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**Datasheet for the decision
of 30 January 2012**

Case Number: T 0036/11 - 3.5.03

Application Number: 03765105.6

Publication Number: 1525767

IPC: H04W 16/28

Language of the proceedings: EN

Title of invention:

Telecommunications radio system for mobile communication services

Patent proprietor:

Koninklijke KPN N.V.

Opponent:

-

Headword:

Telecommunications radio system/KPN

Relevant legal provisions:

EPC Art. 107, 113(1)

EPC R. 84(2), 101(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Appeal by the patent proprietor against decision to discontinue the opposition proceedings after withdrawal of the opposition - admissible (no)"

"Adversely affected (no)"

Decisions cited:

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Catchword:

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Case Number: T 0036/11 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 30 January 2012

Appellant: Koninklijke KPN N.V.
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Representative: Wuyts, Koenraad Maria
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Decision under appeal: Decision of the opposition division of the
European Patent Office posted 25 November 2010
discontinuing the opposition proceedings in
respect of European patent No. 1525767.

Composition of the Board:

Chairman: R. Moufang
Members: F. van der Voort
T. Snell

Summary of Facts and Submissions

I. This appeal is against the decision of the opposition division discontinuing the opposition proceedings in respect of European patent No. 1525767. This patent is based on European patent application No. 03765105.6 which was published as international application (PCT/EP2003/008064) with publication number WO 2004/010724 A.

II. The facts relevant to the present decision may be summarised as follows:

- An opposition was filed on 3 February 2010 by Deutsche Telekom AG;
- With a letter dated 17 February 2010 and received on 18 February 2010 the opponent withdrew its opposition;
- With a brief communication dated 1 March 2010 the opposition division informed the proprietor of the withdrawal of the opposition;
- With a communication dated 12 March 2010 the opposition division invited the proprietor to file its observations in respect of the notice of opposition;
- With a letter dated 10 September 2010 the proprietor filed its observations and requested that the opposition be dismissed. Four prior art documents, i.e. E 10 to E 13, were annexed. Oral proceedings were conditionally requested.

- With a decision dated 25 November 2010 the proprietor was informed that the opposition proceedings were discontinued. The decision mentioned that the opponent had withdrawn the opposition and that the European Patent Office had "no cause to continue the proceedings of its own motion as the dossier now stands".
- III. The proprietor (appellant) lodged an appeal against this decision. In the statement of grounds of appeal the appellant requested that the decision be set aside and "that the opposition division continues to examine the facts of its own motion". Oral proceedings were not requested.
- IV. In a communication sent to the appellant, the board gave its preliminary, non-binding opinion that the appeal did not appear to be admissible. Reasons were given. A time limit of four months was set for filing a reply.
- V. The appellant did not file a reply in response to the communication.
- VI. In view of the board's conclusion as set out below, it is not necessary to reproduce *verbatim* the claims as granted.

Reasons for the Decision

1. *Admissibility of the appeal*
- 1.1 In accordance with Article 107 EPC and Rule 101(1) EPC, one of the requirements for an appeal to be admissible is that the appellant is adversely affected by the

decision under appeal. In the present case, this requirement is not met for the following reasons:

- 1.2 In its reply dated 10 September 2010 to the communication issued by the opposition division, the proprietor requested that the opposition be dismissed. In support of its request, for each one of the claims as granted, the proprietor submitted arguments against the opponent's arguments as set out in the notice of opposition in support of lack of novelty and/or lack of inventive step. Apart from a conditional request that oral proceedings be held, the proprietor did not submit any further requests.
- 1.3 From the reply it can thus unambiguously be derived that the proprietor requested that the opposition be dismissed and, hence, that the patent be maintained as granted.
- 1.4 By deciding to discontinue the opposition proceedings, the opposition division fully acceded to this request, since the decision had the immediate consequence that the patent was maintained as granted. In this respect, it is not relevant whether or not the order of the decision literally corresponds to the proprietor's request. In the board's view, what is decisive is that the substance of the decision given in the order fully accedes to the request, which in the present case is that the patent be maintained as granted.
- 1.5 In the statement of grounds of appeal, the appellant argued that it was adversely affected by the decision, since, notwithstanding the opponent's withdrawal, the EPO had invited the proprietor to file its observations,

which was taken by the proprietor as a clear indication that the EPO planned to continue the opposition procedure of its own motion. Further, since it was evident to the proprietor that the EPO was going to examine the facts of its own motion, the appellant assumed that the further prior art as filed with the reply would also be considered and examined. Issuing a decision to maintain the patent as granted only after an examination of this prior art would have led to "the needed clarity on this patent, in the interest of the public and all parties involved".

- 1.6 These arguments are not convincing for the following reasons:

With the communication dated 12 March 2010 the proprietor was invited to file its observations. This invitation cannot be interpreted as indicating that the proceedings would be continued. For example, a reply in which the proprietor were to submit that, in view of the withdrawal of the opposition, the opposition proceedings were to be discontinued, would have been fully compatible with the content of the communication.

As to the prior art documents filed with the reply, the board notes that in the accompanying letter reference to these documents is only to be found at points II. 3 and 4, which read as follows:

- "3. For the sake of completeness, Patentee submits as further items of prior art

Exhibit E 10: Patent JP-03-244224
including English abstract and English
claims

Exhibit E 11: Patent JP-2001-197551
including English abstract and English
claims and also machine translation of
claims and description

These items of prior art were cited by the
Japanese Patent Office during examination of a
Japanese family member of the patent in suit.

4. Furthermore, Patentee submits the following
items of prior art which were cited by
examiners of the USPTO during examination:

Exhibit E 12: US6088002

Exhibit E 13: US20030003959"

In the board's view, these submissions do not imply that
the proprietor made a request that the opposition
proceedings be continued and, more specifically, that
the cited prior art documents be considered and examined
by the opposition division. Nor do they imply or suggest
that an examination of these documents would lead to
"the needed clarity on this patent, in the interest of
the public and all parties involved".

- 1.7 The board further notes that under Article 113(1) EPC
the decisions of the EPO may only be based on grounds or
evidence on which the parties concerned have had an
opportunity to present their comments. This procedural

right is intended to ensure that no party is caught unawares by reasons given in a decision turning down its request on which the party has not had the opportunity to comment.

In the present case, since the opponent had withdrawn its opposition, the proprietor was the only remaining party to the opposition proceedings. Further, from the decision under appeal it follows that the opposition division had no cause to continue the proceedings of its own motion as the dossier stood at the time (see point II above). If the opposition division had considered that the stage reached in the opposition proceedings was such that they were likely to result in a limitation or revocation of the patent without further assistance from the opponent and without the opposition division itself having to undertake extensive further investigations, it should have continued the proceedings (cf. Rule 84(2) EPC, Guidelines, D-VII, 6.2 and 6.3). In the present case, this situation apparently did not occur and, analogous to the case in examination proceedings in which the examining division is not obliged to issue a communication in which its reasons as to its positive findings on the grant of a patent are set out, the opposition division was not obliged to communicate to the proprietor the reasons as to its positive findings on the maintenance of the patent as granted in order to comply with Article 113(1) EPC. Hence, there was no violation of the right to be heard, which might otherwise have adversely affected the proprietor.

- 1.8 Since the decision corresponds to and is fully consistent with the proprietor's unambiguous request at

the time and the board sees no other reason why the proprietor would have been adversely affected at the time the decision was delivered, the board concludes that within the meaning of Article 107 EPC the proprietor was not adversely affected by the decision.

1.9 Consequently, the appeal is to be rejected as inadmissible, Article 107 EPC and Rule 101(1) EPC.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

G. Rauh

R. Moufang