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**Datasheet for the decision  
of 28 April 2015**

**Case Number:** T 2208/13 - 3.4.01

**Application Number:** 08724316.8

**Publication Number:** 2245696

**IPC:** H01P7/10, H01P1/208, H01P1/20,  
H01P11/00

**Language of the proceedings:** EN

**Title of invention:**  
FILTER ASSEMBLY

**Applicant:**  
Telefonaktiebolaget LM Ericsson (publ)

**Headword:**

**Relevant legal provisions:**  
RPBA Art. 11  
EPC R. 103(1)(a)

**Keyword:**  
Substantial procedural violation - (yes)  
Reimbursement of appeal fee - (yes)  
Remittal to the department of first instance - (yes)

**Decisions cited:**  
G 0002/97, T 0448/09

**Catchword:**



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Case Number: T 2208/13 - 3.4.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.01**  
**of 28 April 2015**

**Appellant:** Telefonaktiebolaget LM Ericsson (publ)  
(Applicant) 164 83 Stockholm (SE)

**Representative:** Kühn, Friedrich Heinrich; Mrs. K. Farieta  
Ericsson AB  
Patent Unit LTE  
Torshamnsgatan 23  
164 80 Stockholm (SE)

**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 8 July 2013 refusing European patent application No. 08724316.8 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** G. Assi  
**Members:** P. Fontenay  
J. Geschwind

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the examining division to refuse European patent application No. 08 724 316.8.
- II. The decision followed a communication pursuant to Rule 71(3) EPC 1973 dated 7 November 2012 in which the applicant had been informed that the examining division intended to grant a European patent on the basis of a set of claims discussed during a consultation by phone with the applicant on 27 September 2012.

In a letter dated 20 December 2012, the applicant however explicitly stated that it did not approve the text underlying the communication of 7 November 2012, submitting that the alleged approval of the amendments discussed on the phone (cf. Result of consultation, last sentence) was the result of a misunderstanding.

The applicant requested either the issuance of a new communication under Rule 71(3) EPC 1973 (on the basis of claims 1-16 as filed with the Entry into the European phase dated 3 May 2010) or the resumption of the examination proceedings.

In an annex to summons to attend oral proceedings dated 25 January 2013, the examining division then maintained objections under Articles 84, 54(1), (2) and 56 EPC 1973 previously raised by letter of 30 January 2012 and the telephone conversation of 27 September 2012.

By letter dated 28 June 2013, the applicant requested, as a main request, the cancellation of the oral proceedings and either the grant of a patent with the claims on file or the resumption of the written

proceedings to overcome possible remaining objections. As an auxiliary request, the applicant requested a decision on the file as it stood.

The decision to refuse the application according to the state of the file was then dispatched on 8 July 2013. It referred to three communications of the examination division dated, respectively, 25 January 2013, 27 September 2012 and 30 January 2012.

- III. The notice of appeal against the decision to refuse the application was filed on 20 August 2013. The appeal fee was paid on the same day. The statement setting out the grounds for the appeal was received on 15 October 2013.
  
- IV. With the grounds of appeal, the appellant requested that the decision under appeal be set aside and a new communication under Rule 71(3) EPC 1973 be issued on the basis of claims 1-16 filed as a main request with the grounds of appeal or, alternatively, that the proceedings be continued on the basis of claims 1-16 as attached to the previous communication under Rule 71(3) EPC 1973 dated 7 November 2012 with the amendments suggested by the examining division.

The appellant further requested the reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC for the reasons of substantial procedural violations which took place during the proceedings before the examining division.

- V. With regard to the examination proceedings, the appellant essentially stated the following (see grounds of appeal):

- The decision under appeal completely ignored the main request, submitted by letter of 28 June 2013, to cancel the oral proceedings to be held on 26 September 2013 and either to grant a patent on the basis of the claims then on file or to resume the written proceedings.
  - The decision under appeal referred to previous communications containing contradictory statements with regard to the assessment of novelty and inventive step.
- VI. By summons of 12 December 2014, the appellant was summoned to oral proceedings before the Board of appeal, due to take place on 19 Mai 2015.
- VII. In a communication dated 3 February 2015 pursuant to Article 15(1) RPBA, the Board expressed its provisional opinion with regard to the allegation of substantial procedural violation.

The Board noted that the requests filed by the applicant in its letter dated 28 June 2013 to cancel the oral proceedings to be held on 26 September 2013 and either to grant a patent on the basis of the claims then on file or to resume the written proceedings were not devoid of ambiguity. For this reason, the Board was not convinced by the argument according to which the examining division had actually ignored the main request filed by the applicant.

Notwithstanding this, the Board also noted the absence of any clear and consistent reasoning in the communications referred to in the decision under appeal and observed that this shortcoming could constitute a substantial procedural violation justifying the reimbursement of the appeal fee under Rule 103 EPC.

For this reason, the remittal of the case to the examining division could be envisaged under Article 11 RPBA.

The appellant was therefore invited to take position on this issue.

VIII. In a phone conversation on 24 mars 2015, the appellant indicated that it intended to file a request for a remittal of the case to the examining division, reimbursement of the appeal fee and cancellation of the oral proceedings.

These requests were confirmed in a fax received later on that same day.

IX. By disposition of 27 April 2015 the oral proceedings before the Board were cancelled.

### **Reasons for the Decision**

#### 1. *Applicable law*

It is noted that the revised version of the Convention (EPC 2000) does not apply to European patent applications pending at the time of its entry into force (13 December 2007), unless otherwise provided. In this decision, where Articles or Rules of the former version of the EPC apply, their citation is followed by the indication "1973".

#### 2. *Admissibility of the appeal*

The appeal complies with the requirements of Articles 106 to 108 EPC and Rule 99 EPC. The appeal is, thus, admissible.

3. *Substantial procedural violation*

3.1 It results from the general principle of good faith and legitimate expectations, which should prevail in relations between parties to proceedings and the instances of the EPO (cf. decision G 2/97, point 1 of the reasons; OJ 1999, 123), that the content of a decision which adversely affects a party be clear and unambiguous (cf. decision T 448/09, not published, point 2.3). This condition implies that the party affected by the decision not only be able to understand the final conclusion reached by the department concerned but also be in a position to comprehend the reasoning which lead to said conclusion without the need to recur to intensive interpretation. This condition also applies to decisions according to the state of the file.

3.2 In the present case, the decision under appeal simply refers to the communications of 25 January 2013, 27 September 2012 and 30 January 2012.

The objection of lack of novelty raised in section 1.2 of the communication of 25 January 2013 does not fulfill the above condition.

Said section is herewith reproduced *in extenso*:

*"Considering the previously raised objection under Articles 52(1), 54 (1)(2) EPC, this objection is reaffirmed since claim 1 describes the structure of D5int [US-B-6 320 484] whereby the fixing of the rod on one side of the chassis is explicitly [sic] described in fig 9b and implicitly to be repeated on the other side considering the symmetric rod and filter structure shown in fig 1."*

In particular, said section does not permit, due to its extreme concision, to identify the claimed features considered to be disclosed in the specific embodiment of Figure 9b of D5int. This appears all the more true since the further objection of lack of novelty, which had previously been raised with the communication of 30 January 2012 and which was then "reaffirmed" later on in the communication of 25 January 2013, relied on a different embodiment, namely the embodiment shown in relation with Figure 6B of D5int. Although Figures 6B and 9B appear quite similar, they do in fact refer to Figures 6A and 9A, respectively, which unambiguously relate to different embodiments (cf. D5int column 2, line 59; column 3, line 6).

Moreover, the fact that the impugned decision refers both to the communication of 25 January 2013 and the communication of 30 January 2012 leads to further uncertainty as to whether the previous objection which relied on Figure 6B was still valid or had been abandoned.

3.3 It follows that the absence of a clear and consistent reasoning in the communications referred to in the decision under appeal *de facto* deprived the appellant of the possibility to work out on which interpretation of the prior art the examining division relied to justify its objection of lack of novelty. This amounts to a substantial procedural violation.

4. *Remittal to the examining division*

Under Article 11 RPBA "A Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance



*proceedings, unless special reasons present themselves for doing otherwise".*

In the absence of special circumstances preventing the Board to remit the case and taking due account of the corresponding request filed by the appellant, the case is remitted to the examining division for further prosecution.

5. *Reimbursement of the appeal fee*

Since the Board deems the appeal to be allowable and the reimbursement of the appeal fee to be equitable by reasons of a substantial procedural violation, the appeal fee is reimbursed (Rule 103(1)(a) EPC).

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:



R. Schumacher

G. Assi

Decision electronically authenticated