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**Datasheet for the decision
of 29 March 2017**

Case Number: T 0540/13 - 3.5.03

Application Number: 01270991.1

Publication Number: 1350373

IPC: H04L29/00

Language of the proceedings: EN

Title of invention:

Method of certifying transmission, reception and authenticity
of electronic documents and related network unit

Patent Proprietor:

KP TWELVE SRL

Opponents:

INTESA S.p.A.

INFOCAMERE Soc.Cons./ACTALIS S.p.A./CEDACRI S.p.A./POSTCOM
S.p.A.

Microsoft Deutschland GmbH

Headword:

Certifying transmission of electronic documents/KP TWELVE

Relevant legal provisions:

EPC Art. 100(c), 107

EPC R. 77

RPBA Art. 12(4), 13(1)

Keyword:

Admissibility of opposition of opponent 01 - yes

Added subject-matter (patent as granted and auxiliary requests 5 to 10, 13 to 23) - yes

Admissibility of auxiliary requests 3, 4, 11, 12 - no (not admitted by opposition division)

Admissibility of late-filed auxiliary request 24 - no (prima facie not allowable)

Decisions cited:

G 0001/93, J 0020/85, T 0384/08, T 1178/04, T 0898/91

Catchword:

When the opposition division decides that an opposition is inadmissible in a case where at least one other admissible opposition has been filed, it is not necessary for the opponent of the opposition held inadmissible to appeal this decision in order to preserve party status in appeal proceedings initiated by another party (see points 1.2 to 1.5 of the reasons).



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Case Number: T 0540/13 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 29 March 2017

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 13 February
2013 revoking European patent No. 1350373
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman F. van der Voort
Members: T. Snell
P. Guntz

Summary of Facts and Submissions

- I. This case concerns appeals arising from the decision of the opposition division to revoke European patent No. 1 350 373.
- II. Oppositions to the patent were filed by the company Intesa S.p.A (henceforth opponent O1) and, jointly, by the companies INFOCAMERE Soc. Cons., Actalis S.p.A., Cedacri S.p.A. and Postcom S.p.A. (henceforth jointly referred to as opponent O2) citing Articles 100(a) and (b) EPC.
- III. In the course of the opposition procedure, an admissible intervention was filed by the assumed infringer Microsoft Deutschland GmbH (henceforth opponent O3), citing Articles 100(a), (b) and (c) EPC.
- IV. Of the cited grounds for opposition, only that of Article 100(c) EPC is relevant to the board's decision.
- V. The opposition division issued a decision revoking the European patent as the ground for opposition pursuant to Article 100(c) EPC prejudiced the maintenance of the patent as granted. In addition, the opposition division either did not admit or did not allow any of the 21 auxiliary requests on file.

In addition to revoking the patent, the title page of the decision states:

"Additional decision: The opposition of the opponent(s) INTESA S.p.A is rejected as inadmissible".

As to the facts concerning the filing of the opposition of opponent O1, reference is made to point 2.1 below.

VI. Appeals were filed by the patent proprietor and opponent O1.

Opponents O2 and O3 are respondents.

VII. In its notice of appeal, the appellant-proprietor requested that the impugned decision be set aside and that the patent be maintained as granted, or, in the alternative, that the patent be maintained in amended form "according to any of the auxiliary requests filed by the patent owner during the Opposition proceedings".

VIII. In its statement of grounds of appeal, appellant-opponent O1 requested that "the decision of the Opposition Division that rejected Opponent O1's opposition on grounds of inadmissibility pursuant to Rule 77 EPC be set aside and that Opponent O1's opposition be considered admissible".

IX. In subsequent replies to the appeal of the appellant-proprietor, all opponents requested that the appeal of the appellant-proprietor be dismissed.

X. In a communication accompanying a summons to oral proceedings, the board gave a preliminary opinion that the opposition of opponent O1 was admissible. It however doubted that the appeal of opponent O1 was admissible as it could not see that opponent O1 was adversely affected by the decision to revoke the patent. It considered that opponent O1 had the status of respondent, at least until a negative decision on the admissibility of its opposition was taken.

The board further gave a preliminary opinion that claim 1 of the main request did not comply with Article

123(2) EPC, i.e. that the ground for opposition pursuant to Article 100(c) EPC prejudiced the maintenance of the patent.

With respect to the auxiliary requests, the board stated that auxiliary requests 1 and 2 had been withdrawn during the opposition procedure and that auxiliary requests 3, 4, 11 and 12 had not been admitted. The board therefore saw no reason to admit these requests (Article 12(4) RPBA). As to auxiliary requests 5 to 10 and 13 to 23, the board noted that claim 1 of each request, although amended, did not comply with Article 123(2) EPC for essentially the same reasons as claim 1 of the main request.

XI. Oral proceedings took place on 29 March 2017 in the presence of all parties.

During the oral proceedings, the appellant-proprietor submitted an amended request as auxiliary request 24.

The appellant-proprietor requested by way of a main request that the decision under appeal be set aside and that the oppositions be rejected. Alternatively, it requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of one of auxiliary requests 3 to 23 as filed during the opposition proceedings and auxiliary request 24 as filed during the oral proceedings. Further, it requested that the appeal filed by opponent O1 be dismissed.

The appellant-opponent O1 requested that the decision under appeal be set aside to the extent that its opposition filed on 2 October 2007 be held admissible.

Further, appellant-opponent O1 requested that the appeal filed by the appellant-proprietor be dismissed.

Respondents O2 and O3 both requested that the appeal of the appellant-proprietor be dismissed.

XII. Claim 1 as granted reads as follows:

"A method of certifying transmission, reception and authenticity of electronic documents between at least one sender user (2) and at least one addressee user (3) in a telecommunication network (4), wherein said sender user (2) carries out the following steps:
drafting the document to be sent,
sending a message comprising the drafted document to a mailbox associated to the addressee user (3) through the telecommunication network,
and wherein the addressee user (3) carries out the following step:
downloading the message from the mailbox associated to the addressee user (3),
wherein a transmittal certificate is automatically generated and sent to a mailbox associated to said sender user (2) by a certification entity (1) connected to the telecommunication network (4) when said message reaches said mailbox of said addressee user (3),
the method being **characterized by** further comprising the steps of:
receiving the message from the sender user (2) at the certification entity (1),
identifying by the certification entity (1) the sender user (2) from whom the message is received, and
checking at the certification entity (1) if said sender user (2) is a certified sender user included among sender and addressee users (2, 3) comprised in at least

one file unit (16) so as to admit or refuse the message,
wherein the transmittal certificate is only generated and sent, if the identified sender user (2) is included among said sender and addressee users (2, 3) in the file unit (16) of the certification entity (1)."

XIII. For the sake of economy, the wording of claim 1 of each of auxiliary requests 3 to 24 is not reproduced in full. As the decision mainly concerns the following method step of claim 1 as granted:

"checking at the certification entity (1) if said sender user (2) is a certified sender user included among sender and addressee users (2, 3) comprised in at least one file unit (16) so as to admit or refuse the message",

it is sufficient to note that, in respect of this feature, claim 1 of each of **auxiliary requests 3, 4, 11 and 12** includes the same wording, claim 1 of each of **auxiliary requests 5 to 10, 13 to 18, and 23** includes the following amended wording:

"checking at the certification entity (1) if said sender user (2) is a certified sender user included among sender and addressee users (2, 3) comprised in at least one file unit (16) so as to admit or refuse the message, wherein the certified sender user is a user of a mail service who is included in the file unit (16) and to whom a transmission certificate shall be sent",

claim 1 of **auxiliary request 22** includes the following amended wording:

"checking at the certification entity (1) if said

sender user (2) is a certified sender user included among sender and addressee users (2, 3) comprised in at least one file unit (16) so as to admit or refuse the message, wherein the certified sender user is a user of a mail service who is included in the file unit (16) and to whom the transmission certificate shall be sent" [underlining by the board],

and claim 1 of **auxiliary request 24** includes the following amended wording:

"checking at the certification entity (1) if said sender user (2) is a certified namely identified sender user included among sender and addressee users (2, 3) comprised in at least one file unit (16) so as to admit or refuse the message".

For the same reason, it is sufficient to note that claim 1 of each of **auxiliary requests 19 to 21** is directed to a network unit which includes, inter alia, the following constructional feature corresponding to the above-cited method step:

"identification means (7) for identifying the sender user (2) of a message received as input from said transmission and reception means (6) and for checking, if said sender user (2) is a certified sender user included among the sender and addressee users (2, 3) comprised in said at least one file unit (16) so as to admit or refuse said messages, wherein the certified sender user is a user of a mail service who is included in the file unit (17) and to whom a transmission certificate shall be sent".

Reasons for the Decision

1. *Admissibility of the appeal of appellant-opponent O1*

1.1 The Opposition Division held that the opposition of opponent O1 was inadmissible. Opponent O1 appealed this part of the decision (see above point VIII).

1.2 As regards the admissibility of opponent O1's appeal, the board notes that only persons adversely affected by a decision are entitled to appeal (Article 107 EPC, first sentence). On the one hand, opponent O1 was not adversely affected by the decision to revoke the patent. On the other hand, the opposition division also held that O1's opposition was inadmissible and took a separate "additional decision" to this effect (see above point V). It is open to question whether this additional decision, which seemed to have a negative outcome for opponent O1 but did not change the fact that its main request that the patent be revoked had been granted, is open to a separate admissible appeal. However, for the reasons given below, this question does not need to be answered in the present case, where also the patent proprietor appealed the decision and did not withdraw its appeal.

1.3 As a matter of principle, the boards of appeal have to examine the question of party status *ex officio* before dealing with the substance of the case (cf. T 384/08, point 3 of the reasons).

1.4 It follows that in the present case, in order to determine whether opponent O1 has party status as of right (Article 107 EPC), here as a respondent with respect to the proprietor's appeal, the board has to decide on the admissibility of opponent O1's opposition, irrespective of whether or not the appeal of opponent O1 is admissible.

1.5 Following T 1178/04 (OJ EPO 2008, 80; cf. points 24 to 30 of the reasons) rather than T 898/91, which took another view (cf. point 1.2 of the reasons), the board is therefore of the view that when an opposition division decides that an opposition is inadmissible in a case where at least one other admissible opposition has been filed, it is not necessary for the opponent of the opposition held inadmissible to appeal this decision in order to preserve party status in appeal proceedings initiated by another party.

1.6 Since the board holds the opposition to be admissible (see below), meaning that, in any case, opponent O1 is a party as of right to these appeal proceedings as respondent, a formal decision as to the admissibility of the appeal of opponent O1 is not necessary.

1.7 Being a party as of right to the patent proprietor's appeal, opponent O1 has the right to request that a formal decision denying its party status be formally set aside. For this reason, the board has included this matter in the order.

2. *Admissibility of the opposition of opponent O1*

2.1 The essential facts and submissions concerned with the filing of the opposition of opponent O1 are the following:

(i) Opponent O1 filed a notice of opposition by fax on 2 October 2007 in which it was stated that the facts and arguments [in support of the grounds for opposition required by Rule 76 EPC] "will follow".

(ii) Opponent O1 sent a package by DHL, which was received at the EPO on 4 October 2007. The package contained EPO Form 2300.1, a confirmation of the notice of opposition sent by fax as well as the documents cited in the notice of opposition. However, contrary to what was stated in EPO Form 2300.1 ("VII. Facts and arguments (Rule 55(c) EPC) presented in support of the opposition are submitted herewith on a separate sheet (annex 1)"; "XI. List of documents Enclosure No. ... 1 Facts and arguments (see VII.) No. of copies: 2", apparently, there was no statement of facts and arguments. This was the last day for filing an opposition (9 months after grant on 3 January 2007, plus 1 extra day due to the public holiday in Germany on 3 October 2007).

(iii) In a communication dated 24 October 2007 from the formalities officer on behalf of the opposition division, opponent O1 was informed that there were no sheets of facts and arguments filed with the letter dated 2 October 2007.

(iv) A statement of facts and arguments was then sent by fax by opponent O1 on 30 October 2007 under cover of a letter dated 29 October 2007, saying "As requested in your communication dated 24 October 2007, we enclose herewith Facts and Arguments". The enclosed statement showed the Representative's letterhead and the date "29 October 2007". There was not the slightest indication that any "Facts and Arguments" had already been submitted earlier.

(v) In a communication dated 18 January 2008 from the formalities officer on behalf of the opposition division, opponent O1 was informed that "The notice of opposition contains no statement of grounds on which

the opposition is based (Rule 76(2)(c) EPC)" and that "the notice of opposition will be rejected by the opposition division as inadmissible...".

(vi) In a letter dated 25 January 2008, opponent O1 expressed "amazement" at the substance of the communication. It argued that the facts and arguments had been submitted with the DHL package, and submitted declarations of persons involved in the sending of the package in support thereof. Opponent O1 requested that the office communication be withdrawn. Conditionally, oral proceedings were requested. That the "Facts and Arguments" as submitted later didn't show the date 2 October 2007 but 29 October 2007 was explained with an alleged reprinting under new letterhead whereas a first version had allegedly been printed on plain white paper. A copy thereof was enclosed. Opponent O1 did not give any explanation as to why the alleged presence of "Facts and Arguments" in the DHL package, sent on 02 October 2007 was not mentioned in the letter of 29 October 2007. Later, in the statement of grounds of appeal they explained that it was their belief that the formalities officer, when issuing the communication dated 24 October 2007, had not been able to find the original of the Facts and Arguments as handed in with DHL package of 2 October 2007 and was simply asking for a replacement. The fact that when posting the DHL package on 2 October 2007 with a letter dated the same day, this very letter still said that the "Facts and Arguments will follow", was explained with the observation that this letter was marked and only meant as a confirmation copy of the fax sent on the same day.

(vii) The opposition division subsequently first dealt with the matter in a communication accompanying a summons to attend oral proceedings dated 9 August 2012.

It stated that "Facts and arguments substantiating the indicated grounds for opposition have not been filed within the opposition period. Even the paper confirmation received on 4 October 2007 ... did not comprise facts and arguments, as has been confirmed by file inspection". Consequently, the opposition division considered that "the opposition of O1 has to be rejected as inadmissible".

(viii) At the oral proceedings dated 4 December 2012, after hearing the parties, the opposition division decided that the opposition of opponent O1 was inadmissible. In the impugned decision, it is stated that the arguments of opponent O1 supported by the statements of the persons involved in sending the notice of opposition "cannot dispel the fact that "facts and arguments" were not filed within the opposition period".

2.2 In accordance with case law, in cases where there is a dispute as to whether documents have been filed with the EPO, it is necessary to determine the likely course of events. In the present case, this would be to determine which of the following two scenarios is more likely to have happened: (i) the DHL package did not include the statement of facts and arguments; or (ii) the statement was lost in the EPO.

2.3 Re (i): Opponent O1 tried to convince the Board that, although not having mentioned such content in the letters of 2 and 29 October 2007, it believed the DHL package to include the statement of facts and arguments. Of course, that does not rule out that an error occurred on the part of opponent O1. On the other hand, with letter of 28 January 2008, it provided

evidence regarding the alleged submission of Facts and Arguments together with the DHL package.

2.4 Re (ii): It appears that neither the formalities officer nor the opposition division undertook any effort to investigate what may have happened when the DHL package was opened in order to determine the likelihood of the statement of facts and arguments having being mislaid within the EPO.

2.5 In a similar case, J 20/85 (OJ EPO 1987, 102), in which missing pages of claims were the issue, the board found that (cf. reasons 3):

"Article 114(1) EPC provides that "In proceedings before it, the European Patent Office shall examine the facts of its own motion". In the present case, faced with the contention and evidence identified above, it was necessary for the Receiving Section to investigate, in detail, what had happened to the set of documents inside the European Patent Office, from the moment when the envelope containing the documents was opened in the Post Room."

The decision goes on to state the following (cf. reasons 5):

"Having regard to the provisions of Article 114(1) EPC quoted in paragraph 3 above, the Board has considered whether the case should be remitted to the Receiving Section for further investigation, or whether it should itself investigate the facts of the case in relation to the handling of the documents which were filed in the Post Room on 27 September 1984. However, although it was filed in due time, the Statement of Grounds of Appeal was not filed until September 1985, so that any

such investigation and taking of evidence would necessarily have to have taken place more than a year after the relevant events. It could not be expected in those circumstances that the personnel in the Post Room would have a clear recollection of what happened to the documents of this particular case, and therefore to conduct such an investigation now would not be fair either to the Appellant or to the European Patent Office. This consideration emphasises the importance of what is stated in paragraph 4 above, to the effect that in a case such as the present the department or section concerned should initiate the taking of evidence as soon as it is apparent that there is a dispute as to facts between the European Patent Office and a party to proceedings before it."

- 2.6 In the board's view, the opposition division should have made an attempt to investigate the circumstances of opening the DHL package and/or ascertaining whether the statement of facts and arguments could yet be found in the EPO, at the latest following receipt of the letter dated 25 January 2008, at which point it was clear that opponent O1 believed that the statement of facts and arguments had indeed been filed within the opposition period. Without such an investigation, it is unclear how the opposition division could, more than four years later, regard it as a "fact" that the statement of facts and arguments had not been received. Further, by waiting so long before considering the matter, any meaningful investigation was rendered impossible. The board is now in the position that nine years have passed since the filing of the opposition. It is more than doubtful, whether hearing witnesses, either those offered by opponent O1 or those within the EPO, after such a long time could now still serve any useful purpose.

2.7 Under the circumstances that no investigation took place within the EPO it now seems impossible to establish whether it was more likely that the statement of facts and arguments was omitted by mistake on the part of opponent O1, or was lost within the EPO. In such a case, the opponent has to receive the benefit of any doubt.

2.8 Consequently, the board considers that the opposition of opponent O1 is admissible. Opponent O1 is therefore at least a party as of right, i.e. has the status of respondent with respect to the proprietor's appeal (cf. point 1.5 above).

3. *Main request - claim 1 as granted - Articles 100(c) and 123(2) EPC*

3.1 The board maintains the annotations M1 to M8 for the features of claim 1 used in the impugned decision.

3.2 The characterising part of claim 1 as granted reads as follows:

M5: receiving the message from the sender user (2) at the certification entity (1),

M6: identifying by the certification entity (1) the sender user (2) from whom the message is received, and

M7: checking at the certification entity (1) if said sender user (2) is a certified sender user included among sender and addressee users (2, 3) comprised in at least one file unit (16) so as to admit or refuse the message [board's underlining],

M8: wherein the transmittal certificate is only generated and sent, if the identified sender user (2) is included among said sender and addressee users (2, 3) in the file unit (16) of the certification entity (1).

- 3.3 The matter at issue is whether the term "certified sender user" in feature M7 results in the subject-matter of the patent extending beyond the content of the application as filed. The term "certified" was apparently introduced during the examination procedure and it was common ground that there is no literal basis for the term "certified sender user" in the application as filed.
- 3.4 In order to determine what is actually claimed, it is a basic tenet that a claim should be construed in a manner which makes technical sense. In this respect, the wording of one feature cannot be construed in isolation but must be interpreted in a technically meaningful way having regard to the other features with which it interacts. With respect to Articles 100(c) and 123(2) EPC, the board however does not agree that, as argued by the appellant-proprietor, Article 69(1) EPC and its protocol may be used to discount technically meaningful interpretations of a claim merely because they are not supported by the description and drawings as filed. To conclude otherwise would render Article 123(2) EPC meaningless as regards amendments to claims.
- 3.5 In essence, steps M6, M7 and M8 specify the following: In M6, the sender user is identified. In M7, a check is made whether to admit or refuse the message based on a check as to whether said sender user is a certified sender user included among sender and addressee users comprised in at least one file unit. In M8, the

transmittal certificate is generated and sent if the identified sender user is included among said sender and addressee users in the file unit. Therefore, M7 refers to a "certified sender user", but M8 does not, referring instead to an "identified sender user" (i.e., one identified in step M6).

3.6 When considering the feature M7 in isolation, the wording used could apparently have either of the following two meanings, which was not disputed:

(i) Checking at the certification entity (1) if said sender user (2) is a certified sender as a result of being included among certified sender and addressee users comprised in at least one file unit.

(ii) Checking at the certification entity (1) if said sender user (2) is a certified sender, and further checking if said sender user is included among sender and addressee users comprised in at least one file unit (this embodiment will be referred to as the "double checking" embodiment).

3.7 The opposition division argued that M7 must be construed as (ii), and even went so far as to say that the feature "means that the check involves a certificate". The board does not go that far. In the board's view, the most that can be said is that the wording of feature M7 as such is not clear and might be construed in the sense of (ii). Moreover, the wording "certified" does not in itself mean a certificate must be involved in the check referred to in M7.

3.8 It has next to be considered whether the meaning of M7 becomes clear when it is read together with the other features of claim 1, in particular M6 and M8. In this

respect, the board notes that if the wording "checking ... if said sender user is a certified sender user" were given the "double checking" meaning (ii), as argued by the opposition division, it would result in feature M7 requiring two checks, whereas in accordance with M8, there would be only the single requirement for generating and transmitting the transmittal certificate of whether or not the identified sender user is included among the sender and addressee users in the file unit. Nevertheless, from a technical point of view, as pointed out by opponent O3 at the oral proceedings, it would at least be feasible to apply a different test for admitting or refusing the message than for generating and sending the transmittal certificate. Hence, the "double checking" embodiment is a technically meaningful interpretation of the features in question. However, since a basis for this "double checking" embodiment cannot be found in the application as filed, the board judges that claim 1 as granted contains subject-matter which extends beyond the content of the application as filed.

3.9 Moreover, for the sake of argument, even if claim 1 were interpreted in the sense of (i), it would still embrace a technical embodiment not supported by the application as originally filed, as explained in the following:

3.10 When given the meaning (i) above, feature M7 could apparently at least embrace the following possibilities:

(a) the sender user is deemed certified as a result of being included in the file unit;

(b) the sender user is certified as a result of being in the file unit and has been certified as a result of some non-technical certification process; or

(c) the sender user is certified as a result of being in the file unit, by being certified, e.g. beforehand, by a technical certification process.

3.11 It follows that claim 1 embraces the technical embodiment (c) which was not disclosed in the application as filed, contrary to Article 123(2) EPC.

3.12 The arguments of the appellant-proprietor can be summarised as follows:

(i) It is not possible to identify from the wording of claim 1 that two checking steps are required. It is clear from the wording of claim 1 that the term "certified sender user" shall be used to identify the users listed in the file unit.

(ii) The interpretation given by the opposition division is not in line with the wording of the description, contrary to Article 69 EPC and the protocol on interpretation.

(iii) The term "certified" applies to the user and is therefore a non-technical attribute. Therefore, in accordance with decision G 1/93, no subject-matter is added by this term.

(iv) The opposition division committed a procedural violation under Article 113(1) EPC and Rule 111(2) EPC, as the two-step interpretation of claim 1 adopted by the opposition division was not supported by arguments.

3.13 Re (i) and (ii): These points have been dealt with above.

Re (iii): As indicated above, the term "certified" can also be a technical attribute. Indeed, the present patent is concerned in general with technical forms of certification. It is therefore by no means illogical to give the term "certified" a technical meaning. The board further notes that in claim 1 the fact that in the feature "sender and addressee users (2, 3) in the file unit (16) of the certification entity (1)" reference is made to "users" does not mean that this feature is to be understood as non-technical. Similarly, the fact that the term "certified" applies to a "user" does not therefore turn it into a non-technical attribute.

Re (iv): The board does not see that the opposition division in this respect committed a procedural violation due to an infringement of Article 113(1) EPC. The reasoning per se is understandable without apparently requiring further explanations. There also appears to be no dispute that the proprietor was able to comment on it.

4. The board therefore concludes that the ground for opposition pursuant to Article 100(c) EPC prejudices the maintenance of the patent as granted. The main request is therefore not allowable.

5. *Auxiliary requests 3, 4, 11 and 12*

5.1 In accordance with Article 12(4) RPBA, the admitting of requests which were not admitted by the department of first instance is at the discretion of the board.

Auxiliary requests 3, 4, 11 and 12 were not admitted by the opposition division because they were subject to the same objection as the main request. The appellant-proprietor has not challenged that assessment, which the board shares. The appellant did not provide any further reasons why the Board should exercise its own discretion under Article 12(4) RPBA in a different way than the opposition division had done.

5.2 Consequently, auxiliary requests 3, 4, 11 and 12 are held to be inadmissible (Article 12(4) RPBA).

6. *Auxiliary requests 5 to 10 and 13 to 23 - claim 1 - Article 123(2) EPC*

6.1 Claim 1 of each of the auxiliary requests 5 to 10 and 13 to 23 (cf. point XIII) contains the additional feature:

"the certified sender user is a user of a mail service who is included in the file unit (16) and to whom a transmission certificate shall be sent".

Similarly, claim 1 of auxiliary request 22 (cf. point XIII) contains the additional feature:

"the certified sender user is a user of a mail service who is included in the file unit (16) and to whom the transmission certificate shall be sent".

6.2 The appellant-proprietor stated that the aim of this amendment in each of these requests was to clarify and limit the meaning of the term "certified sender user".

6.3 However, in the board's view, all aspects of these added features are implicitly comprised in claim 1 as

granted. Consequently, these amendments make no difference to Article 123(2) EPC. In particular, each claim 1 still embraces both the "double checking" embodiment and the technical certification embodiment.

6.4 Consequently, claim 1 of each of these requests does not comply with Article 123(2) EPC for the same reasons as given above (cf. point 3) in respect of claim 1 of the main request.

7. *Auxiliary request 24 - admissibility*

7.1 In accordance with this request (cf. point XIV), the term "a certified sender user" is replaced by the expression "a certified namely identified sender user".

7.2 In accordance with Article 13(1) RPBA, "Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy".

7.3 Auxiliary request 24 was filed at a late stage of the oral proceedings before the Board. A new request may be admitted at such a late stage if it overcomes, prima facie, all the objections previously discussed and does not introduce new objections or complications.

7.4 However, that is here not the case. Amended claim 1 is, in the board's view, even more unclear than claim 1 as granted, contrary to Article 84 EPC. Moreover, the amendment does not overcome the objection under Articles 100(c) and 123(2) EPC discussed in connection with claim 1 of the main request, and introduces

considerable doubt as to compliance with Article 123(3) EPC.

7.5 In respect of Article 84 EPC, the expression "a certified namely identified sender" is manifestly unclear. In this respect, the terms "identified" and "certified" concern different concepts which would not normally be linkable by the term "namely", in the same way that it would make no sense to use the expression "apples namely pears". Furthermore, the skilled reader would not know whether to interpret the expression "certified namely identified" here as "certified and identified" (e.g. "British namely English"), or as "not certified, but identified" (e.g. "not apples but pears"). If the claim is to mean "certified and identified sender", it would still apparently be subject to the same objection of non-compliance with Article 123(2) EPC discussed in connection with claim 1 of the main request. If it is to be understood as "not certified but identified", effectively the requirement of being certified has been deleted, which renders doubtful whether claim 1 complies with Article 123(3) EPC.

7.6 With respect to Article 123(3) EPC, the appellant-proprietor argued that in claim 1 as granted, "certified" has the possible sub-meaning "identified". Consequently, the amendment merely limited "certified" to one of its possible meanings.

However, the board notes that, although whether or not "certified" has a possible sub-meaning "identified" might have been relevant to a discussion on Article 123(3) EPC, the argument is moot, since a formulation of claim 1 has been chosen which, for the reasons given above, is prima facie not clear and not compliant with

Article 123(2) EPC. Further, allowing an amendment at this stage which would require an in-depth discussion of Article 123(3) EPC would be contrary to procedural efficiency.

7.7 The appellant-proprietor further argued that the board was unfairly giving speculative meanings to the claim rather than considering the merits of the "invention" as described in the description. Such an approach was not in the spirit of the EPC. The board should take into account, when amendments are formulated by non-native speakers, that these might not be in position to find the clearest formulation. With regard to procedural efficiency, the appellant-proprietor found that the fault lay essentially with the EPO, who had taken nine years in processing the file through opposition and appeal proceedings.

7.8 The board finds these arguments unconvincing. In accordance with Article 84 EPC, the claims shall define the matter for which protection is sought and shall be clear. Consequently, it is incumbent on the board to ensure that this requirement is met. It is not possible to relax this requirement in view of a party not being a native speaker of the language of the proceedings, or because of alleged errors of drafting, all the more so in inter partes proceedings. As regards the length of the proceedings, the board does not see how that is relevant to admissibility of requests filed late in the oral proceedings to counter objections that had been on file for a very long time.

7.9 For above reasons, the board used its discretionary power under Article 13(1) RPBA to not admit auxiliary request 24.

8. *Conclusions*

8.1 As none of the proprietor's requests is allowable, it follows that the proprietor's appeal has to be dismissed.

8.2 The board holds the opposition of opponent O1 to be admissible. Opponent 1's request that the "additional decision" taken by the opposition division be set aside is therefore acceded to.

Order

For these reasons it is decided that:

1. The appeal of the appellant-proprietor is dismissed.
2. The "additional decision" is set aside and the opposition filed by opponent O1 is held admissible.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated