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**Datasheet for the ancillary decision
of 16 May 2022**

Case Number: T 1891/20 - 3.5.03

Application Number: 14824813.1

Publication Number: 3087767

IPC: H04W8/18

Language of the proceedings: EN

Title of invention:

Method for accessing a service and a corresponding device

Patent Proprietor:

Thales Dis France SAS

Opponents:

IDEMIA France
Giesecke+Devrient Mobile Security GmbH
Giesecke & Devrient GmbH

Headword:

Request for correction of the minutes/THALES

Relevant legal provisions:

EPC R. 4(1), 124(1)
RPBA 2020 Art. 6(4)

Keyword:

Correction of the minutes - (no): present minutes include essentials of the oral proceedings and the parties' relevant statements

Decisions cited:

R 0002/12, R 0006/14, R 0007/17, T 0212/97, T 0642/97,
T 0231/99, T 0468/99, T 0263/05, T 0774/05, T 1721/07,
T 0128/08, T 1735/08, T 0008/13, T 0613/14, T 1934/14,
T 0888/17

Catchword:

If a party considers that the "essentials of the oral proceedings" or "relevant statements" within the meaning of Rule 124(1) EPC are incorrect or missing in the minutes of oral proceedings, they must file a request for correction of the minutes in the shortest time possible after their receipt. This ensures that the relevant facts and submissions are still fresh in the minds of the members of the deciding body and, if applicable, the other party or parties (Reasons 9.2).

Waiting for the written decision before submitting a request for correction of the minutes is incompatible with a party's obligation to request correction of the minutes in the shortest time possible after their receipt (Reasons 9.3).



Beschwerdekammern

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Case Number: T 1891/20 - 3.5.03

A N C I L L A R Y D E C I S I O N
of Technical Board of Appeal 3.5.03
of 16 May 2022

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Composition of the Board:

| | |
|-----------------|-------------------|
| Chair | K. Bengi-Akyürek |
| Members: | N. Obrovski |
| | J. Eraso Helguera |

Summary of Facts and Submissions

- I. By submission dated 3 February 2022, the respondent (patent proprietor) requested a correction of the minutes of the oral proceedings held before the board on 15 November 2021.
- II. The minutes of the oral proceedings were issued on 19 November 2021 and the board's written decision on 9 December 2021. Hence, the respondent's request for correction was submitted more than **two months** after notification of the minutes of the oral proceedings, and about **one and a half months** after notification of the written decision.
- III. By submission dated 21 February 2022, appellant II and the intervener ("opponents 2 and 3") requested that the respondent's request for correction be refused as inadmissible or as unallowable.
- IV. The respondent stated in its request for correction that some relevant points had not been mentioned in the minutes, contrary to what was required according to decision T 263/05.
- V. The respondent's main arguments are as follows:
 - Opponent 2 and opponent 3 had requested a "translation from German to English" but no translation from English to German had been required. This question had confused the interpretation service. Although the respondent had in the oral proceedings referred to the Guidelines for Examination in the EPO according to which a party did not have the right to speak in one

language and hear in *another*, the board had only stated that the Boards of Appeal were not bound by those Guidelines. The board, however, had not interrupted to deliberate on the respondent's argument. Moreover, the section of the Guidelines which had been referred to by the respondent contained a reference to T 774/05, and the board had not justified why it had departed from this decision. "This question" should have been mentioned in the minutes because it had been raised by one of the parties and because it had required a decision by the board. The latter for the reason that opponent 2 and opponent 3 could have been forced to speak in English or could have been prevented from speaking at all.

- Although opponent 2 and opponent 3 had been presented as *different* parties (and one of them as an intervener), they had had a common representative who had filed multiple written submissions in the name of both. The respondent had requested in the oral proceedings to clarify whether opponent 2 and opponent 3 should be treated as *one* party or *two* parties and, in the latter case, whether a common written submission filed in the name of two different parties - with different rights in terms of arguments and evidence they could rely on - would be accepted. If not, the "intervention should be deemed inadmissible". This had been an important question and should therefore appear in the minutes.

- During the discussion of the patentability of the main request, the respondent had stated in the oral proceedings that the objection under Article 123(2) EPC, which had been raised by the board in its

preliminary opinion, had never been raised before. It had further indicated that "the right to be heard has not been respected by the Board by the non-admittance of the new auxiliary request". This should also be included in the minutes.

- The respondent had made arguments as regards the inventive-step discussion which had been an exercise of the right to be heard and should therefore be present in the minutes. Moreover, the board had not invited the other parties to comment on these arguments, thereby not duly responding to them.

VI. In support of its correction request, the respondent submitted a written declaration by one of the respondent's representatives who were present during the oral proceedings before the board.

VII. In a communication under Rule 100(2) EPC dated 3 March 2022, the board provided the parties with its preliminary opinion on the request for correction of the minutes. The respondent replied thereto with submission dated 5 May 2022, and appellant II and the intervener with submission dated 10 May 2022.

Reasons for the Decision

1. *Ancillary decision*

1.1 The board first notes that, if the request for correction of the minutes had been made *before* the issuing of its written decision of 15 November 2021 terminating the appeal proceedings, the board would have considered that request in that written decision

(cf. T 888/17, Reasons 2; T 1721/07, Reasons 15 to 19).

1.2 Under the given circumstances, where the request for correction of the minutes was only made *afterwards*, the board considers it appropriate to deal with the request for correction in a decision ancillary to the board's written decision of 15 November 2021 (cf. ancillary decisions relating to T 128/08 of 5 November 2009, T 1735/08 of 27 September 2012 and T 1934/14 of 8 October 2018).

1.3 The board considers the present decision to be ancillary in that it cannot be challenged under Article 112a(1) EPC separately from the board's written decision of 15 November 2021 (see T 613/14, Reasons 6.1, with regard to the decision on a request for correction of the minutes of oral proceedings before an opposition division and Article 106(1) EPC; see also T 231/99, Reasons 1).

1.4 Contrary to a board's communication, a decision is taken by *all* members of the board. Dealing with the request for correction of the minutes in the form of an "ancillary decision" rather than in the form of a communication (see, for example, the board's communication dated 12 April 2018 in case T 692/12) also takes account of the fact that reference to the unanimous recollection of events by all three members of the board is made in the present decision.

2. *Legal framework*

2.1 Pursuant to Rule 124(1) EPC, minutes of oral proceedings shall be drawn up, containing the essentials of the oral proceedings and the relevant statements made by the parties.

2.2 Under Article 6(4) RPBA 2020, the minutes of oral proceedings shall be drawn up by a member of the deciding board or the Registrar, as the Chair may designate. According to the *travaux préparatoires* to this provision, "the minutes drawn up by the Board record the essential procedural acts, for example the parties' requests and the submission of documents during the oral proceedings. However, arguments presented by the parties during the oral proceedings are generally not included in the minutes, although they may form part of the board's written decision" (CA/3/19, page 22).

2.3 It is in the discretion of the minute-writer what to consider "essential" or "relevant" (T 212/97, Reasons 2.2; T 642/97, Reasons 9.3; R 7/17, Reasons 23). A summary of the arguments made by the parties during the oral proceedings is usually not included in the minutes (T 1721/07, Reasons 17; see also T 263/05, Reasons 8.7). Moreover, the board is responsible for deciding upon what is necessary to be recorded in the minutes, not the parties (T 468/99, Reasons 1.5; T 1721/07, Reasons 15).

2.4 Furthermore, it is expected from parties to submit a request for correction of the minutes *promptly* after their receipt (cf. R 6/14, Reasons 7).

3. *The respondent's requests*

3.1 The respondent referred to a part of a sentence in catchword IV of T 263/05, according to which the "minutes of oral proceedings before the Boards of Appeal should record the requests of the parties on which a decision of the Board is required".

3.2 It is, however, apparent from T 263/05, Reasons 8.5, that the requests referred to in this excerpt are "the formal written requests of the parties on which the parties at the close of proceedings require a formal decision" [...] "such as the dismissal of the appeal, setting aside of the decision under appeal, revocation of the patent or maintenance of the patent in amended form, or other procedural requests such as the remittal of the case or requests relating to appeal fees or costs". What the respondent refers to as "requests" in its request for correction are no such requests.

3.3 Moreover, at the beginning of the oral proceedings held on 15 November 2021, the Chair read out the parties' requests, and the parties explicitly confirmed them. As stated in the minutes, the respondent's requests were the following:

"The patent proprietor requested that the appeals and the intervention be rejected as inadmissible or dismissed as unallowable or, alternatively, that the patent be maintained on the basis of the claims of the auxiliary request filed with the submission dated 6 July 2021. They further requested a different apportionment of costs, the exclusion from file inspection of Annexes 1-3 to their reply to the notice of intervention and a partial reimbursement of their appeal fee."

3.4 The only amendment of the respondent's requests during the oral proceedings concerned the request to exclude Annexes 1 to 3 from file inspection. As noted in the minutes, this request was amended - in line with the appellants' view on this matter - to a request to exclude Annexes 3 and 4 from file inspection.

3.5 When asked by the Chair at the end of the oral proceedings about its requests, the respondent confirmed that it maintained its requests as previously stated. The respondent did not mention any additional requests.

4. *Languages and interpretation*

4.1 As to the question related to interpretation, the respondent seems to have partly misunderstood the situation, including what was discussed during the oral proceedings.

4.2 Contrary to the respondent's allegation in point 1 of its request for correction, the request for interpretation "from German to English" was not made by appellant II and the intervener, but rather by the respondent itself, in its submission dated 14 October 2021. This request was granted.

4.3 At the oral proceedings before the board, the representative of appellant II and the intervener asked why no interpretation from English to German was provided to them. The board referred to their submission dated 29 September 2021, in which they had stated that they would speak in German but that they did not need interpretation from English to German. The representative acknowledged this and was satisfied with not being provided with an interpretation from English to German.

4.4 This also corresponds to the overview of the translation arrangements for the oral proceedings which were issued to the parties on 18 October 2021 (cf. EPO Form 3018).

- 4.5 The written statement in the declaration of the respondent's representatives according to which the respondent allegedly requested the board "to decide in which language O2 and O3 are intended to speak" does not correspond to the recollection of events by the members of the board. Rather, according to their unanimous recollection, the respondent did not make any such request for a decision by the board. Moreover, the representative of appellant II and the intervener only spoke in the language in which he had previously announced to speak (i.e. in German), which was translated for the representatives of the respondent, in line with its previous interpretation request (i.e. to English).
- 4.6 For the sake of completeness, the board points out that it did not deviate from decision T 774/05 either. In that case, a representative who was a German native speaker had filed all written submissions in English, had requested interpretation from German to English, and had then made a belated request to speak German in the oral proceedings, which was not submitted within the time limit stipulated in Rule 2(1) EPC 1973 (Rule 4(1) EPC). The request for interpretation from German to English had also been made for the benefit of an accompanying person, whom the board did not allow to speak during the oral proceedings.
- 4.7 The facts of the present case are entirely different. Firstly, the announcement of appellant II and the intervener to speak German in their submission dated 29 September 2021 was not late. Secondly, they did not make any request for interpretation at all, let alone one for the benefit of an accompanying person who was not allowed to speak.

- 4.8 The board further notes that the respondent replied to the announcement of appellant II and the intervener to speak German by requesting interpretation from German to English in its submission dated 14 October 2021 - without in any way criticising the announcement of appellant II and the intervener.
- 4.9 In its submission dated 3 March 2022, the respondent indicated that it would in its view not have been problematic if appellant II and the intervener had not only spoken German, but had also listened in German, as they would then have spoken and listened in the same language. However, as correctly pointed out by appellant II and the intervener in their submission dated 10 May 2022, this would only have made it necessary to have *additional* interpretation, namely from English to German. Clearly, Rule 4 EPC does not oblige a party to request interpretation services which they do not deem necessary themselves - regardless of the language in which they intend to speak.
5. *Opponent 2 and intervener as different parties*
- 5.1 The respondent stated in its correction request to have raised the question in the oral proceedings whether opponent 2 and the intervener had to be treated as one or two parties, and whether they could in the latter case be represented by a common representative. The respondent further stated that this had concerned the admissibility of the intervention (see point 2, fourth paragraph, of the correction request).
- 5.2 In its submission dated 5 May 2022, the respondent then said that "the question was not the admissibility of the intervention, but the ability of the common representative to act on behalf of the two parties with

different roles". This is not only in contradiction to its own previous statement in the correction request, but also in contradiction to the unanimous recollection of the members of the board, according to which the question of common representation was only raised by the respondent in the context of the admissibility of the intervention.

5.3 It is stated in the minutes of the oral proceedings that the admissibility of the intervention was discussed with the parties. The parties' arguments presented during the oral proceedings are, on the other hand, generally not included in the minutes (see points 2.2 and 2.3 above) but may form part of the board's written decision. In that regard, the board refers to Reasons 1.1 to 1.5 of its written decision.

5.4 Moreover, as indicated in Reasons 1.5 of the written decision, the admissibility of the intervention did not have any bearing on the outcome of the appeal proceedings.

6. *Alleged new objection in the board's preliminary opinion*

6.1 The respondent stated that it had argued in "the discussion of the patentability of the claim 1 of the main request" that the objection under Article 123(2) EPC in the board's preliminary opinion under Article 15(1) RPBA 2020 had not been raised before. In its correction request, it provided arguments why this was supposedly the case. *Inter alia*, it alleged that the objection referred to by the board was not related to an intermediate generalisation, contrary to the opponents' previous objection as regards added subject-matter.

- 6.2 Firstly, the board points out that the main request was considered unallowable due to a **lack of inventive step**, and not due to added subject-matter. This is reflected both in the minutes and in the written decision.
- 6.3 Secondly, it is stated in the minutes of the oral proceedings that both the allowability of the main request and the admittance of the auxiliary request were discussed with the parties. According to the unanimous recollection of the members of the board, as to the allegedly new objection under Article 123(2) EPC the respondent essentially repeated in the oral proceedings the general arguments as set out in the written submission dated 6 July 2021. The detailed reasons contained in the respondent's request for correction have been presented for the first time with that correction request. In the oral proceedings before the board, the respondent did not provide these reasons.
- 6.4 Thirdly, the board notes that the allegation that the objection under Article 123(2) EPC in the board's preliminary opinion pursuant to Article 15(1) RPBA 2020 was new and did not relate to an intermediate generalisation is in contradiction to what is explicitly stated in point 6.3.5 thereof, namely that the "omission of steps 26 and 28 [...] in the recitation of 'ordered steps' of claim 1 amounts to an unallowable intermediate generalisation."
- 6.5 Fourthly, the parties' arguments presented during the oral proceedings are generally not included in the minutes (see points 2.2 and 2.3 above) but may form part of the board's written decision. In this regard, the board refers to Reasons 3.3 and 3.4 of the written decision on the allowability of the main request, and

to Reasons 4.1 and 4.2 of the written decision on the admittance of the auxiliary request.

7. *Alleged statement as to the right to be heard*

7.1 The respondent alleged to have stated during the oral proceedings that "the right to be heard has not been respected by the Board by the non-admittance of the new auxiliary request".

7.2 This is in contradiction to the unanimous recollection of the members of the board. The respondent did not at any time raise any objection related to any alleged procedural defect.

7.3 Rather, the respondent had argued during the discussion before the deliberation by the board that it followed, in its view, from the right to be heard that the auxiliary request should be admitted into the proceedings, because of the allegedly "new" objection as to added subject-matter raised by the board in its preliminary opinion under Article 15(1) RPBA 2020, to which they had reacted by filing the auxiliary request.

7.4 Presenting such an argument in favour of the admittance of a claim request does, however, not qualify as an objection under Rule 106 EPC and is, in fact, not recognisable as any kind of objection. Moreover, after the board had deliberated and had announced its conclusion not to allow the main request and its decision not to admit the auxiliary request into the proceedings under Article 13(2) RPBA 2020, the respondent did not make any reference whatsoever to the "right to be heard" or any other procedural issue.

- 7.5 In point 4 of its submission dated 5 May 2022, the respondent claims that it had been "evident that the respondent considers that the right to be heard has not been respected" when the board did not admit the auxiliary request. Therefore, it had considered it "useless to repeat the objection after a decision was taken".
- 7.6 However, as stated before, the respondent did not raise any objection at all, neither *before* nor *after* the board announced its decision not to admit the auxiliary request into the appeal proceedings. The board reiterates in this context that "it is the duty of a party to check whether its objection to a fundamental procedural defect occurring during the oral proceedings has been recognised by the Board and will be dealt with" and that "if a party is really convinced that a violation of its right to be heard has occurred during the oral proceedings the subsequent objection must be clearly raised as such, and not as a mere aside, so that it will oblige the Board of Appeal to react, and require this to be recorded in the minutes in accordance with Rule 124 EPC, at least at a party's request" (R 2/12, Reasons 1.2.1).
- 7.7 The board notes that opponent 2 and the intervener confirmed in point 3 of their submission dated 21 February 2022 and in point 17 of their submission dated 10 May 2022 that the respondent did not raise any objection under Rule 106 EPC during the entire oral proceedings before the board. They also offered the hearing of witnesses to support their statement.
- 7.8 The board further notes that its discretionary decision not to admit the auxiliary request into the appeal proceedings was based on the absence of cogent reasons

justifying exceptional circumstance and on a *prima facie* **lack of inventive step** (see Reasons 4.1.4 and 4.1.5 of the written decision). Hence, the allegedly "new" objection as to added subject-matter had no bearing on the outcome of the decision not to admit the auxiliary request. Moreover, as indicated in point 6.4 above, the objection under Article 123(2) EPC relating to an intermediate generalisation was not new either.

8. *Respondent's arguments on inventive step*

8.1 The respondent stated that its arguments brought forward at the oral proceedings on inventive step had been an exercise of its right to be heard and should therefore be recorded in the minutes. However, most arguments presented during the oral proceedings before a Board of Appeal can be considered as an exercise of the right to be heard. Nevertheless, the parties' arguments are generally not included in the minutes (see points 2.2 and 2.3 above) but may form part of the board's written decision. In that regard, as to the respondent's relevant arguments, the board refers again to Reasons 3.3 of the written decision.

8.2 The board does not share the respondent's view that the appellants supposedly did not have the opportunity to comment on the respondent's arguments on inventive step. The Chair explicitly provided both parties with the opportunity to comment, including on the matter of inventive step. At the end of the oral proceedings, the Chair asked both parties again whether they wished to make any further comments, and both parties denied this. This is reflected in the minutes of the oral proceedings.

8.3 The board notes that opponent 2 and the intervener also stated in point 20 of their submission dated 21 February 2022 that they had multiple opportunities to comment. They also offered the hearing of witnesses to support their statement.

9. *Timing of the request for correction of the minutes*

9.1 Parties are obliged to submit a request for correction of the minutes of oral proceedings promptly after receipt of the minutes (R 6/14, Reasons 7; see also point 2.4 above). The board understands this to require an immediate action from a party, i.e. to submit a request for correction of the minutes in the shortest time possible after their receipt.

9.2 Hence, if a party considers that the "essentials of the oral proceedings" or "relevant statements" within the meaning of Rule 124(1) EPC are incorrect or missing in the minutes of oral proceedings, they must file a request for correction of the minutes in the shortest time possible after their receipt. This ensures that the relevant facts and submissions are still fresh in the minds of the members of the deciding body and, if applicable, the other party or parties.

9.3 The contents of the written decision following oral proceedings do not have any bearing on whether the minutes of oral proceedings are incorrect or incomplete. The respondent therefore errs when stating in its submission dated 10 May 2022 that it is "compulsory" to wait for the written decision before submitting a request for correction of the minutes. Rather, such conduct suggests that a request for correction of the minutes may be embedded in litigation tactics, the purpose of which may not be limited to

ensuring that the minutes are indeed correct and complete. In any case, such conduct is incompatible with a party's obligation to request correction of the minutes in the shortest time possible after their receipt.

- 9.4 The respondent's further arguments that the Christmas holidays had been in between the receipt of the written decision and the filing of the request for correction, and that they also had to prepare and provide reasons as to the request for correction, do not justify the very late filing of that request either.
- 9.5 In conclusion, filing the request for correction of the minutes more than two months after notification of the minutes was not in line with the respondent's obligation to submit a request for correction of the minutes of oral proceedings promptly after their receipt, i.e. in the shortest time possible.
- 9.6 For the sake of completeness, the board points out that minutes may also be corrected *ex officio* (cf. T 231/99). Hence, while a party's request for correction of the minutes may be refused due to its late filing, a late-filed request for correction does as such not prohibit the competent body from correcting the minutes following that request.

Order

For these reasons it is decided that:

The request for correction of the minutes of the oral proceedings is refused.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated