

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [X] To Chairmen
(D) [-] No distribution

**Datasheet for the decision
of 5 September 2016**

Case Number: T 1825/14 - 3.5.03

Application Number: 11002792.7

Publication Number: 2373101

IPC: H04W60/00

Language of the proceedings: EN

Title of invention:

Method to inform user equipment to perform register procedure
in wireless communication system, and related communication
device

Applicant:

HTC Corporation

Headword:

Wireless communication system/HTC

Relevant legal provisions:

EPC R. 103(1) (a)

Keyword:

Substantial procedural violation - (yes)

Decisions cited:

J 0002/87, J 0014/94

Catchword:

Protection of legitimate expectations



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1825/14 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 5 September 2016

Appellant: HTC Corporation
(Applicant) No. 23, Xinghua Road
Taoyuan District
Taoyuan City 330 (TW)

Representative: Wagner, Karl H.
Wagner & Geyer Partnerschaft
Patent- und Rechtsanwälte
Gewürzmühlstrasse 5
80538 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted 2 April 2014
concerning European patent application
No. 11002792.7**

Composition of the Board:

Chairman F. van der Voort
Members: O. Loizou
B. Noll
S. Fernández de Córdoba
K. Schenkel

Summary of Facts and Submissions

- I. The applicant lodged the present appeal against the decision of the examining division dated 2 April 2014 finding as follows:
- "1. The main request for correction of the date of receipt of the submission dated 6 December 2012 [*sic*] from 7 December 2012 [*sic*] to 6 December 2012 [*sic*] is refused.
2. The auxiliary request of 8 May 2012 for further processing is granted.
3. This decision is subject to a separate appeal (Article 106(2) EPC)."
- II. The facts relevant to the present decision are summarised below.
- III. An examination report concerning the patent application in suit (application No. 11002792.7) was issued by the examining division on 27 July 2011. A period of four months for filing observations and for correcting indicated deficiencies was set, which expired on 6 December 2011.
- IV. With a letter dated 6 December 2011 the applicant requested a two-month extension of the time limit. The examining division granted this request with a communication dated 19 December 2011, thereby extending the time limit for reply to a total of six months, expiring on 6 February 2012.

- V. On 6 February 2012, the applicant filed a response to the communication dated 27 July 2011, together with amended application documents.
- VI. On 8 March 2012, the formalities officer issued a communication on behalf of the examining division, noting a loss of rights pursuant to Rule 112(1) EPC, namely that the application was deemed to be withdrawn under Article 94(4) EPC. The reason given was that the invitation to file observations on the communication from the examining division dated 27 July 2011 had not been complied with in due time, as the observations had been filed on 6 February 2012. More specifically, the applicant was informed that the "application" had been received at the EPO on 7 December 2011 and that the request for extension of the time limit had therefore been granted "erroneously", the time limit having expired on 6 December 2011. The "extension of time limit" was "considered not having been granted" and, consequently, the applicant's reply was deemed to have been received late.
- VII. By letter dated 8 May 2012 the applicant submitted a main request that "the situation" be corrected by the EPO as follows:
- "(1) the request for an extension of the time limit on December 6, 2011 was timely filed;
- (2) the extension of the time limit of December 19, 2011 was correctly granted;
- (3) the response to the Official Communication of July 27, 2011 was timely filed on February 6, 2012;
- (4) the Communication of March 8, 2012 shall be

withdrawn".

By way of a first auxiliary request the applicant requested an appealable decision under Rule 112(2) EPC and, by way of a second auxiliary request, further processing of the application under Article 121 EPC. It paid the fee for further processing.

- VIII. During oral proceedings before the examining division two witnesses, Mr Freese and Mr Schmidtbauer, were heard regarding the applicant's assertion that the submission dated 6 December 2011 had been delivered by hand on 6 December 2011 and not on 7 December 2011.
- IX. The examining division issued a written decision on 2 April 2014, cf. point I above.
- X. Oral proceedings before the board were held on 5 September 2016.

The appellant requested that the decision under appeal be set aside, and that the fee for further processing, the sum deposited for the witnesses' costs on 1 August 2013, and the appeal fee be reimbursed.

After deliberation by the board, the chairman announced the board's decision.

Reasons for the Decision

1. The appeal is admissible.
2. The board notes that the request for an extension of the time limit was initially granted by the examining

division and was thus treated as a valid procedural act.

3. Relations between the EPO and applicants are governed by the principle of good faith (J 2/87, OJ EPO 1988, 330, and J 14/94, OJ EPO, 1995, 824). Hence, if the EPO issues a communication such as - in the present case - receipt of a response within a set time limit, and then treats that response as a valid procedural act, it cannot subsequently go back on its own earlier position, especially when, as here, it has led the applicant to legitimately believe that no loss of rights has taken place.
4. In the present case, the examining division was thus prevented by its own earlier conduct from issuing the notice of loss of rights dated 8 March 2012. Hence, it should not have gone back on its earlier position, which had led the applicant to legitimately believe that no loss of rights had occurred, the time limit having been extended by the examining division's communication dated 19 December 2011. Therefore, by issuing the notice of loss of rights and not withdrawing it as requested by the applicant, the examining division committed a substantial procedural violation.
5. In view of the above, the time limit for filing observations was complied with by the letter dated 6 February 2012 and, consequently, there was no reason for the examining division to grant the request for further processing.
6. The decision under appeal is therefore to be set aside.
7. Request for reimbursement of fees

- 7.1 According to Rule 103(1)(a) EPC, the appeal fee is reimbursed where a board deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. As the appeal is allowable and the board considers reimbursement of the appeal fee to be equitable in view of the substantial procedural violation committed by the examining division, a reimbursement of the appeal fee is justified.
- 7.2 The taking of evidence was made conditional upon deposit with the EPO by the applicant of an amount for reimbursement of expenses of the witnesses (Rule 122(1) to (3) EPC). Since the witnesses have not requested any reimbursement of their costs, the deposit made by the applicant is to be reimbursed on condition that cost waivers signed by the witnesses are submitted.
8. Since, as pointed out above, there was no need to request further processing, the fee for further processing is also to be reimbursed.

Order

For these reasons it is decided that:

- The decision under appeal is set aside.
- The fee for further processing and the appeal fee are to be reimbursed.
- The sum deposited for the witnesses' costs is to be reimbursed once cost waivers signed by the witnesses have been submitted.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated