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**Datasheet for the decision
of 7 January 2019**

Case Number: T 0623/18 - 3.5.06

Application Number: 13163147.5

Publication Number: 2790101

IPC: G06F9/455, G05B19/418

Language of the proceedings: EN

Title of invention:

System and method for automated virtual commissioning of an industrial automation system

Patent Proprietor:

ABB Schweiz AG

Opponent:

Siemens Aktiengesellschaft

Headword:

Admissibility of the opposition/ABB

Relevant legal provisions:

EPC Art. 100, 101(1), 114(2)

EPC R. 76(2)(c), 77(1)

EPC 1973 Art. 99(1)

EPC 1973 R. 55(c)

RPBA Art. 20(2)

Guidelines for examination D-IV, 1.2.2.1(v)

Vienna Convention on the Law of Treaties (1986) 31, 32

Keyword:

Admissibility of opposition (yes)

Remittal to the department of first instance (yes)

Decisions cited:

T 0222/85, T 0134/88, T 0065/00, T 0521/00, T 0613/10,

G 0009/91, G 0010/91, G 0002/12, G 0003/14

Catchword:



Beschwerdekammern

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Case Number: T 0623/18 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 7 January 2019

Appellant: Siemens Aktiengesellschaft
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 17 January 2018
rejecting the opposition filed against European
patent No. 2790101 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman W. Sekretaruk
Members: M. Müller
G. Zucka

Summary of Facts and Submissions

- I. The appeal is against the decision of the opposition division, with reasons dated 17 January 2018, rejecting the opposition against European patent 2 790 101 as inadmissible pursuant to Rules 76(2) (c) and 77 EPC.

- II. The file history relevant for the present case is as follows:
 - (a) Notice of opposition was based on the grounds of opposition under Article 100(a) EPC, in combination with Articles 54 and 56 EPC, and Article 100(b) EPC, and it was requested that the patent be revoked in its entirety. Several documents were mentioned, some of which were considered in more detail in the reasons relating to the ground for opposition under Article 100(a) EPC.
 - (b) In response to the notice of opposition, the proprietor requested that the opposition be rejected as not admissible or, in the alternative, as not allowable.
 - (c) In response to a summons to oral proceedings before the opposition division, by letter dated 19 October 2017, the opponent made additional submissions in support of its opposition.
 - (d) The opposition division followed the proprietor in finding that none of the grounds for opposition was sufficiently substantiated within the meaning of Rule 76(2) (c) EPC.

- III. The opponent filed a notice of appeal against this decision on 5 March 2018 and paid the appeal fee on the same day. A statement of grounds of appeal was received on 28 May 2018. The appellant (opponent) requested that

the decision be set aside, and the patent be revoked. With a letter dated 18 September 2018, the respondent (proprietor) replied to the appellant's submissions, requesting that the appeal be dismissed.

- IV. By letter dated 13 November 2018, the board informed the parties of its intention to find the opposition admissible, to set aside the decision and, without deciding on the merits of the opposition, to remit it to the opposition division for further prosecution. In On that condition, both the appellant and the respondent, by letters dated 26 and 19 November 2018, respectively, confirmed that they did not request oral proceedings before the board of appeal.

Reasons for the Decision

The decision under appeal

1. The opposition was based on the grounds for opposition under Article 100(a) EPC, in combination with Articles 54 and 56, and Article 100(b) EPC.
- 1.1 With regard to Article 100(b), the opponent argued that claim 1 introduced a "remote data processing server" but failed to specify its relation to the preceding features of the claim relating to a "remote data processing system". For that reason it was argued that the skilled person could not carry out the invention (see the notice of opposition, page 9, point 1).
- 1.2 With regard to Article 100(a) EPC in combination with Article 54 EPC, the opponent gave reasons why, in its

view, the combination of documents D6A, D6B and D6C, which all related to the control system "AC 870P", and also document D7, disclosed all features of claim 1 at least implicitly.

1.3 With regard to Article 100(a) EPC in combination with Article 56 EPC, the opponent started from the assumption that the preamble of claim 1 was known in the prior art, stated which problem the features of the characterising portion solved over such prior art and gave reasons why, in its view, each of documents D6A, D6B and D7 disclosed a solution to that problem with all the features of the characterising portion of claim 1. Additional remarks were made on further prior-art documents.

2. In view of this, the opposition division came to the following conclusion:

2.1 With regard to Article 100(b) EPC, the opponent's reasons related merely to the clarity of the claims, which was not a ground for opposition, rather than the question whether the patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by the skilled person. Hence, the ground for opposition under Article 100(b) EPC was insufficiently substantiated (see the decision, reasons 2-2.3).

2.2 With regard to Article 100(a) EPC in combination with Article 54 EPC, the opponent's arguments failed to refer to the individual features of claim 1 and so did not enable the patent proprietor or the opposition division to reconstruct the novelty objection without making their own investigations (see reasons 3-3.2).

With regard to Article 100(a) EPC in combination with Article 56 EPC, the opponent further failed to indicate from which piece of prior art the features of the preamble of claim 1 were known (see reasons 3.3). Hence, the ground for opposition under Article 100(a) EPC was not sufficiently substantiated either. Reference in this regard was made to decision T 613/10 (see the decision under appeal, reasons 3.1).

- 2.3 The opposition division concluded that the requirements of Rule 76(2)(c) EPC were not met (see reasons 4).

The board's position

3. Rule 76(1) EPC states that "Notice of opposition shall be filed in a written reasoned statement", and Rule 76(2)(c) EPC that it shall contain "a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based, as well as an indication of the facts and evidence in support of these grounds". Rule 76(1) and (2)(c) EPC does not contain any further requirements regarding the content or quality of the notice of opposition. Article 100 EPC sets out the valid grounds for opposition. Article 101(1) EPC specifies *inter alia* that "If the opposition is admissible, the Opposition Division shall examine, in accordance with the Implementing Regulations, whether at least one ground for opposition under Article 100 prejudices the maintenance of the patent".
4. In the EPC 1973, the requirement of Rule 76(1) EPC was contained in Article 99(1) EPC 1973, 2nd sentence. Rule 55(c) EPC 1973, corresponding to Rule 76(2) EPC, states that the notice of opposition shall contain "a

statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds". That is, Rule 76(1) and (2)(c) EPC differs from the corresponding passages in Article 99(1) EPC 1973 and Rule 55(c) EPC 1973 in that an "indication of ... arguments" is no longer required. If anything, therefore, the requirements of Rule 76(1) and (2)(c) EPC are less stringent than the corresponding ones in the EPC 1973. In view of the fact, however, that a "written reasoned statement" is still required, this board considers that the omission did not change the meaning of the regulation. This also corresponds to the legislator's apparent intention (see the Decision of the Administrative Council of 12 December 2002 adopting the Implementing Regulations to the European Patent Convention 2000 and the corresponding Explanatory remarks, OJ EPO, Special Edition No. 1, 2003, pages 57 and 74-200, in particular pages 117 and 175 relating to "New Rule 55a EPC").

5. It is consistent jurisprudence of the boards of appeal, that the principles of interpretation provided for in Articles 31 and 32 of the Vienna Convention on the Law of Treaties (VCLT) are to be applied when interpreting the EPC (see, for instance, G 2/12, reasons 6, item (3)). Article 31(1) VCLT states that "A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose."
6. In its decisions G 9/91 and G 10/91, the Enlarged Board of Appeal rephrased the questions referred to it as

being *inter alia* "whether or not - or to what extent - an Opposition Division or a Board of Appeal [...] is bound by the statement of the opponent under Rule 55(c) EPC [1973] of the *extent* to which the patent is opposed and of the *grounds for opposition*" (see G 9/91, reasons 5; emphasis by this board).

- 6.1 It then asks whether it would be correct to consider that "the content of the statement of Rule 55(c) EPC [1973] only implie[d] a formal requirement for admissibility of the opposition without any further legal effect on the examination of the opposition" and answers in the negative, stating: "Rule 55(C) EPC [1973] only makes sense interpreted as having the double function of governing (together with other provisions) the admissibility of the opposition and of establishing at the same time the legal and factual framework, within which the substantive examination of the opposition in principle shall be conducted" and is to "give[] the patentee a fair chance to consider his position at an early stage of the proceedings" (see G 9/91, reasons 6).
- 6.2 In view of this, the Enlarged Board decided that "The power of an Opposition Division or a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC depends upon the extent to which the patent is opposed in the notice of opposition pursuant to Rule 55(c) EPC" 1973 and that "An Opposition Division or a Board of Appeal is not obliged to consider all the grounds for opposition referred to in Article 100 EPC, going beyond the grounds covered by the statement under Rule 55(c) EPC", with different exceptions applying to the opposition

divisions and the boards of appeal (see G 9/91 and G 10/91, headnotes).

- 6.3 The Enlarged Board thus expressed its opinion on the purpose of Rule 55(c) EPC 1973 (and thus of Rule 76(1) and (2)(c) EPC), stressing the importance of the statement under Rule 55(c) EPC 1973 for the determination of the extent of the opposition and the grounds for opposition to be examined. No conclusion can, however, be drawn from G 9/91 or G 10/91 on the required content or quality of the arguments in the statement under Rule 55(c) EPC 1973 or the written reasoned statement according to Article 99 EPC 1973 or Rule 76(1) EPC.
7. In the present case, the notice of opposition stated that the opposition challenged the granted patent in its entirety and was based on the grounds for opposition under Article 100(a) EPC in combination with Articles 54 and 56 EPC, and under Article 100(b) EPC. In support of the grounds under Article 100(a) EPC, it indicated evidence, in particular documents D6A to D6B and D7, and facts relating to what these documents allegedly disclosed and where. In support of the ground under Article 100(b) EPC, it indicated a fact, namely an alleged incoherence in terminology in claim 1 which the skilled person could not resolve on the basis of the description. There is no doubt that the notice of opposition was filed as a written reasoned statement.
- 7.1 The board also considers that the statement under Rule 76(1) and (2)(c) EPC in the notice of opposition serves its purpose as explained by the Enlarged Board. As summarised above, it defines the extent and scope of the opposition, and the legal and factual framework as

the assessment whether the facts, evidence, and reasons provided by the opponent establish that the grounds for opposition under Article 100(a) and (b) EPC prejudice the maintenance of the patent. The notice of opposition also gave the patentee a fair chance to consider his position at an early stage of the proceedings: the board notes that this position might well be that the presented facts, evidence and arguments are insufficient to establish the alleged deficiencies in the patent. Moreover, the opposition division may, under Article 114(2) EPC, disregard facts or evidence which the opponent chooses to submit after the opposition period according to Article 99 EPC.

7.2 The board therefore concludes, with a view to Article 31 VCLT, that the notice of opposition complies with the ordinary meaning of the terms of Rule 76(1) and (2)(c) EPC interpreted in their context and in the light of the object and purpose of the regulation.

7.3 The board sees no basis for requiring more from the statement under Rule 76(1) and (2)(c) EPC and, in particular, none for making admissibility of the opposition dependent on the assessment of substantive questions, which must (rather) be dealt with during examination of the opposition under Article 101 EPC. More specifically, the board considers that it is a matter of substantive examination to determine how the skilled person would interpret the claim language and whether, based on that interpretation, the skilled person was in a position to carry out the invention. It is a matter of substantive examination whether an objection merely relates to a lack of clarity, which is not a ground for opposition, or can support the ground for opposition under Article 100(b) EPC. It is also a matter of substantive examination to characterise the

person skilled in the art, for whom, according to Article 100(b) EPC, the description should be sufficiently clear and complete, and for whom obviousness over the prior art is to be assessed according to Article 100(a) EPC in combination with Article 56 EPC.

7.4 It was decided (see T 222/85, reasons 4, last paragraph) that the "requirement of Rule 55(c) [1973] will only be satisfied if there is sufficient indication of the relevant 'facts, evidence and argument[s]' (i.e. relevant to the extent of the patent which is opposed), for the reasoning and merits of the opponent's case in relation to the grounds of opposition relied upon to be properly understood by the Opposition Division and the patentee". It was further explained that "This must be assessed on an objective basis, from the point of view of a reasonably skilled man in the art to which the opposed patent relates" (*loc. cit.*; see also headnote 2). In T 613/10 it was stated (reasons 13) that the circumstances of the individual case - including *inter alia* the difficulty of the technical issues with regard to the patent and the prior art - had to be considered for the question of admissibility, in particular if, as in the case then before the board, the requirements of Rule 76(2)(c) EPC were not satisfied clearly and unambiguously.

7.5 The board does not wish to exclude the possibility that in individual cases it may already be apparent at first glance that the facts and evidence indicated in the notice of opposition cannot, by any means, "support" the stated grounds for opposition. However, at least if it is controversial whether the indicated facts and evidence can support the grounds for opposition, for instance, because they depend on the determination of

the "reasonably skilled man in the art" and what this person may or may not "properly understand", this board considers that it cannot be an admissibility criterion but must be an issue of substantive examination. It would appear that this issue will have to be considered controversial in particular if the requirements of Rule 76(2)(c) EPC are not "clearly and unambiguously" violated.

- 7.6 This board agrees with decision T 65/00 (reasons 2.1.3), which states that "Whether the relevance of the arguments brought forward or their correctness are sufficient to revoke the patent is of no importance" for admissibility of the opposition. "In this case, it is therefore irrelevant whether the arguments brought forward by the Opponent refer to Article 84 EPC or Article 83 EPC. For admissibility of the appeal, it is sufficient that the arguments are such that an arguable case is established".
- 7.7 Decision T 521/00 (reasons 4.1) expressly contradicted T 65/00, albeit only in an *obiter dictum* (see reasons 4.2), by stating that it would "undermine" the provisions of Rule 55(c) EPC 1973 "by lowering its requirements", which should not happen "all the more on the account of the fact that the Enlarged Board has stressed its significance", for instance in G 9/91. As explained above, this board does not share the view that the importance laid in G 9/91 or G 10/91 on Rule 55(c) EPC can be invoked to justify making aspects of substantive examination requirements for the admissibility of the opposition.
- 7.8 In decision T 134/88 (reasons 3), which T 521/00 followed instead of T 65/00, it was found that

"allegations which cannot be subsumed under one of the opposition grounds have to be left out of consideration" (English translation cited after T 521/00, reasons 4.1) in determining whether a ground for opposition is substantiated within the meaning of Rule 55 EPC 1973. The board tends to consider that T 65/00 and T 134/88 can be reconciled by saying that there is no "arguable case" for a ground for opposition under which no argument indicated in the notice of opposition can be subsumed.

7.9 However, this issue is immaterial for the case at hand, because the arguments in the present notice of opposition can clearly be subsumed under the indicated grounds for opposition. For the ground for opposition under Article 100(a) EPC this is evident, and for that under Article 100(b) EPC the board takes the view that questions of claim interpretation and clarity, even though not *per se* grounds for opposition, can have an impact on the issue of whether the claimed invention is sufficiently disclosed within the meaning of Article 100(b) EPC and, therefore, establish an at least "arguable case". Also the Enlarged Board has not challenged the finding that "an opponent has the right to argue that a claim is unclear or (in effect) lack support" because "the uncertain boundaries of a claim or lack of support may play a role when arguing the various grounds for opposition" (see G 3/14, point 80 (g) of the reasons).

7.10 The board therefore concludes that the perceived deficiencies in the notice of opposition according to the decision under appeal do not render the opposition inadmissible (Rule 77 EPC). The decision must therefore be set aside.

Article 20(a) RPBA

8. The Guidelines for examination, D-IV, 1.2.2.1 (v), state: "The contents of the statement of grounds must enable the patent proprietor and the opposition division to clearly understand the nature of the objection raised and the evidence and arguments adducted in its support. This entails explaining the relevant circumstances to such an extent that neither the patentee nor the opposition division needs to undertake further investigations to be able to form a definitive opinion on the grounds for opposition". They imply with reference to T 222/85 that the grounds for opposition must be "clearly presented and argued" so as to make the opposition admissible. As explained above, the board considers that Rule 76(2)(c) EPC does not require as much from the notice of opposition; in particular, whether the "written reasoned statement" enables the "patent proprietor and the opposition division to *clearly understand* the nature of the objection raised and the evidence and arguments adducted in its support" and whether "further investigations" are necessary for the patentee or the opposition division "to be able to form a *definitive opinion* on the grounds for opposition" (emphasis by the board) is, in the board's judgment, a matter for the allowability rather than the admissibility of the opposition.

Remittal for further prosecution

9. As regards the ground for opposition under Article 100(b), the opposition division limited itself to the finding that the opponent's reasons related to clarity and were therefore not pertinent. It did not

determine how the skilled person, in view of the description, would have interpreted the term "remote data processing server" and whether, in view of that, the description suffered from an insufficiency of disclosure with regard to the subject-matter of claim 1.

10. As regards the ground for opposition under Article 100(a) EPC, the opposition division limited itself to the (correct) observation that the opponent, in its notice of opposition, did not make express reference to the individual features of the claims or indicate "a concrete document as closest prior art" and concluded, that "Therefore [...] neither the patent proprietor nor the opposition division [were] able to reconstruct the objection[s] without making own investigations". It did not address the question why the person skilled in the art would be unable to understand the reasons without the missing information; for instance, why the skilled person would be unable to understand why the opponent considered a particular feature or group of features in the claims to be published in the indicated prior art.

11. These issues not being addressed in the decision under appeal, the board considers it appropriate to remit the case to the opposition division for further prosecution under Article 111(1) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sekretaruk

Decision electronically authenticated