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**Datasheet for the decision
of 9 September 2022**

Case Number: T 1215/20 - 3.5.03

Application Number: 09795832.6

Publication Number: 2394458

IPC: H04W24/08

Language of the proceedings: EN

Title of invention:

Method and apparatus for estimating a quantity of mobile terminals per quality of service class identifier

Applicant:

Lenovo Group Limited

Headword:

Public availability of cited prior art/LENOVO

Relevant legal provisions:

EPC Art. 111(1), 113(1)
EPC R. 103(1)(a), 111(2)
RPBA 2020 Art. 11, 12(8)

Keyword:

Decision in written proceedings - (yes): no oral proceedings necessary or appropriate

Remittal - (yes): fundamental deficiency in examination proceedings

Reimbursement of the appeal fee - (yes): equitable by reason of a substantial procedural violation

Decisions cited:

J 0007/82, T 0763/04, T 1557/07, T 1469/10, T 2239/15,
T 2012/17, T 1051/20



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Case Number: T 1215/20 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 9 September 2022

Appellant:
(Applicant)

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 13 January 2020
refusing European patent application
No. 09795832.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: J. Eraso Helguera
C. Almberg

Summary of Facts and Submissions

- I. The appeal was lodged against the decision of the examining division to refuse the present European patent application for lack of inventive step (Article 56 EPC) with respect to the independent claims of each of a main request and two auxiliary requests and for lack of clarity (Article 84 EPC) with respect to the independent claims of the auxiliary requests.
- II. During the examination proceedings, the examining division referred to the following document:
- D1:** Huawei, "Introduction of QoS measurements",
3GPP TSG RAN WG2 #64, R2-086821, November 2008.
- III. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of any of the three claim requests subject to the decision under appeal and re-submitted with the statement of grounds of appeal (i.e. **main request** and **first and second auxiliary requests**). If the main request could not be granted, the appellant requested oral proceedings. In view of the reasons below, it is not necessary to reproduce the wording of these claim requests.

Reasons for the Decision

1. *Substantial procedural violation*
- 1.1 The right to be heard under Article 113(1) EPC encompasses the right of a party to have its comments

considered in the written decision (see e.g. T 2012/17, Reasons 3.1; T 763/04, Reasons 4.3 and 4.4). Although a decision does not have to address each and every argument of a party in detail, it must comment on the crucial points of dispute to give the losing party a fair idea of why its arguments were not considered convincing (cf. T 2012/17, Reasons 3.1; T 1557/07, Reasons 2.6).

- 1.2 In the case at hand, the question of public availability of document **D1** is a crucial point of dispute. This is because the only reason for the refusal of the main request, i.e. lack of inventive step, hinges on the validity of D1 as starting point.
- 1.3 In its statement of grounds of appeal, the appellant contended that D1 was a "discussion contribution" for a discussion meeting of the 3GPP TSG RAN WG2 in Prague which had allegedly taken place in November 2008. 3GPP meetings in general were private meetings: a registration was mandatory and an attendance was only possible for representatives of the member organisations of the 3GPP. Thus, any kind of those meetings could not be considered to be held in public or to be open to the public. Further, it was not common to publish contributions on the 3GPP FTP-server prior to or simultaneously with a meeting, contrary to what had been allegedly stated by the examining division. The appellant concluded that D1 could not be regarded as prior art within the meaning of the EPC for the present application. In the absence of any relevant prior art, the independent claims had to be considered novel and inventive.
- 1.4 These allegations only constitute a minor development of the arguments already submitted in point III of the

written response to the summons to oral proceedings issued by the examining division (cf. pages 4 and 5). In said response, the applicant contended that D1 did not form prior art as it had not been available to the public before the priority date of the present application. Specifically, it submitted, *inter alia*, that:

"2. The only date stated in D1 is 10 to 14 November 2008, which is a meeting of the 3GPP group. D1 actually bears no evidence that it has been publicly available.

3. Further, the meeting on 10 to 14 November 2008 was an internal meeting of the 3GPP cannot be considered public as only participants of the 3GPP standardization committee were attending."

1.5 According to the appellant, the examining division allegedly stated that it was common to publish contributions on the 3GPP FTP-server prior to or simultaneously with a meeting (statement of grounds of appeal, page 4, last paragraph).

However, the file contains no record of such statement. The board can only speculate whether or not any such statement was made during the telephone conversation held on 23 October 2019. In any event, it was not mentioned in the corresponding minutes. In fact, there is no evidence at all on file that the examining division ever considered the question of public availability of D1. In particular, the decision under appeal does not address the applicant's arguments in this respect (and there was also no communication issued in that regard). It follows that the examining division did not respect the appellant's right to be

heard as to the matter of public availability of document D1.

- 1.6 However, the examining division could and should have explained how it assessed the public availability of document D1. The board takes note of the specific indications compiled in the valid version of the Guidelines for Examination (cf. Guidelines G-IV, 7.6 "Standards and standard preparatory documents" in the applicable version of November 2019), and the available case law on the public availability of technical standards, such as T 1469/10, Reasons 2.3 (relating to 3GPP standards: "... the respective dates ('timestamps') indicated on the 3GPP document lists reliably correspond to the dates on which a certain document was uploaded to the 3GPP file server and thus was available on the server to be accessed by the public ..."), or e.g. T 2239/15 (see Catchword). Besides, if the examining division retrieved the 3GPP document from one of the EPO's in-house databases mentioned in the Guidelines, rather than from the Internet, such databases would usually record the specific date in which the document was downloaded from a 3GPP server.
- 1.7 As lack of inventive step, starting from D1, was the sole reason for rejecting the main request, the failure to address the appellant's arguments in the decision under appeal amounts to a substantial procedural violation. To review the inventive-step reasoning in the decision under appeal, the board would be forced to perform an entirely new evaluation of the matter of public availability of D1. This would however go against the primary object of appeal proceedings to review the decision under appeal in a judicial manner (cf. Article 12(2) RPBA 2020).

2. *Reimbursement of the appeal fee (Rule 103(1)(a) EPC)*

2.1 The principle of the right to be heard under Article 113(1) EPC is so fundamental that the present denial of it with respect to the *ratio decidendi* of the appealed decision constitutes - in itself - a "substantial procedural violation" rendering reimbursement of the appeal fee equitable pursuant to Rule 103(1)(a) EPC. The right to be heard self-evidently also applies to the public availability of evidence related to assessing novelty and inventive step. Furthermore, there is a manifest causal link between the above substantial procedural violation and the necessity of filing an appeal against the examining division's decision.

2.2 Hence, even if the appellant has not requested reimbursement of the appeal fee, such reimbursement is ordered on the board's own motion in accordance with Article 114(1) EPC (cf. J 7/82, OJ EPO 1982, 391, Reasons 6).

3. *Remittal to the examining division (Article 111(1) EPC and Article 11 RPBA 2020)*

3.1 Pursuant to Article 111(1) EPC, remittal for further prosecution is at the discretion of the board. Whereas Article 11 RPBA 2020 imposes a requirement of "special reasons" for remitting, fundamental deficiencies which are apparent in the first-instance proceedings, as a rule, constitute such reasons.

3.2 Accordingly, the board has decided to set aside the appealed decision and to remit the case to the examining division for further prosecution on the basis of the three claim requests on file.

4. *Decision in written proceedings*

4.1 The appellant requested oral proceedings in the event that the main request could not be granted (cf. point III above).

4.2 The board's decision to set aside the decision under appeal and to remit the case to the examining division is not adverse in substance to the appellant. A hearing before the board solely to discuss whether or not the case should be remitted is consequently not deemed to be necessary or appropriate (see e.g. T 1051/20, Reasons 4.2, and the decisions cited therein).

4.3 Therefore, the decision may be handed down in written proceedings without holding oral proceedings (Article 12(8) RPBA 2020).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is to be reimbursed in full.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated