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**Datasheet for the decision
of 14 December 2021**

Case Number: T 0819/19 - 3.5.05

Application Number: 08740001.6

Publication Number: 2263905

IPC: B60L3/00, H04L12/40, H04L12/46,
H04L29/12

Language of the proceedings: EN

Title of invention:

COMMUNICATION RELAY DEVICE FOR TRAIN AND COMMUNICATION RELAY
METHOD FOR TRAIN

Patent Proprietor:

Mitsubishi Electric Corporation

Opponent:

Siemens Aktiengesellschaft

Headword:

COMMUNICATION RELAY DEVICE FOR TRAIN / Mitsubishi

Relevant legal provisions:

EPC Art. 113(1)
EPC R. 111(2), 103(1)(a)
RPBA 2020 Art. 11

Keyword:

Appealed decision - sufficiently reasoned (no)

Right to be heard - violation (yes)

Remittal - fundamental deficiency in first-instance proceedings (yes)

Reimbursement of appeal fee - equitable by reason of a substantial procedural violation



Beschwerdekammern

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Case Number: T 0819/19 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 14 December 2021

Appellant: Siemens Aktiengesellschaft
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Respondent: Mitsubishi Electric Corporation
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
16 January 2019 concerning maintenance of the
European Patent No. 2263905 in amended form.

Composition of the Board:

Chair A. Ritzka
Members: N. H. Uhlmann
E. Mille

Summary of Facts and Submissions

I. The appellant-opponent appealed against the opposition division's interlocutory decision to maintain the European patent No. 2 263 905 in amended form according to the main request submitted in the course of the oral proceedings.

II. The decision under appeal made reference to, *inter alia*, following prior art documents:

E1 US 2006/180709

E2 P. Srisuresh et al.,: "Traditional IP Network Address Translator (Traditional NAT)", Internet Archive Wayback Machine, 24 January 2007, pages 1-17, Retrieved from the Internet: URL:<http://web.archive.org/web/20070124101430/http://tools.ietf.org/html/rfc3022>

E3 US 2002/049859

E4 HUBERT KIRRMANN: "THE IEC/IEEE TRAIN COMMUNICATION NETWORK", IEEE MICRO, IEEE SERVICE CENTER, LOS ALAMITOS, CA, US, 1 January 2001, pages 81-92, ISSN: 0272-1732

III. In its statement setting out the grounds of appeal the appellant requested that the decision be set aside, the patent be revoked and the appeal fee be reimbursed.

IV. The respondent-proprietor filed a reply to the appeal and requested that the appeal be dismissed.

V. The board summoned the parties to oral proceedings.

In a communication pursuant to Article 15(1) RPBA 2020, the board set out its provisional view of the case. It observed that the first-instance proceedings appeared to be tainted by substantial procedural violations. A

remittal to the department of first instance and reimbursement of the appeal fee were to be expected.

- VI. The parties withdrew their respective requests for oral proceedings.

Thereupon the oral proceedings were canceled and the appeal procedure was continued in writing.

- VII. The wording of the claims is of no relevance for this decision.

Reasons for the Decision

1. The patent in suit pertains to a communication relay device for a train. The device converts source and destination addresses.
2. Reasons in the impugned decision, Article 113(1) EPC and Rule 111(2) EPC
 - 2.1 The appellant argued (section B.1 of the statement setting out the grounds of appeal) that the decision was not reasoned in the sense of Rule 111(2) EPC and requested that the appeal fee be reimbursed.
 - 2.2 The respondent submitted (sections 2 to 4 of the letter of reply) that the decision was brief, but clearly indicated why claim 1 was found to be inventive.
 - 2.3 The board's analysis is set out in the following sections.
 - 2.4 The decision under appeal
 - 2.4.1 The opposition decision decided that the patent as amended meets the requirements of the EPC. In particular, it was held that the subject-matter of the

independent claims was new and involved an inventive step (Articles 54 and 56 EPC).

- 2.4.2 The reasons regarding inventive step of the subject-matter of claim 1 are set out in sections 12.2 and 12.3 of the decision under appeal.
- 2.4.3 The opposition division held that document E1 represented the closest prior art for the subject-matter of claim 1.
- 2.4.4 The arguments of the opponent and the patent proprietor were reproduced in section 12.2.
- 2.4.5 Section 12.3 reads in full:

The opposition division came to the conclusion that "formation identification information" and its setting depending on packet destination as defined in independent claim 1 rendered non-obvious the subject-matter of claim 1. Therefore, the subject-matter of claim 1 involves an inventive step.

- 2.5 The law and the jurisprudence
- 2.5.1 According to Rule 111(2) EPC, decisions of the European Patent Office which are open to appeal shall be reasoned.
- 2.5.2 The jurisprudence of the Boards of Appeal developed criteria for judging if a decision is reasoned in the sense of Rule 111(2) EPC. In particular, it was held that a decision had to contain the logical chain of facts and reasons on which it is based and at least some motivation on crucial points of dispute, see the Case Law of the Boards of Appeal of the EPO, 9th edition, chapters III.K.3.4.3 and 3.4.4.

The Guidelines for Examination at the EPO, chapters E-X 2.6 and 2.8, state to the same effect that "the reasoning for each of the grounds on which the decision

is based must contain, in logical sequence, those arguments which justify the order" and "all significant arguments advanced by a losing party to the proceedings are carefully examined and comprehensively refuted in the decision".

- 2.5.3 Article 113(1) EPC codifies the parties' right to be heard. The right to be heard is not just a right to present comments but also to have those comments duly considered. The comments presented must be considered in the ensuing decision.
- 2.6 Does the decision under appeal meet the requirements of Article 113(1) and Rule 111(2) EPC?
 - 2.6.1 Section 12.3 of the decision states the conclusion of the opposition division. However, there is no explanation how the division came to this conclusion. Merely reciting some features of an independent claim and stating that they render the subject-matter of the claim non-obvious cannot be seen to contain any logical chain of arguments. In effect, the conclusion given in section 12.3 of the decision under appeal amounts to an unsubstantiated assertion.
 - 2.6.2 The respondent submitted that the decision under appeal completely indicated the features which distinguished the claims over the cited art and that these features could not be derived from the cited art.

The board agrees that the decision includes such indications. However, the decision does not set out any arguments supporting the conclusion reached by the opposition division.
 - 2.6.3 Furthermore, the arguments of the opponent, as summarized by the opposition division in section 12.2. of the decision, were not refuted in any way.

2.6.4 Finally, the opponent argued in the notice of opposition that the subject-matter of claim 1 as granted did not involve an inventive step in view of the disclosure of documents E3 and E4. This inventive step attack was not addressed in the impugned decision.

2.6.5 The respondent submitted in its letter of reply (sections 15 and 16) that this attack was not discussed during the oral proceedings and the appellant "seemingly abandoned" this attack during the oral proceedings.

The board disagrees. The minutes of the oral proceedings do not mention any such abandonment. Furthermore, objections submitted in writing do not need to be repeated at the oral proceedings. The procedures according to the EPC are mainly in writing, thus written submissions have to be taken into account.

2.7 In view of the above observations, the board holds that with regard to the requirements of Article 56 EPC the impugned decision infringes the right to be heard of the opponent (Article 113(1) EPC) and is not reasoned in the sense of Rule 111(2) EPC.

2.8 A failure to provide reasoning in accordance with Rule 111(2) EPC is considered a procedural violation. Similarly, disregarding the right to be heard of a party amounts to a procedural violation. In the present case the question of compliance with the inventive step requirement of the EPC is of decisive nature, because a patent can be maintained in amended form only if the subject-matter of the claims involves an inventive step. Hence, the procedural violations are substantial and justify the reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC (see the Case Law of the Boards of Appeal of the EPO, 9th edition, chapter V.A. 9.5.9)

3. Remittal to the department of first instance
- 3.1 According to Article 11 RPBA 2020 fundamental deficiencies in the proceedings before the opposition division constitute, as a rule, reasons for remitting the case to it. In the board's view, the substantial procedural violations constitute a fundamental deficiency in the proceedings.
- 3.2 The primary object of the appeal proceedings is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020). The board considers that in the present case the decision, which is not reasoned in the sense of Rule 111(2) EPC, cannot be substantially reviewed.
- 3.3 For these reasons, the board decided to remit the case for further prosecution. Reimbursement of the appeal fee is equitable.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the department of first instance for further prosecution.

The appeal fee is reimbursed in full.

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka

Decision electronically authenticated