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**Datasheet for the decision
of 5 October 2022**

Case Number: T 1017/20 - 3.5.05

Application Number: 10752138.7

Publication Number: 2473392

IPC: B61L29/32, B61L29/18,
B61L25/02, B61L23/06

Language of the proceedings: EN

Title of invention:

RAILWAY SYSTEMS USING ACOUSTIC MONITORING

Patent Proprietor:

Siemens Mobility Limited

Opponent:

OptaSense Holdings Limited

Headword:

RAILWAY SYSTEMS USING ACOUSTIC MONITORING / Siemens Mobility

Relevant legal provisions:

RPBA 2020 Art. 12(6), 13(2)

EPC Art. 84, 100(b), 83

Keyword:

Main request - admitted in first-instance proceedings (no)
Main request - error in use of discretion at first instance
(no)
Main request - circumstances of appeal case justify admittance
(no)
Main request - admitted (no)
Amendment after summons - exceptional circumstances (no)

Decisions cited:

T 0412/09, T 0051/87, T 0945/12



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Case Number: T 1017/20 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 5 October 2022

Appellant: Siemens Mobility Limited
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 25 February
2020 revoking European patent No. 2473392
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chair	A. Ritzka
Members:	N. H. Uhlmann
	K. Kerber-Zubrzycka

Summary of Facts and Submissions

- I. The appellant-patent proprietor appealed against the opposition division's decision to revoke European patent No. 2 473 392.
- II. The decision under appeal made reference, *inter alia*, to the following documents:
 - Q3 US 2004/261533
 - Q4 J. F. Forren et al: "Traffic monitoring by tire noise", INTELLIGENT TRANSPORTATION SYSTEM, 1997. ITSC '97., IEEE CONFERENCE ON BOSTON, MA, USA 9-12 NOV. 1997, pages 177-182, ISBN: 978-0-7803-4269-9
 - Q5 Chapter 9 of the book "Fiber Optic Sensors", 2002, Marcel Dekker, Inc., Editors: Francis T S Yu and Shizhuo Yin, Authors: G D Peng, P L Chu; pages 417 - 447
- III. In its statement setting out the grounds of appeal the appellant requested that the decision be set aside and that the patent be maintained in amended form according to the main request or one of the first to sixth auxiliary requests. These requests (claims and description) were submitted with the statement of grounds of appeal.
- IV. The respondent-opponent filed a reply and requested that the appeal be rejected as inadmissible or, in the alternative, that it be refused because none of the appellant's requests were allowable.
- V. The board summoned the parties to oral proceedings and set out its provisional view on the case in a communication under Article 15(1) RPBA.

VI. By letter dated 9 September 2022 the appellant withdrew all auxiliary requests and submitted a corrected version of the main request.

VII. The oral proceedings took place by videoconference.

VIII. Final requests of the parties

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form according to the main request submitted with the statement of grounds of appeal or according to the corrected version submitted with its letter of 9 September 2022.

The respondent (opponent) requested that the appeal be dismissed.

IX. Claim 1 of the main request and the corrected version of the main request reads as follows:

"A method of monitoring and/or controlling components of a railway system which includes a track and at least one train that is operable to run on said track, comprising the steps of:

- a) providing an acoustic transducer proximate the railway for picking up acoustic signals, wherein the acoustic transducer comprises an optical fibre;
- b) receiving acoustic signals from the transducer from at least two locations;
- c) analysing the received signals and identifying a signature of the train, compensating the signature for the squeezing and stretching of the signature along a time axis depending on the speed of the train, and tracking the train by using a pattern matching algorithm to compare the received signatures ensuring that the received signatures correspond to the same train, and

determining the position of the train from its signature."

Reasons for the Decision

1. Admissibility of the appeal

The respondent requested in its reply that the appeal be rejected as inadmissible.

The board holds that the appeal meets the requirements of Articles 106 to 108 EPC and Rule 99 EPC and is thus admissible.

2. The patent in suit pertains to an apparatus and a method for monitoring and/or controlling components of a railway system. An acoustic transducer is placed proximate to the railway. The transducer comprises an optical cable. Acoustic signals received from two locations are analysed and a signature of a train is identified. The signature is compensated depending on the speed of the train and used for tracking the train and determining its position.

3. Document Q3 discloses a method for determining parameters relating to a train travelling on a railway track. Acoustic sensors are used and the location of the train is determined.

Main request

4. Admission

4.1 The claims of the main request correspond to those of the main request on which the contested decision was based whereby merely an "and" is missing at the end of feature b) in claim 1. This difference does not have any impact on the claimed subject-matter.

4.2 The main request on which the impugned decision was based was submitted in the course of the first-instance oral proceedings and was not admitted into the opposition proceedings.

4.3 The respondent requested that the main request should not be admitted under Article 12(6) RPBA. It argued that the discretionary decision of the opposition division was correct and that no special circumstances of the appeal case were present.

4.4 According to the first sentence of Article 12(6) RPBA, a board must not admit requests which were not admitted into the proceedings that led to the decision under appeal, unless

(a) the decision not to admit them was affected by an error in the use of discretion, or unless

(b) the circumstances of the appeal case justify their admittance.

These two criteria (a) and (b) were discussed with the parties at the oral proceedings.

Criterion a) :

4.5 The board holds that the opposition division took the relevant factors of late-filing and *prima facie* compliance with the requirements of the EPC into consideration in a reasonable way. It did not exceed the proper limits of its discretion. It is not for the board to review all the facts and circumstances of the case as if it were in the opposition division's place and to decide whether or not it would have exercised the discretion in the same way. Instead, the role of the board is to identify whether such exercise of discretion by the opposition division was arbitrary, unreasonable or was not carried out according to the

right principles (see G7/93, point 2.6; Case Law of the Boards of Appeal of the EPO, 10th edition, V.A.3.4.1).

4.6 The opposition division has discretion to not admit late-filed requests under Rule 116(1) and (2) EPC. The opponent had raised the objection under Article 100 b) EPC, which was allegedly addressed by the main request filed during the oral proceedings, in the notice of opposition. The summons to oral proceedings similarly referred to this objection. Consequently, the main request submitted at the oral proceedings was not justified by an unexpected turn of events and was late-filed. In this procedural situation, it is appropriate to apply the criterion of *prima facie* allowability of the amended request.

4.7 The appellant argued that the feature from the description added to claim 1, namely "the squeezing and stretching of the signature along a time axis depending on the speed", was also disclosed in prior-art document Q4. In particular, Q4 described how sound emitted from a moving source appeared to increase in frequency as the source approached the listener and to decrease in frequency as the source moved away. Thus, the respondent must have been aware of the feature added to claim 1 and, consequently, this amendment would not give rise to any procedural inefficiency.

The board disagrees. In general, an opponent should be familiar with the subject-matter of the granted and opposed claims. However, it goes too far to expect the opponent to be prepared for amendments involving features from the description. The fact that related features might be disclosed in a prior-art document submitted by the opponent does not negate these principles. Furthermore, the board agrees with the

respondent that the teaching in Q4 is not directly related to the feature added to claim 1.

- 4.8 The appellant stated that it could not have carried out any amendment based on dependent claims because the granted patent did not include any dependent claims. Thus, its possibilities for amendments were unfairly limited.

The board notes that the sole responsibility for the text of the patent lies with the appellant, the then applicant (Article 113(2) EPC).

- 4.9 The appellant submitted that the opposition division erred when deciding on the *prima facie* allowability of amended claim 1. It submitted extensive substantive arguments.

The board holds that the appellant's objections do not relate to any incorrect exercise of discretion by the opposition division in its *prima facie* assessment of the allowability of claim 1 but to the complete substantive analysis of compliance with Articles 84 and 123(3) EPC.

As regards the *prima facie* assessment, it is not unreasonable to come to the conclusion that the amendment to claim 1 leads to issues with Articles 84 and 123(3) EPC. In particular, the amended wording of claim 1 can, *prima facie*, reasonably be interpreted according to the two interpretations a) and b) mentioned in the minutes of the first-instance oral proceedings and in the decision under appeal. The fact that a complete examination, taking into consideration the teaching of the description and the common general knowledge of the skilled person, might lead to a different outcome does not make the *prima facie* analysis unreasonable.

4.10 Consequently, the decision of the opposition division not to admit the main request was not affected by an error in the use of discretion.

Criterion b) :

4.11 According to Article 12(1) RPBA, appeal proceedings are to be based, *inter alia*, on the decision under appeal and the minutes of the oral proceedings before the opposition division. It follows from this that the minutes and, in particular, the issues discussed in the course of the oral proceedings form part of the circumstances of the appeal case.

4.12 According to the minutes, sections 4.1 to 4.5, 5 and 6, the compliance of the then main request with the requirements of Article 100 b) EPC was discussed. Subsequently, the opposition division formed the opinion that these requirements were not met. Thereupon, the appellant submitted an amended main request, which essentially corresponds to the current main request.

In this particular situation, the board holds that the *prima facie* compliance of the main request with the provisions of Article 100 b) EPC forms part of the circumstances of the appeal case that are to be considered for the purpose of applying Article 12(6) RPBA.

4.13 Throughout the first-instance proceedings the respondent argued that the compensation for speed, as claimed, required the speed of the train to be known, but that the patent did not disclose how the speed was to be determined.

4.14 The appellant argued that it was common general knowledge that the speed of a train could be determined by taking the time derivative of the amplitude envelope

of the signature, thereby citing paragraph 21 of patent document Q3 as evidence.

The board notes that as a rule patent documents do not represent common general knowledge. Additionally, paragraphs 21 and 33 of Q3 do not only disclose the commonly known dependency between distance and speed, the latter corresponding to the first derivative of the former, but also describe further specific details, which do not form part of the common general knowledge, e.g. that the high-frequency spectrum is analysed.

Furthermore, according to page 4, lines 12 and 13, of the description of the application as filed, a single signature alone cannot be used to determine the speed of the train.

- 4.15 The appellant argued that, according to decisions T 412/09 and T 51/87, a patent specification (in this case document Q3) could be viewed as part of the common general knowledge.

This argument is not convincing. These decisions mention specific conditions (that teaching be disclosed in series of patent specifications or belong to a brand new field of research), which are not met in the case at hand. These conditions were not addressed by the appellant.

- 4.16 The appellant pointed further to document Q5.

However, this document does not disclose any techniques for determining the speed.

- 4.17 For these reasons, the invention as set out in claim 1 does not, *prima facie*, meet the requirements of Article 100 b) EPC.

- 4.18 The appellant argued that the reasoning for not admitting the main request set out by the opposition

division did not apply, thereby referring to decision T 942/12.

The board notes that this decision does not deal with any related issues. Instead, it seems that decision T 945/12 was meant.

This decision states, *inter alia*, that a board may take into account additional facts and different circumstances while exercising its discretion under the then Article 12(4) RPBA 2007.

The board notes that Article 12(4) RPBA 2007 was replaced, in part, by the currently applicable Article 12(6) RPBA 2020. It is explicitly stated therein that the circumstances of the appeal case may justify the admittance of a request which was not admitted by the department of first instance. This aspect is addressed in detail in the present decision.

4.19 In the board's view, the mere fact that the parties submitted in writing substantive arguments regarding the requirements of Article 100 b) EPC does not justify the admittance of the main request. Otherwise, a party could force a board to admit a request not admitted by the department of first instance by submitting substantive arguments on appeal. This would not be in accordance with the main provision of Article 12(6), first sentence, RPBA - namely that a board is not to admit requests which were not admitted in the proceedings that led to the decision under appeal.

4.20 To sum up, the main request in the appeal was not admitted by the opposition division and, *prima facie*, does not resolve an issue which was raised in the notice of opposition and on which the opposition division presented a negative opinion before and during the first-instance oral proceedings. In this situation

the board holds that the circumstances of the appeal case do not justify the admittance of the main request.

- 4.21 Consequently, the main request was not admitted into the appeal proceedings under Article 12(6), first sentence, RPBA.

Corrected version of the main request

5. Admission

- 5.1 This request was submitted after the summons to oral proceedings had been issued. Hence, its admission is governed by the provisions of Article 13(2) RPBA, which stipulates that any amendment to a party's appeal case made after notification of a summons to oral proceedings must not, in principle, be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

- 5.2 The appellant argued that no new matter was added to the proceedings, no new arguments were submitted and the respondent had plenty of time to deal with this request.

- 5.3 The board is not convinced. Claim 1 of this request is the same as claim 1 of the main request. The amendments of the description do not play a decisive role. In the absence of any amended claims or new arguments, the observations set out above with regard to the main request apply similarly to the corrected version of the main request.

In this situation, no exceptional circumstances are apparent.

- 5.4 For these reasons, the board did not admit the corrected version of the main request under Article 13(2) RPBA.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka

Decision electronically authenticated