguous* disclosure that this limitation does not apply to the described embodiments.

2.9 Consequently, in view of objections (i), (ii) and (iv) to (vii), claim 1 of the main request does not comply with Article 76(1) EPC.

3. *First to ninth auxiliary requests - claim 1 - Article 76(1) EPC*

3.1 Some of the objections (i), (ii) and (iv) to (vii) apply, *mutatis mutandis*, to claim 1 of each of the first to ninth auxiliary requests:

First auxiliary request: (i), (ii), (iv) to (vii).

Second to fifth auxiliary requests: (iv) to (vii).

Sixth to eighth auxiliary requests: (v) to (vii).

Ninth auxiliary request: (vi) and (vii).

3.2 Consequently, claim 1 respectively of the first to ninth auxiliary requests does not comply with Article 76(1) EPC either.

4. *Tenth auxiliary request - claim 1 - Article 76(1) EPC*

4.1 Although claim 1 of the tenth auxiliary request is amended to introduce features with the aim of overcoming the objections discussed above, a new objection under Article 76(1) EPC has arisen. In this respect, by introducing the feature "... unacknowledged mode", claim 1 now embraces the possibility that the re-transmitted designated group of SDUs defined in the first characterising feature concerns *unacknowledged* mode (UM). In the parent application as filed, however, the re-transmitted designated group of SDUs only concerns *acknowledged* mode (AM), namely SDUs which have been transmitted but not acknowledged (cf. claim 2 of the parent application as filed). Consequently, the claiming of a re-transmitted group of SDUs in connection with UM is not directly and unambiguously disclosed in the parent application as filed.

4.2 Claim 1 of the tenth auxiliary request therefore does not comply with Article 76(1) EPC either.

5. *Eleventh auxiliary request - admittance (Article 13(2) RPBA 2020)*

5.1 The request was filed during the oral proceedings before the board. Its admittance is therefore at the discretion of the board (Article 13(2) RPBA 2020). In the application of Article 13(2) RPBA 2020, the criteria according to Article 13(1) RPBA 2020 may also be used (see e.g. explanatory remarks to Article 13(2) RPBA 2020).

In accordance with Article 13(1) RPBA 2020, the "Board shall exercise its discretion in view of, inter alia, the current state of the proceedings, the suitability of the amendment to resolve the issues which were admissibly raised by another party in the appeal proceedings or which were raised by the Board, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, whether the party has demonstrated that any such amendment, *prima facie*, overcomes the issues raised by another party in the appeal proceedings or by the Board and does not give rise to new objections".

5.2 In the present case, the eleventh auxiliary request was a straightforward development of the tenth auxiliary request. The latter request had been submitted in writing in response to a new objection raised by the board (see point 2.8 above). In response to a new issue under Article 76(1) EPC, as raised by the respondent at the oral proceedings before the board, the appellant filed amended claims as the eleventh auxiliary request, which, *prima facie*, overcame the objection, and did not give rise to new objections. Although the respondent did argue that the amendments gave rise to non-compliances respectively with Articles 84 and 123(3) EPC, these objections were found to be unconvincing (see points 6 and 7 below). Thus, taking account of the criteria set out in Article 13(1) RPBA 2020, there was no reason not to admit the auxiliary request.

5.3 Pursuant to Article 13(2) RPBA 2020, amendments to a party's case after notification of a summons to oral proceedings shall, in principle, only be taken into

consideration in **exceptional circumstances**.

In the present case, the board, exceptionally, raised a new objection *ex officio*. Consequently, the requirement for there to be "exceptional circumstances" is met.

5.4 Therefore, the eleventh auxiliary request was admitted into the proceedings (Articles 13(1) and (2) RPBA 2020).

6. *Eleventh auxiliary request - claim 1 - Articles 76(1) and 123(3) EPC*

6.1 The relevant part of **claim 1 as granted** reads as follows:

"means for performing an RRC Reconfiguration procedure to resume a data radio bearer, DRB, other than a signaling radio bearer 1, SRB1, when an RRC connection is re-established;
characterized by:
means for transmitting PDCP Service Data Units, SDUs, after resetting header compression protocol and the DRB is resumed ..." (board's underlining).

6.2 The relevant part of **claim 1 of the eleventh auxiliary request** reads as follows:

"means for performing an RRC Reconfiguration procedure to resume all radio bearers other than a signaling radio bearer 1, SRB1, when an RRC connection is re-established;
characterized by:
means for re-transmitting a designated group of PDCP Service Data Units, SDUs, after resetting

header compression protocol and a data radio bearer, DRB ... is resumed".

