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**Datasheet for the decision  
of 11 December 2017**

**Case Number:** T 0183/17 - 3.5.02

**Application Number:** 10188105.0

**Publication Number:** 2315322

**IPC:** H01R31/06, H02J7/00

**Language of the proceedings:** EN

**Title of invention:**

Docking station and device for use in a docking station

**Applicant:**

Sa, Shuang

**Relevant legal provisions:**

EPC Art. 114(2)  
RPBA Art. 12(4)  
EPC R. 116(1), 116(2)

**Keyword:**

Late-filed request - admitted (no) - request identical to  
request not admitted in first instance proceedings



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0183/17 - 3.5.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.02**  
**of 11 December 2017**

**Appellant:** Sa, Shuang  
(Applicant) 100 13551 Verdun Place  
Richmond, BC V6V 1W5 (CA)

**Representative:** Appleyard Lees IP LLP  
15 Clare Road  
Halifax HX1 2HY (GB)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 9 September  
2016 refusing European patent application No.  
10188105.0 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** R. Lord  
**Members:** G. Flynn  
W. Ungler

## **Summary of Facts and Submissions**

- I. The applicant's appeal contests the examining division's decision to refuse the European patent application 10 188 105.0.
  
- II. In the contested decision the examining division, setting out their reasons, came to the conclusion that all of the requests on file at the time were late-filed and comprised amendments which were "clearly not allowable" under Article 123(2) EPC.

The requests on file were the main and the three auxiliary requests which were filed on 27 June 2016, which was one day before the oral proceedings of 28 June 2016 that the applicant did not attend.

Citing Article 114(2) in conjunction with Rule 116(1) EPC, the examining division exercised their discretion regarding these late-filed submissions and did not admit them into the procedure.

As these requests were the only ones on file, the examining division held that there was no valid request on file that had been proposed by the applicant and admitted by the division. Under these circumstances and considering Article 113(2) EPC the examining division came to the conclusion that the application was to be refused.

- III. With the written statement setting out the grounds of appeal the appellant (applicant) re-filed the main and the three auxiliary requests that had been filed on 27 June 2016.

The appellant did not comment as to the admissibility of these requests in the appeal procedure, but argued that they did not add subject-matter in contravention of Article 123(2) EPC and that their subject-matter was novel and involved an inventive step, Articles 54 and 56 EPC

IV. The appellant was summoned to attend oral proceedings. In an annex to the summons the Board set out their preliminary observations on the appeal, concluding that it seemed they should not overrule the way in which the examining division had exercised its discretion in this case and should therefore hold the main and the three auxiliary requests that were re-filed on appeal to be inadmissible using the discretionary power afforded by Article 12(4) RPBA.

V. Oral proceedings were held as scheduled on 11 December 2017.

The appellant requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further examination on the basis of the main request and first to third auxiliary requests filed with letter dated 27 June 2016.

The Board pronounced the present decision at the oral proceedings.

## **Reasons for the Decision**

1. According to Article 114(2) EPC the EPO may disregard facts or evidence not filed in due time and according to Rule 116(2) EPC taken together with the third and fourth sentences of Rule 116(1) EPC to which it refers, new application documents (i.e. in the present case new sets of claims) which are presented after the final date fixed for making written submissions in preparation for oral proceedings need not be considered, unless they are admitted on the grounds that the subject of the proceedings has changed.
  
2. In the present case, the new main and three auxiliary requests were filed before the examining division on 27 June 2016, which was after the final date that had been fixed for making written submissions in preparation for oral proceedings. In considering whether the amendments were admissible under Rule 116(1) [and (2)] and Article 114(2) EPC, the examining division referred to Guidelines H-II, 2.7.1 and applied the principle that they should first consider whether the late-filed requests were allowable on a prima facie basis (see reasons for the decision, section I). The examining division applied this principle to each of the new requests and found that in each case the amendment was "clearly not allowable under Article 123(2) EPC" (see the conclusions reached at the end of each of the sub-sections A to D of section I of the reasons for the decision). In view of these findings the examining division exercised their discretion regarding these late-filed submissions and did not

admit the main and three auxiliary requests filed on 27 June 2016.

3. On appeal the appellant has re-submitted the main and three auxiliary requests which were not admitted by the examining division.
4. According to Article 12(4) RPBA, the Board has the power to hold inadmissible requests which were not admitted in the first instance proceedings.
5. The case law regarding late submissions in general, independent of the preparation of oral proceedings governed by Rule 116 EPC, is summarised in the Case Law of the Boards of Appeal, Eighth Edition, section IV.E. 4.3.3(a) under the headings "Filing of amended claims in appeal proceedings", "Ex parte appeal procedure", "Admission of requests already refused by the examining division".

There it is stated that it is the established jurisprudence of the boards of appeal that the power of the examining division to consent to amendments under Rule 137(3) EPC is a discretionary power. According to G 7/93 (OJ 1994, 775) the way in which the examining division should exercise its discretion to allow an amendment of an application must depend upon the circumstances of each individual case, and must also depend upon the stage of the pre-grant procedure which the application has reached. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion if it comes to the conclusion either that the department of first instance, in its decision, has not exercised its discretion in accordance with the right principles or that it has exercised its discretion in an unreasonable

way. The exercise of a discretionary power has to strike a balance between, in particular, the applicant's interest in obtaining adequate protection for his invention and the EPO's interest in bringing the examination to a close in an effective and speedy way. Moreover, the exercise of a discretionary power has to be reasoned, otherwise it would be arbitrary (T 246/08).

These considerations apply also when a board of appeal has to review the way in which an examining division has exercised its discretion under Rule 116(1) and (2) EPC in respect of the admission of amendments filed after the final date fixed for making written submissions in preparation for oral proceedings (see the last paragraph of the Case Law, section III.C.4.4).

6. In the present case the examining division applied the criterion of "clear allowability" set out in the Guidelines for Examination, H-II, 2.7.1, which is undoubtedly the right principle to have applied. Furthermore, when applying that criterion they gave an appropriate level of reasoning for the conclusion they reached, even if the conclusion under the "clear allowability" criterion should perhaps have been that the amendments were "not clearly allowable", rather than that they were "clearly not allowable".
7. The appellant argued that in coming to their conclusion the examining division had exercised their discretion unjustly because they had not taken into account that the expression "cable connection" in claim 1 was broad and could be construed either as being the "docking contact point" of the adaptor, as in claim 14, or as being some other unspecified connection. The Board considered these arguments to be of no relevance to the

question at issue of whether the examining division had exercised their discretion in accordance with the right principles or had exercised their discretion in an unreasonable way.

8. The appellant also argued that when considering whether or not the amendments to the claims were "clearly allowable", it was not necessary for the amendments to resolve all minor issues. In the appellant's view it was sufficient that the main claims as amended provided a promising starting point and small issues of added subject-matter in a dependent claim, for example, could have been resolved after agreement had been reached on the main claims. These arguments were not persuasive because even if the examining division had been able to recognise the defects as being "minor", which is questionable, the fact that the applicant had chosen not to attend the oral proceedings meant that it would have involved a substantial procedural delay had the examining division postponed the oral proceedings to give the applicant an opportunity to remedy them. This would not have been in accordance with the need for procedural economy.
9. Taking all of these considerations into account the Board of Appeal came to the conclusion that they should not overrule the way in which the examining division exercised its discretion in this case and held the main and the three auxiliary requests that were re-filed on appeal to be inadmissible using the discretionary power afforded by Article 12(4) RPBA.
10. In the absence of an admissible request the appeal had to be dismissed.



**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated