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**Datasheet for the decision
of 14 April 2016**

Case Number: T 0732/11 - 3.5.02

Application Number: 07006819.2

Publication Number: 1845497

IPC: G08B25/14

Language of the proceedings: EN

Title of invention:

Technician communications for automated building protection systems

Applicant:

Siemens Industry, Inc.

Relevant legal provisions:

RPBA Art. 13(1), 13(3)
EPC Art. 111(1)

Keyword:

Late-filed request - justification for late filing (no)
Appeal decision - remittal to the department of first instance
(no)



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Case Number: T 0732/11 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 14 April 2016

Appellant: Siemens Industry, Inc.
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 24 November 2010 refusing European patent application No. 07006819.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Cramer
Members: R. Lord
H. Bronold

Summary of Facts and Submissions

- I. This is an appeal of the applicant against the decision of the examining division to refuse European patent application No. 07 006 819.2. The reason given for the refusal was that the subject-matter of the independent claims of the request filed with letter dated 12 August 2010 did not involve an inventive step according to Article 56 EPC.
- II. In a communication accompanying the summons to oral proceedings, dated 15 January 2016, the board indicated their preliminary opinion *inter alia* that the independent claims of the request which was the subject of the decision under appeal contravened Article 123(2) EPC, that these claims also did not meet the requirement for clarity of Article 84 EPC, and that the subject-matter of these claims did not involve an inventive step.

The appellant filed no substantive written response to that communication.

Oral proceedings before the board took place on 14 April 2016. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the new main request filed during the oral proceedings of 14 April 2016, or, if that was not possible, that the case be remitted to the department of first instance.

- III. Claim 1 according to the appellant's main request reads as follows:

"A system for communications in automated protection of a building environment, the system comprising:

a protection system for a building, the protection system having one or more monitoring devices (106); and a communications module (14) connected with the protection system and operable to communicate wirelessly with a portable service tool (110), the system further comprising the portable service tool, the portable service tool being operable to

- collect data, diagnose problems, and/or configure the building system (400) using one or different links, as a user moves about the environment,
- perform troubleshooting, identifying a malfunctioning device or a ground fault in a circuit, using one or different links, as a user moves about the environment."

IV. The appellant essentially argued as follows:

The request filed during the oral proceedings before the board was admissible, because it addressed the objection under Article 123(2) EPC which had been the basis for rejecting the request previously on file. The deletion of the method claims also addressed objections raised against those claims in the board's communication. The amendment had not been made earlier, because the appellant had been of the opinion that they would have been able to persuade the board that the previous request met the requirements of Article 123(2) EPC.

The case should be remitted to the department of first instance, to enable them to consider the objections under Articles 123(2) and 84 EPC, which had been raised for the first time by the board, and because otherwise the appellant would be put into a position corresponding to *reformatio in peius*.

Reasons for the Decision

1. The appeal is admissible.
2. *Admissibility of request filed during oral proceedings*
 - 2.1 The appellant's sole request was filed during the oral proceedings before the board, after the board had given its opinion that the previous request contravened Article 123(2) EPC. The reasons for that opinion had already been presented to the appellant in the board's communication of 15 January 2016. The final paragraph of that communication stated that "the board should not be taken by surprise by ... new requests at the oral proceedings", and that the appellant "may file written submissions in preparation for the oral proceedings up to **one month** before the date scheduled for the oral proceedings" (emphasis in original).
 - 2.2 The only reason indicated by the appellant's representative as to why this new request was nonetheless only filed during the oral proceedings was that the appellant had considered that they would be able to convince the board that the previous request met the requirements of Article 123(2) EPC, and on this basis had decided not to file any amendments before hearing the board's opinion on this point. Such tactical considerations cannot however justify ignoring the explicit instructions of the board, which instructions reflect the provisions of Article 13(1) and (3) of the Rules of Procedure of the Boards of Appeal (RPBA). Moreover, even if it were considered acceptable to defer filing such requests in this manner, it would nonetheless have been possible (and indeed incumbent on the appellant) to have prepared

them in advance of the oral proceedings, rather than obliging the board to interrupt the oral proceedings so that this could be done. Thus, this reason alone cannot justify the admission of this request into the proceedings at such a late stage.

2.3 Two further factors speak against the admissibility of the request, namely:

- Claim 1 of the request differs from that of the previous request (that filed with letter of 12 August 2010) by the deletion of the features corresponding to the original dependent claim 24. Those features had been introduced into the independent claims already with the then applicant's reply of 13 January 2009 to the first communication under Article 94(3) EPC, and had been maintained in the claims since then. Their deletion thus represents a significant change in direction of the appellant's case.
- Even though the modified request addresses the objection under Article 123(2) EPC as raised in section 1.1 of the board's communication, it makes no attempt to address the objections of lack of clarity raised in section 2.2, second sentence of that communication. Moreover, since the amendment consists in the deletion of features from the claim, it also could not contribute to addressing the objection of lack of inventive step which was the basis of the decision under appeal. Indeed, the resultant broadening of the scope of the claim might even result in further prior art becoming relevant for the assessment of inventive step. Thus this request *prima facie* does not meet the requirement established in the case law of the Boards of Appeal that a request filed only at such

a late stage of the procedure should be clearly allowable.

2.4 The board therefore, exercising its discretion under Article 13(1) and (3) RPBA, decided to not admit this request into the proceedings.

3. *Request for remittal*

The appellant requested that if the (main) request were not allowed, the case should be remitted to the department of first instance for further prosecution, in particular to give the examining division the opportunity to decide on the objections under Articles 123(2) and 84 EPC raised by the board. The board however sees itself as being fully in a position to exercise its discretion under Article 111(1) EPC in such a way as to decide on the formal matters discussed during the oral proceedings. The appellant's comment concerning *reformatio in peius* is not relevant in this context, since the decision under appeal was to refuse the application, so that a decision not to remit the case would not result in any worsening of the position of the appellant, merely a confirmation of that position. The board therefore decided not to remit the case to the department of first instance.

4. Since the appellant's sole request was not admitted into the proceedings, and since the case is not to be remitted to the department of first instance, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



U. Bultmann

R. Cramer

Decision electronically authenticated