- 6.3 The reformulation of claim 1 of the eleventh auxiliary request is based on claim 1 of the parent application as filed. The amendment therefore complies with Article 76(1) EPC.
- 6.4 With respect to Article 123(3) EPC, the respondent argued that, in claim 1 as granted, the DRB in the characterising part referred back to the antecedent DRB in the preamble, whereas there was no such link in claim 1 of the eleventh auxiliary request. Consequently, "a data radio bearer" defined in the characterising part need not be one of the "all radio bearers ...". The scope of claim 1 has therefore "shifted".
- 6.5 The board however does not agree. With a mind willing to understand the claim in a way which makes sense technically, it is clear that the term "a data radio bearer, DRB" in the characterising part means a DRB within the group of "all radio bearers". In any case, the term "all radio bearers" leaves no scope for any putative *other* DRBs. The scope of claim 1 of the eleventh auxiliary request is therefore not broader than that of claim 1 as granted.
- 6.6 A further objection under Article 123(3) EPC was raised against the main request underlying the opposition proceedings and maintained in these appeal proceedings. This objection needs to be considered, since it applies, *mutatis mutandis*, to claim 1 of the eleventh auxiliary request.

6.7 The objection concerns the alleged broadening of claim 1 as granted from "a transceiver" with means for transmitting *and* receiving SDUs to an E-UTRAN without means for receiving SDUs. The same objection was raised in connection with the parent application, and in accordance with decision T 453/15 (*supra*) was found not convincing. The relevant passage of that decision reads as follows:

"6.2.2 As already stated above ..., the board considers that claim 1 as granted embraces a communication device with: (i) only means for transmitting, or (ii) only means for receiving, or (iii) with means for transmitting and receiving. The board sees no reason to interpret the term "or" in claim 1 only as "and", as essentially argued by the respondent.

6.2.3 Since claim 1 as amended is narrower in scope than interpretation (i), the scope of protection has not been extended within the meaning of Article 123(3) EPC."

6.8 The same reasoning applies, *mutatis mutandis*, to claim 1 of the eleventh auxiliary request.

6.9 To conclude, claim 1 of the eleventh auxiliary request complies with Articles 76(1) and 123(3) EPC.

7. *Eleventh auxiliary request - claim 1 - Article 84 EPC*

7.1 The respondent objected to the term "a designated group of ... SDUs" as being unclear (NB: the respondent made this objection in connection with claim 1 respectively of the ninth and tenth auxiliary requests, although it can be considered to apply, *mutatis mutandis*, to

claim 1 of the eleventh auxiliary request). The respondent submitted that the appellant themselves had argued that the term was meaningless when discussing compliance with Article 76(1) EPC (cf. the appellant's submission dated 22 December 2021, point 3, third paragraph). Furthermore, it was arbitrarily worded and played no role as regards the remaining features of claim 1.

7.2 The board however considers that this term, although broad, is understandable and technically meaningful in the sense of referring to a *selected* group of the previously transmitted SDUs. Three different ways of determining the designated group are, moreover, defined in paragraph [0044] of the opposed patent, item 2 (which corresponds to claim 1 of the parent application as filed), justifying the broad formulation of claim 1.

7.3 The respondent's arguments are therefore, unconvincing in that regard.

8. *Request for questions to be referred to the Enlarged Board of Appeal*

8.1 In the submission dated 22 December 2020, point 1, the appellant made the following request:

"[I]t is requested that, if the Board considers itself competent to raise and decide on new objections that had not been the subject of the decision under review, the following questions should be referred to the Enlarged Board of Appeal under Art. 112(1) (a) EPC:

1. *Do the Rules of Procedure of the Boards of Appeal of the European Patent Office (RPBA) as in*

force from January 1, 2020 impose any limitations on the scope of examination for the board of appeal in the appeal proceedings?

2. If the answer to question 1 is yes, does the board of appeal conducting those proceedings have inherent competence to raise new objections that had not been the subject of the examining [sic] division's decision?

3. If the answer to question 2 is yes, can the board of appeal conducting those proceedings directly decide on any such new objections in view of Art. 11 RBPA [sic], or is the board of appeal obliged in such cases to remit the application to the department whose decision was appealed for a further prosecution in accordance with the second alternative of Art. 111 (1) EPC?"

8.2 The appellant reasoned the need for a referral by referring to Article 111(1) EPC and Article 12(2) RPBA 2020, and by arguing:

"According to Art. 111 (1) EPC, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

In contrast, Art. 12(2) of the Rules of Procedure of the Boards of Appeal [...] as in force from January 1, 2020 defines the nature and scope of the appeal proceedings as a review of the decision under appeal in a judicial manner.

Since the present decision under appeal did not mention, discuss or find any violations of Art. 76(1) EPC with regard to the feature identified as objection (vii) in item 5.7 of the Summons, it is considered ultra vires [for] the present board to newly raise such objection at the present stage of the proceedings, at least with regard to the Main Request which corresponds to the Main Request underlying the contested decision. Since the Board of Appeal constitutes the only and final judicial instance in the present procedure, the Applicant/Appellant [sic] is confronted with new objections and has no possibility to have any decision on such new objections reviewed by a further instance."

8.3 The board points out that, with respect to the main request, **objection (vii)** is actually moot, since there are several other objections leading to the refusal of this request. That notwithstanding, there is no need to refer these questions to the Enlarged Board of Appeal because, on the basis of established case law (cf. J 5/81, Headnote 2; T 198/88, point 2.3 of the reasons), the board is unequivocally able to answer these questions itself by reference to the EPC.

8.3.1 **Re questions 1 and 2:**

Article 12(2) RPBA 2020 frames the "primary object of the appeal proceedings [as being] to review the decision under appeal in a judicial manner", but mainly concerns, if at all, obligations on the parties and not the board ("a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based"). The board sees here no provision, or any other provision of

the Rules of Procedure, which could and would restrict its power conferred by Articles 111(1) and 114(1) EPC to raise new objections of its own motion. This would, moreover, be "incompatible with the spirit and purpose of the Convention" (cf. Article 23 RPBA 2020). Thus, provisions of the RPBA as "secondary legislation" according to Article 23(4) and Rule 12c EPC could never take precedence over the provisions of the EPC itself (cf. Article 23(3) EPC).

Although G 10/91, OJ 1993, 420, imposes a limitation on the scope of examination, in *inter partes* appeal proceedings, that fresh grounds for opposition can only be introduced with the proprietor's consent, by "ground for opposition" is here meant one of the *legal bases* set out in Article 100 EPC. This is consistent with a "ground" being considered as the *legal basis* (cf. G 1/95, OJ 1996, 615, point 5.4 of the reasons), and not the *factual basis*, which concerns the facts, arguments and evidence relied on (*idem*, cf. point 3.1 of the reasons). The board is not aware of any case law which would regard two objections having the same legal basis, e.g. Article 76(1) EPC, which concerns the ground for opposition pursuant to Article 100(c) EPC, as being *separate grounds for opposition* within the meaning of G 10/91.

Moreover, in case of amendments of the claims in the course of *inter partes* appeal proceedings, such amendments are to be **fully** examined as to their compatibility with the requirements of the EPC (see G 10/91, point 19 of the reasons). The board notes in passing that in *ex parte* appeal proceedings any new *ground*, i.e. not examined by the first-instance department, can be invoked by a Board of Appeal under Article 114(1) EPC during the appeal proceedings (cf.

G 10/93, OJ 1995, 172, Headnote).

That the board may raise new objections, such as even a new inventive-step objection, is furthermore confirmed by the Enlarged Board of Appeal (see e.g. R 16/13, points 5.1 and 5.2 of the reasons). This is also consistent with Article 13(1) RPBA 2020, which mentions "the issues which were admissibly raised by another party in the appeal proceedings or which were raised by the Board".

It goes without saying that, when a new objection is raised, the proprietor's right to be heard must be respected (Article 113(1) EPC), but that is a separate issue (see also explanatory remarks to Article 13(1) RPBA 2020, penultimate paragraph, last sentence: "Where the Board raises an issue of its own motion under Article 114(1) EPC, the party's right to be heard under Article 113(1) EPC must be respected").

8.3.2 **Re question 3:**

In accordance with Article 111(1) EPC, the board "may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution". According to established case law, this does not mean that a party has an absolute right to have every issue decided by two instances. Hence, no such obligation as claimed by the appellant can be derived from Article 111(1) EPC or from Article 11 RPBA 2020. Remitting a case *merely* so that a limited issue (such as **objection (vii)** here) can be considered by two instances would be neither proportionate nor procedurally expedient, nor would it constitute a

"special reason" within the meaning of Article 11 RPBA 2020.

8.4 Thus, there is no need for a referral to the Enlarged Board of Appeal.

9. *Alleged substantial procedural violation - Rule 103(1) (a) EPC*

9.1 The appellant requests reimbursement of the appeal fee by dint of an alleged substantial procedural violation committed by the opposition division. In this respect, it is argued that a violation of Article 113(1) EPC occurred when the opposition division did not admit an auxiliary request into the opposition proceedings (cf. points 4.2 to 5.7 of the minutes of the first-instance oral proceedings), arguing that the opposition division did not give them sufficient time to prepare this auxiliary request following its change of mind from the preliminary opinion issued with the summons to the oral proceedings. Thus, a "minor oversight" occurred that led to the request not being admitted.

9.2 However, the board notes that following the non-admitting of the auxiliary request by the opposition division during the oral proceedings, the request was then withdrawn *of the appellant's own volition* (cf. point 5.8 of the minutes). This obviated the need for the opposition division to give reasons for not admitting the request, which could have been reviewed by the board. This claim request has also not been re-submitted with the appeal. Although the appellant also states that the request was only withdrawn after it had not been admitted, the board does not see the logic of this approach. If they had not accepted the reasons orally given by the opposition

division for not admitting the request and actually wanted to pursue the request, it should not have been withdrawn.

9.3 Under these circumstances, no procedural violation can be recognised which would justify reimbursement of the appeal fee (Rule 103(1)(a) EPC).

10. *Conclusion*

The amendments made to claim 1 in accordance with the eleventh auxiliary request have overcome the ground which led to the revocation of the opposed patent, i.e. Article 76(1) EPC. However, the ground for opposition pursuant to Article 100(a) EPC has not yet been examined. The case is therefore remitted to the opposition division for further prosecution on the basis of the claims of the present eleventh auxiliary request.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is refused.
2. The decision under appeal is set aside.
3. The case is remitted to the opposition division for further prosecution.
4. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated