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**Datasheet for the decision
of 15 July 2020**

Case Number: T 1414/18 - 3.5.03

Application Number: 14178323.3

Publication Number: 2830381

IPC: H04W72/04

Language of the proceedings: EN

Title of invention:

Method for configuring timing resource in device to device communication

Applicant:

HTC Corporation

Headword:

Refund of a further search fee/HTC

Relevant legal provisions:

EPC Art. 82, 92, 111(1), 113(1)

EPC R. 64(2), 103(1) (a)

RPBA 2020 Art. 11

Guidelines for examination (November 2017), F-V

Keyword:

Unity of invention - (yes): single invention
Refund of further search fee - (yes)
Substantial procedural violation - (yes)
Remittal to the first instance for further prosecution - (yes)
Reimbursement of the appeal fee - (yes): ex officio

Decisions cited:

J 0007/82, W 0011/89, W 0006/97, T 0188/00, T 0173/06,
T 1888/09, T 1476/09, T 0756/14, T 2526/17

Catchword:

(1) As to unity of invention under Article 82 EPC, only if the application relates to more than one "invention", the notion of "a single general inventive concept" under Article 82 EPC and the concept of the "same or corresponding special technical features" under Rule 44(1) EPC have to be assessed for the purpose of deciding upon unity of invention (see Reasons, point 1).

(2) As to a refund of further search fees under Rule 64(2) EPC, the decision to refuse a patent application may be understood to implicitly contain the decision to refuse the refund of a further search fee, if the examining division's intent is clear (see Reasons, point 4).

(3) A statement such as "the next procedural step will be summons to oral proceedings during which the application will be refused" made prior to a final decision to refuse a patent application may infringe a party's right to be heard and thus may lead to a substantial procedural violation (see Reasons, point 5).



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Case Number: T 1414/18 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 15 July 2020

Appellant: HTC Corporation
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Taoyuan City 330 (TW)

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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 10 November
2017 refusing European patent application
No. 14178323.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: J. Eraso Helguera
R. Winkelhofer

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing the present European patent application. The grounds for refusal of the examining division consisted of a mere reference to their latest communication pursuant to Article 94(3) EPC dated 27 March 2017.

- II. A partial European search report under Rule 64(1) EPC for the present application had been issued by the search division on 6 November 2014. In an annex to this search report ("sheet B"), the search division indicated that the application contained two inventions and thus did not meet the requirements of unity of invention. The search division found that claim 1 as well as, partially, dependent claims 3 to 13 on file related to the first invention and claim 2 to the second invention, and conducted a search for the first invention pursuant to Rule 64(1) EPC.

In addition, the applicant was invited via EPO Form 1507U to pay a further search fee within two months in order to have the second invention searched, too.

- III. After payment of the further search fee, a full European search report covering both inventions was issued on 26 March 2015.

- IV. In a communication under Article 94(3) EPC of 22 April 2015, the examining division confirmed the search division's view on lack of unity under Article 82 EPC.

- V. In their reply of 1 September 2015, the applicant contested the examining division's assessment of unity of the invention and requested a refund of the further search fee. This request was maintained by their submission of 13 June 2016.
- VI. In their further communications under Article 94(3) EPC of 3 December 2015 and 27 March 2017, the examining division maintained their non-unity objection. In particular, the communication of 27 March 2017 included the following statement (cf. point 1, last paragraph):

"In the present case, two searches needed to be performed as claim 1 discloses a broad claim relating to scheduling meanwhile claim 2 is restricted to specific features describing overlapping frames. As seen by the documents cited in the search report, two searches were performed and different documents were found."

In addition, that communication comprised the following closing (cf. points 4 and 5):

"4 As to the reimbursement of the search fee. The preliminary opinion of the examining division is to refuse the reimbursement of such fee ...

5 The next procedural step will be summons to oral proceedings during which the application will be refused (Article 97(2) EPC)."

- VII. In reaction to the above communication, the applicant withdrew the request for oral proceedings and requested an appealable "decision according to the state of the file".

VIII. In the statement of grounds of appeal, the appellant requests that the decision under appeal be set aside and, as a main request, that a patent be granted on the basis of the claims subject to the decision under appeal, or, in the alternative, on the basis of the claims of an auxiliary request filed with the statement of grounds of appeal.

It is also requested (again) that the further search fee be refunded.

IX. **Claim 1** of the main request reads as follows (amendments vis-à-vis originally filed claim 1 indicated by the board):

"A method of configuring timing resource in device to device (D2D) communication for a first user equipment (UE), the method comprising:
receiving (402) a first signal from a second UE; and reporting (404) to a network node at least one of an arriving time information and a prospective resource allocation information, whereby the network node configures timing resource for D2D communication between the first UE and the second UE;

wherein the arriving time information is an information about an arriving time related to the first signal sent from the second UE, and the prospective resource allocation information is an information about prospective resource allocation of the first UE."

Claim 2 of the main request reads as follows (amendments vis-à-vis originally filed claim 2 indicated by the board):

"A method of configuring timing resource in device to device (D2D) communication for a network node, the method comprising:

receiving (502) a report from a first user equipment (UE) comprising at least one of an arriving time information and a prospective resource allocation information, ~~wherein the first signal is a discovery signal sent to the first UE by a second UE;~~

performing (504) an estimation on whether a D2D subframe at the first UE overlap a normal uplink subframe according to the report; and

configuring (506) timing resource for D2D communication between the first UE and the second UE according to the estimation;

wherein the arriving time information is an information about an arriving time related to a first signal sent to the first UE by a second UE, and the prospective resource allocation information is an information about prospective resource allocation of the first UE, wherein the first signal is a discovery signal sent to the first UE by the second UE."

Reasons for the Decision

1. *Unity of invention - originally filed claims*
(Article 82 EPC)

1.1 According to Article 82 EPC, a patent application "shall relate to **one invention** only or to a **group of inventions** so linked as to form a single general inventive concept".

That means that only if the application relates to more

than one "invention", the notion of "a single general inventive concept" under Article 82 EPC and the concept of the "same or corresponding special technical features" under Rule 44(1) EPC come into play, i.e. have to be assessed for the purpose of deciding upon the question of unity of invention. As a consequence, it is first to be determined whether the present application covers only *one or several* "inventions".

1.2 In order to properly assess the compliance with Article 82 EPC, the underlying "invention(s)" is(are) to be established on the basis of the technical problem(s) to be solved according to the description of the application in question (see e.g. W 11/89, OJ 1993, 225, point 4.1; W 6/97, point 6.3; T 173/06, point 8; T 1888/09, point 2.1). This is apparently also endorsed by the Guidelines for Examination in its applicable edition of November 2017 (see e.g. F-V, section 8, second paragraph, and section 8.1, penultimate sentence).

1.3 In the present case, the original application as a whole (i.e. including the description and drawings) refers consistently to a single invention, the objective of which is "to provide a method to configure timing resource so that data transmission/reception for D2D communication and normal communication do not interfere with each other" (see e.g. paragraph [0008] of the description as filed). According to paragraph [0029] of the original description, "... [t]he process 50 used for the network node may be in coordination with the process 40 used for a UE ...".

Claim 1 as originally filed thus describes the invention (i.e. the solution to the above technical problem) from the perspective of the UE (i.e. reporting

arrival time and resource allocation information to the network node), whilst **claim 2** as originally filed describes the same invention from the perspective of the network node (i.e. performing, on the basis of the reported arrival time and resource allocation information, estimations on whether a D2D subframe at the first UE overlaps a normal uplink subframe). There is no hint in the application towards using the processes at the UE and at the network node independently for a different purpose, and therefore, the application must be considered as relating to one invention only.

- 1.4 In that regard, the board notes that the mere fact that the main aspect of the invention is predominantly covered by one (more limited) independent claim does not automatically mean that the complementary (broader) independent claim is related to *another* invention. In particular, this does not mean that two different searches have to be carried out to cover both independent claims.

- 1.5 As to the statement of the examining division that two searches were needed to be performed as claim 1 disclosed a broad claim relating to scheduling whilst claim 2 was restricted to specific features (cf. point VI above), the board holds that a *complete* search should not be restricted to the claims of a patent application, regardless of how broad or limited they are, but should give due consideration to the underlying description and the drawings (see Article 92 EPC).

- 1.6 For the above reasons alone, the original claims of the present application are unitary within the meaning of Article 82 EPC. Thus, the reasoning of the examining

division drawing upon the aspects of a "single general inventive concept", "special technical features" and "non-unity a-posteriori" is moot and does not need further consideration.

2. *Unity of invention - claims of the main request
(Article 82 EPC)*

Given that claims 1 and 2 of the present main request only add reference signs and include minor re-wordings (see point IX above), these claims are also unitary within the meaning of Article 82 EPC.

3. In view of the observations made in points 1 and 2 above, the decision under appeal is to be set aside.

4. *Refund of the further search fee (Rule 64(2) EPC)*

4.1 In the course of the examination proceedings, the appellant had repeatedly argued as to why they believed that unity was present, and that the further search fee paid by them should be refunded, as a direct consequence thereof.

The examining division addressed both issues in their communications of 3 December 2015 and 27 March 2017 (in line with their communication of 22 April 2015, upon which the appellant had requested a refund of the search fee), each time concluding that unity was lacking and a refund of the further search fee would have to be refused.

4.2 In the impugned decision, taken upon the appellant's request for a "decision according to the state of the file", together with the withdrawal of the request for oral proceedings (cf. point VII above), the application

was refused. Under the specific circumstances of the present case, this decision is understood as to also refuse the request for refund of the further search fee. Although a decision on the refund of further search fees should be indicated in the order of the written decision (see e.g. T 756/14, point 8), the examining division's intent to refuse the request for the refund of the search fee had been clear from their latest communication of 27 March 2017 (cf. point VI above), in line with their previous communications, directly resulting from their assessment of unity.

- 4.3 According to Rule 64(2) EPC, a further search fee (see Article 2(1), item 2 of the Rules relating to Fees) shall be refunded by the examining division or the competent board upon appeal (see Rule 100(1) EPC) if the invitation for payment of a further search fee by the search division was unjustified. This assessment is to be based on the facts and arguments presented therein by the search division and on the basis of the originally filed claims (see, *inter alia*, T 188/00, point 4.5; T 1476/09, point 3; T 2526/17, point 4.7).

As outlined above, unity of invention on the basis of the originally filed claims had incorrectly been denied by the examining division. As a consequence, the further search fee is to be refunded.

5. *Substantial procedural violation*

- 5.1 The examining division used the following statement in their latest communication of 27 March 2017 to which the impugned decision refers (see point VI above; board's emphasis):

*"The next procedural step will be summons to oral proceedings during which the application **will be refused** (Article 97(2) EPC)."*

5.2 The phrase ("will be refused") - on an objective basis - implies that, regardless of any facts or arguments the applicant could potentially have brought forward thenceforth, the application was finally to be refused under Article 97(2) EPC. This statement could therefore not be reasonably understood as indicating the likely consequence of the application to be refused, if - as e.g. stated in the examining division's communication of 3 December 2015 - no convincing arguments and appropriate amendments were presented by the applicant.

5.3 Such a conduct of the proceedings is however contrary to the very aim and purpose of the right to be heard under Article 113(1) EPC, according to which decisions of the EPO organs like a decision of an examining division to eventually refuse a patent application may only be based on grounds or evidence on which a party had indeed an opportunity to present their comments. The applicant most likely inferred from the above final phrase that any reaction to the substance of that examining division's communication was pointless since the examining division apparently had already made up their mind on the issues at stake. Accordingly and most logically, with their submission of 22 September 2017, the applicant withdrew the request for oral proceedings before the examining division and requested an appealable "decision according to the state of the file" (cf. point VII above).

6. *Reimbursement of the appeal fee (Rule 103(1)(a) EPC)*

6.1 Given that, in the present case, there is also a causal link between the above substantial procedural violation and the necessity of filing an appeal against the examining division's decision, reimbursement of the appeal fee is equitable.

6.2 Hence, reimbursement of the appeal fee is ordered on the board's own motion (see e.g. J 7/82, OJ EPO 1982, 391, headnote III).

7. *Remittal to the examining division for further prosecution (Article 111(1) EPC)*

7.1 Pursuant to Article 11 RPBA 2020, fundamental deficiencies (such as substantial procedural violations) which are apparent in the first-instance proceedings constitute "special reasons" for a remittal of an appeal case to the first-instance department for further prosecution.

7.2 Accordingly, the board has decided that the case is to be remitted to the examining division for examination of those requirements of patentability which have not been assessed yet (Article 111(1) EPC). Against this background, a discussion of the appellant's further arguments on the remaining issues would be premature.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The refund of one further search fee is ordered.
3. The case is remitted to the examining division for further prosecution.
4. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated