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**Datasheet for the decision
of the Enlarged Board of Appeal
of 6 June 2016**

Case Number: R 0004/14
Appeal Number: T 1531/10 – 3.5.03
Application Number: 99957131.8
Publication Number: 1068753
IPC: H04Q 7/32
Language of the proceedings: EN

Title of invention:
COMMUNICATION METHOD AND APPARATUS

Patent Proprietor:
Aussie L.L.C. Pty Ltd

Opponents:
INSIDE CONTACTLESS
Monitise Group Limited
NOKIA UK Limited
Vodafone Group PLC

Headword:
Petition for review/Aussie

Relevant legal provisions:
EPC Art. 112a, 113
EPC Rule. 106, 107, 109(2)(a)
RPBA Art. 13

Keyword:

Petitioner's subjective surprise at Board of Appeal's actions is not relevant to an objective review of its decision.

Prima facie consideration of allowability when deciding on admissibility of a claim request, discretion to admit is governed by Article 13 RPBA.

Petition for review - clearly unallowable

Decisions cited:

T 0892/92, T 0763/04, T 0246/08, J 0007/82, R 0001/13

Catchword:

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Case Number: R 0004/14

D E C I S I O N
of the Enlarged Board of Appeal
of 6 June 2016

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Decision under review: **Decision of the Technical Board of Appeal
3.5.03 of the European Patent Office of
16 October 2013.**

Composition of the Board:

Chairman: W. van der Eijk
Members: D. Rogers
A. Ritzka

Summary of Facts and Submissions

- I. The petition for review concerns the decision T 1531/10 of the Technical Board of Appeal 3.5.03 of 16 October 2013 to dismiss the Petitioner's appeal against the interlocutory decision of the Opposition Division to revoke European Patent No. 1068753.
- II. The Petitioner (the patent proprietor) filed the petition and paid the petition fee, both acts being carried out within the applicable time limits. The petition is based only on the ground in Article 112a(2)(c) EPC, that is that a fundamental violation of Article 113(1) EPC, (right to be heard), occurred in appeal proceedings.
- III. The Opposition Division found that claim 1 of the main request (which had been amended during the opposition proceedings) complied with Articles 84, 123(2) and 100(b) EPC, (sufficiency of disclosure), but held that its subject matter did not involve an inventive step. Claim 1 of the auxiliary request was held not to comply with Article 123(2) EPC.
- IV. The Petitioner appealed and requested that the decision of the Opposition Division be set aside and that the patent be maintained upon the basis of a Main Request (identical to the main request that was before the Opposition Division), or upon the basis of an Auxiliary Request which it filed with its Grounds of Appeal. The subsequent appeal proceedings, to the extent relevant to the petition proceedings, are summarized below.

- V. The Board of Appeal summoned the parties to what was to be the first oral proceedings before it and in the attached communication, (the "First Communication"), indicated its view that, contrary to the finding of the Opposition Division, the following feature of claim 1 of the Main and Auxiliary Requests was unclear (Article 84 EPC):

"...so that a further identification or authentication process is available through the network but not subject to approval from the network provider".

The feature will hereafter be referred to as the "Approval Feature".

- VI. In the First Communication the Board also identified some further Article 84 EPC clarity issues with claim 1 of the Auxiliary Request. These concerned the following features of the claim:

"...in the event that the external interrogation signals contain information which appears to the intermediary processor not to be for the purpose of interrogating the existing subscriber identification module"; and

"...active means to intercept any external interrogation signal".

- VII. In response to the First Communication the Appellant filed Auxiliary Requests 1 to 4 to replace its Auxiliary Request.

- VIII. At the first oral proceedings before the Board on 21 June 2013, an extensive discussion of the grounds for opposition under Article 100(b) EPC, sufficiency of disclosure, took place, which included a discussion of the meaning of the Approval Feature . In addition novelty and inventive step of claim 1 of the Main Request and the admissibility of Auxiliary Requests 1 to 4 were discussed. No decision, other than to admit Auxiliary Request 4 into the proceedings, was reached in the first oral proceedings. The Board did, however, express the view that the Main Request did not involve an inventive step, that Auxiliary Requests 1 to 3 were not to be admitted into the proceedings, and that claim 1 of Auxiliary Request 4 *prima facie* complied with the requirements of Article 84 and 123(2) EPC. Proceedings then continued in writing.
- IX. During these further written proceedings the Appellant withdrew its Main and Auxiliary Requests 1 to 3 and made the former Auxiliary Request 4 into its Main Request and sole request.
- X. The Board then summoned the parties to what was to be the second oral proceedings in this case. In its communication annexed to this summons (the "Second Communication") the Board summarised the results of the discussions in the first oral proceedings. The Board also set out what it then considered to be the "Main points for discussion at the second oral proceedings" under a title using these words. In the first paragraph following this title the Board used the following words which have taken on some significance in these proceedings:

"Articles 100(b), 100(c), 123(2) and 84 EPC

The board considers that it should not be necessary to repeat the argument presented in the first oral proceedings (see above). The discussion should rather be based only on any additional aspects relevant to the claims of the new main request".

- XI. The text referred to by the words, "... (see above) ...", (this text is found in paragraph III. 5. of the Second Communication), sets out Article 84 EPC clarity objections which only concern the use of the terms "redirection" and "direction" in features c1 and c2 of what was to be the Main Request in the second oral proceedings. The Second Communication made no reference to any Article 84 EPC objections as regards the Approval Feature.
- XII. Respondent III (the only party besides the Appellant to play an active role in the proceedings) filed a response to the Second Communication. Respondent III raised Article 84 EPC objections against claim 1 of the Main Request. To summarise, these were that it was not clear what the difference between an "existing SIM" and an "attached SIM" was, and whether the feature "...intermediary processor is adapted to connect with an appropriate subscriber identification module" of feature c already limits the "alternative memory means" of c3 to a subscriber identity module. Respondent III also stated that it considered that the clarity issue raised by the Board in its First Communication relating to the Approval Feature still applied to the Main Request.

- XIII. At the beginning of the second oral proceedings, the only claim request before the Board was the Main Request (former Auxiliary Request 4).
- XIV. During the second oral proceedings before the Board, whether claim 1 of the Main Request met the requirement of clarity pursuant to Article 84 EPC was discussed with the parties. This discussion concerned inter alia the clarity of the Approval Feature.
- XV. The Approval Feature was mentioned in the First Communication, and referred to in Respondent III's reply to the Second Communication.
- XVI. As a result of this discussion, the Chairman announced that claim 1 of the Main Request did not fulfil the requirement of clarity and was therefore not allowable (see point XI of T 1531/10).
- XVII. The Petitioner withdrew this Main Request and sought to continue the proceedings with a new Main Request that it filed during the second oral proceedings. The admissibility of this late filed request was discussed with the parties. This discussion addressed the compliance of the new Main Request with the requirements of Articles 84 and 123(2) EPC. After deliberation the Board informed the parties that the new Main Request was not admitted into the proceedings. It was at this point during the second oral proceedings that the Petitioner requested that in the minutes it be recorded that the Petitioner's right to be heard was violated by not admitting the new Main Request into the procedure.

XVIII. The minutes of the second oral proceedings reflect the above. The Petitioner subsequently made an unsuccessful effort to amend the minutes.

XIX. Due to its withdrawal of its Main Request (former Auxiliary Request 4), the Petitioner has chosen to conduct its case in a way which means that the decision of the Board in T 1531/10 is only concerned with the admissibility of the new Main Request. The Board found that the new Main Request was not clearly allowable and thus did not admit it into the proceedings. This led to there being no admissible request and hence to the dismissal of the appeal.

XX. In a communication dated 4 February 2016, the Enlarged Board informed the Petitioner of its provisional opinion that the petition was admissible.

XXI. As regards the allowability of the petition, the Enlarged Board expressed the following views:

That the Petitioner should not have been surprised, on an objective basis, when the clarity objection raised by Respondent III regarding the Approval Feature was taken up in the second oral proceedings; and

That the Petitioner's right to be heard in respect of the admissibility of the new Main Request filed at the second oral proceedings was respected; and

That the Petitioner's right to be heard in respect of whether the requirements of Article 123(2) EPC were fulfilled by the new Main Request was respected.

XXII. The Petitioner's arguments in the petition and in response to the Enlarged Board's preliminary opinion can be summarised as follows:

In its petition the Petitioner argues that from the Second Communication, particularly from the wording cited at point X above, it did not expect that a discussion of the clarity of the Approval Feature would take place during the second oral proceedings. The Petitioner was surprised when such a discussion did take place as clarity problems with this feature had not been mentioned in the Second Communication; indeed the Board had indicated that it did not wish to hear a repeat of arguments from the first oral proceedings.

XXIII. The Petitioner therefore sought to overcome this objection by filing a new Main Request. The non-admittance of this new Main Request constituted a violation of its right to be heard under Article 113(1) EPC.

XXIV. The Petitioner advances two arguments:

The first is that if a party makes its late filed claim request due to a surprising rejection of its earlier filed claim requests, then in such a case a full, rather than a prima facie consideration is required of the late filed request in order to determine its admissibility.

The second and more general argument is that it is a violation of the right to be heard if the admissibility of a request is decided upon the basis of prima facie

allowability, even if the parties are heard on this issue. This is the case whether the party is surprised or not. The right to be heard cannot be reduced to the formal opportunity to present arguments without a full assessment thereof on the merits (see point 4 of the Petition).

- XXV. On the scope of the right to be heard under Article 113(1) EPC, the Petitioner refers to T 892/92 (OJ 1994, 664; Reasons 2.1). This decision suggests that the right to be heard cannot have been exercised if the parties can be said to have been surprised from an objective point of view by the decision and the grounds and evidence on which it is based.
- XXVI. The Petitioner thus argues that the only way the right to be heard can be safeguarded is if a full assessment of the merits of a new request is made.
- XXVII. The Petitioner is aware that R 1/13 of 17 June 2013 stands in its way. It distinguishes the facts of the present case in that it was forced into a late filing due to a "...surprising change of mind of the Board". In such a case not a prima facie, but a full consideration of the new Main Request is required.
- XXVIII. The Petitioner also notes that a Board can come to a different conclusion on a full consideration of a claim than on a prima facie consideration. It gives the example in the present case that the subject matter of the Main Request, in the first oral proceedings, (where it was called Auxiliary Request 4), was held prima facie to satisfy the clarity requirements of

Article 84 EPC, but on a full consideration was found not to satisfy these requirements.

XXIX. Finally the Petitioner considers that the objections under Article 123(2) EPC against the new Main Request that are found in the Board's decision were not brought to the Petitioner's attention in the second oral proceedings after it had explained to the Board where its amendments were directly and unambiguously disclosed. This also constitutes a violation of the right to be heard.

XXX. In a letter dated 26 April 2016 the Petitioner withdrew its request for oral proceedings. The Enlarged Board therefore cancelled these oral proceedings. Attached to the Petitioner's letter were some remarks by the inventor. The Petitioner's representative explicitly distanced himself from these remarks. The Enlarged Board will therefore not take these remarks into account.

XXXI. The requests of the Petitioner, received in writing, are:

That the decision under review, T 1531/10, be set aside;

That the proceedings be reopened;

That the members of the Board of Appeal who participated in the decision under review be replaced;

That the fee for the petition for review be reimbursed;

That should the Enlarged Board of Appeal have reason to doubt the facts on which the petition is based as presented by the Petitioner, it is further requested:

to procure declarations by the members of Board 3.5.03 who have taken part in the oral proceedings on the events in these oral proceedings, or

to hear them in the requested oral proceedings before the Enlarged Board of Appeal, and

to hear Dr. Hans Wegner, Mr. Bastian Best, Mr. Keith Benson and Mr. James R. Wrathall, who were present for the Petitioner in the oral proceedings.

Reasons for the Decision

1. *Admissibility of Petition*

The petition has been filed on time, is in the correct form and the fee has been paid on time. The provisions of Article 112a(4) and Rule 107 EPC have thus been complied with.

Rule 106 EPC provides that a petition under Article 112a, paragraphs 2(a) to (d) is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings.

In the present case the Petitioner raised an objection, during the second oral proceedings, relating to the non-admittance of its new Main Request as it had been taken by surprise by the Board raising clarity objections against its previous main request.

It is not necessary to decide whether this objection also covered the Petitioner's objection regarding the consideration of Article 123(2) EPC issues and its new Main Request. The Enlarged Board's conclusion on the clarity objections makes a discussion on the added matter point unnecessary (see paragraph 14 to 15 below).

The petition is therefore admissible. However, for the following reasons the Enlarged Board considers that the petition is clearly unallowable and must be rejected (Rule 109(2)(a) EPC).

2. *Allowability of Petition*

The first issue to consider is if the Petitioner can be considered to have been surprised by the Board's decision in the second oral proceedings that claim 1, of what at the beginning of the second oral proceedings was its Main Request, did not satisfy the requirements of Article 84 EPC because of the presence of the Approval Feature in the claim.

3. Whether a party can be considered to be surprised is assessed on an objective basis (see T 892/92, OJ 1994, 664).
4. Respondent III in its reply to the Second Communication specifically referred to the clarity objections regarding the Approval Feature that would form the basis of the Board's decision. These clarity objections had also been raised in the Board's First Communication.
5. In its Second Communication the Board stated:

"Articles 100(b), 100(c), 123(2) and 84 EPC

The board considers that it should not be necessary to repeat the argument presented in the first oral proceedings (see above). The discussion should rather be based only on any additional aspects relevant to the claims of the new main request".

6. If the words relating to Article 84 EPC preceding the above quoted paragraph, the "... (see above) ..." reference, are read they refer to a clarity objection

other than the Approval Feature objection which was referred to in the First Communication, and by Respondent III in its reply to the Second Communication.

7. The Enlarged Board does not therefore consider that the Petitioner can have been surprised when the clarity objection in respect of the Approval Feature as regards the then Main Request, (raised by both the First Communication and Respondent III in its reply to the Second Communication), was taken up in the second oral proceedings. This conclusion disposes of what can be called the Petitioner's "surprise" case.
8. The Enlarged Board now turns to the Petitioner's argument that a prima facie, as distinct from a full consideration of the compliance of its new Main Request with the requirements of Article 84 and 123(2) EPC, in itself, constituted a violation of the right to be heard. This argument concerns the Board's decision not to admit the new Main Request into the proceedings.
9. The Petitioner has suggested in its Petition that even without the factor of surprise, the prima facie examination as to allowability of a claim request (that is whether it complies with the requirements of Articles 84 and 123(2) EPC) in order to determine whether to admit such a claim request into the proceedings is not sufficient to guarantee the right to be heard: what is required is a full assessment of the merits of such claim requests. If the petitioner is correct on this point, any claim request, no matter when filed, would effectively be admissible, a conclusion that would deprive Article 13(1) RPBA of all effect.

10. The Enlarged Board notes that the term *prima facie* is to be found in neither the EPC nor the Rules of Procedure of the Boards of Appeal ("RPBA"). Little is to be gained, therefore, from identifying and distinguishing "*prima facie*" consideration from other forms of consideration. The correct legal basis for admitting into proceedings amendments to a party's case after it has filed its grounds of appeal or reply is set out in Article 13(1) RPBA. This involves the Board exercising a discretionary power. This discretion is to be exercised in view of *inter alia* the complexity of the new subject matter, the current state of the proceedings and the need for procedural economy.
11. The exercise of the discretionary power contained in Article 13(1) RPBA, is as such not subject to review by the Enlarged Board, unless under Article 112a(2)(c) EPC a fundamental violation of Article 113 EPC occurred while exercising this discretionary power. The task of the Enlarged Board is therefore to review whether the Board exercised its discretion under Article 13 RPBA whilst respecting the Petitioner's rights under Article 113(1) EPC.
12. The nature of the right to be heard under Article 113(1) EPC has been subject to many decisions. An example of such a decision is T 763/04 at point 4.4 where it stated:

"...it is not sufficient to observe Article 113(1) merely formally by granting the Applicant the procedural possibility for presenting comments, as this was the case here. This procedural step falls short of

its legislative purpose and remains a pure formality, if there is no trace in the file that such comments were indeed read and discussed on the merits, beyond a mere acknowledgement of their existence. In summary, Article 113(1) requires not merely that a party be given an opportunity to voice comments, but more importantly it requires that the deciding instance demonstrably hears and considers these comments".

The Enlarged Board agrees with the description of the right to be heard set out above.

13. The Board arrived at the conclusion that the claims of the new Main Request, *prima facie*, did not satisfy the requirements of Article 84 EPC and hence that it would exercise its discretion not to admit the new Main Request into the proceedings.
14. The minutes of the second oral proceedings show that the admissibility of the new Main Request was debated during these oral proceedings, and decision T 1531/10 shows that the Board heard and considered the parties' arguments. These points have not been contested. Hence, the Enlarged Board considers that the Petitioner's right to be heard in respect of the admissibility of the new Main Request was respected. The Board was therefore entitled not to admit the new Main Request upon a consideration of its compliance with Article 84 EPC alone.
15. The Petitioner has also raised the issue of a violation of its right to be heard in respect of the discussion at the second oral proceedings on whether the requirements of Article 123(2) EPC were fulfilled by

its new Main Request. In the light of the Enlarged Board's conclusion in paragraph 14 above, no finding on this point is required.

16. The Enlarged Board has already noted in paragraph 14 above that the minutes of the second oral proceedings show that the parties were heard on the admissibility of the new Main Request. Point 1.2 of the Reasons of the Board's decision in T 1531/10 sets out the Board's reasoning for finding that the claims of the new Main Request did not satisfy the requirements of Article 84 EPC. This reasoning extends over three and a half pages. The Enlarged Board thus has the impression from the procedural record that a rather extensive consideration of the decisive Article 84 EPC issue took place, even if the Board itself in point 1.2.7 of the Reasons qualified its conclusion, that the requirements of Article 84 EPC were not satisfied by the new Main Request, as being arrived at from a "prima facie" consideration.
17. The Enlarged Board is thus of the view that the Petition does not establish any violation of Article 113(1) EPC. Hence the Petition is clearly unallowable.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk