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**Datasheet for the decision
of 15 October 2021**

Case Number: T 2042/18 - 3.4.02

Application Number: 07747469.0

Publication Number: 2149056

IPC: G01C21/16, G01C21/30, G01S5/02,
G01S5/14, G01S19/22, G01S19/49

Language of the proceedings: EN

Title of invention:

Positioning device, method and program with absolute
positioning and relative positioning modes

Patent Proprietor:

TomTom Global Content B.V.

Opponent:

Neusoft Technology Solutions GmbH

Headword:

Relevant legal provisions:

EPC Art. 83, 100(b), 100(c), 123(2), 123(3), 113(1)
EPC R. 106
RPBA Art. 12(4)
RPBA 2020 Art. 13(2)

Keyword:

Grounds for opposition - insufficiency of disclosure (no)
Sufficiency of disclosure - (yes)
Late-filed facts - submitted with the statement of grounds of appeal - admitted (no)
Late-filed evidence - submitted with the statement of grounds of appeal - admitted (no)
Late-filed request - submitted during oral proceedings - circumstances of appeal case justify admittance (no)
Late-filed objection - circumstances of appeal case justify admittance (no)
Right to be heard - opposition procedure - substantial procedural violation (no) - appeal procedure - violation (no)
Obligation to raise objections - objection dismissed

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 2042/18 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 15 October 2021

Appellant: Neusoft Technology Solutions GmbH
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Respondent: TomTom Global Content B.V.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
12 June 2018 concerning maintenance of the
European Patent No. 2149056 in amended form.**

Composition of the Board:

Chairman R. Bekkering
Members: H. von Gronau
G. Decker

Summary of Facts and Submissions

- I. The opponent's appeal is directed against the interlocutory decision of the opposition division concerning maintenance of the European patent No. 2149056 in amended form. The opposition division was of the opinion that the patent in amended form according to the then main and sole request met the requirements of the EPC.
- II. The following documents are relevant for the present decision:

E3: US 2006/271295 A1
D7: EP 1 243 939 A1
D8: EP 0 445 719 A2
D9: US 6 850 844 B1
- III. With the statement setting out the grounds of appeal, the appellant filed documents D7 to D9 and requested that the decision of the opposition division be set aside and the patent be revoked.
- IV. The respondent (patent proprietor) requested with the reply to the appeal that the appeal be dismissed.
- V. Both parties requested that oral proceedings be held.
- VI. In a communication pursuant to Article 15(1) RPBA 2020 the board expressed its preliminary opinion that *inter alia* the documents D7 to D9, the added subject-matter objection and the lack of novelty objection based on document D7 were late filed and it had to be decided on their admission, and that the claimed invention was disclosed in a manner sufficiently clear and complete

for it to be carried out by a person skilled in the art.

VII. By letter dated 15 September 2021 the appellant argued that document D7 was highly relevant and should be admitted, and that the added subject-matter objection based on Article 100(c) EPC had been raised when filing the opposition but that this objection had been ignored or not heard by the opposition division.

VIII. Oral proceedings took place on 15 October 2021. During the oral proceedings the appellant requested as a new main request that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution. The previous sole request became its auxiliary request.

The parties stated their final requests as follows:

The appellant (opponent) requested as a main request that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution, or, as an auxiliary request, that the decision under appeal be set aside and that the patent be revoked.

The patent proprietor requested that the appeal be dismissed.

At the end of the oral proceedings the chairman announced the board's decision.

IX. Independent claims 1 and 11 as considered for maintenance by the opposition division in the interlocutory decision read as follows (The feature numbering M1 to M7 and N1 to N7 is added by the board

in line with the feature numbering used by the opposition division and the parties):

"1. [M1] Positioning device (PD) arranged to determine a position using an absolute positioning system (APS) and a relative positioning system (RPS), and [M2] further arranged to work in a first mode, in which the position is determined using the absolute positioning system, and [M3] in a second mode, in which the position is determined using the relative positioning system in combination with a starting position determined by the absolute positioning system, and [M4] being further arranged to switch from the first mode to the second mode (303), characterised in that:
[M5a] the positioning device (PD) is further arranged to keep a history file (302), the history file comprising:
[M5b] a plurality of positions previously determined by the absolute positioning system and
[M6a] an associated accuracy for each of the plurality of determined positions; and
[M6b] measurements determined by the relative positioning system, and
[M7] wherein, when a switch is made from the first mode to the second mode, the positioning device is further arranged to check the history file and to select one of the plurality of positions determined by the absolute positioning system as the starting position for the relative positioning system (304) based on the accuracy information stored in the history file."

"11. [N1] Method for determining a position, where the method comprises determining a position using an absolute positioning system and a relative positioning

system,

[N2] the position can be determined in a first mode, in which the position is determined using the absolute positioning system, and

[N3] in a second mode, in which the position is determined using the relative positioning system in combination with a starting position determined by the absolute positioning system, and

[N4] further comprises switching from the first mode to the second mode,

characterised in that the method comprises:

[N5a] keeping a history file (302) comprising:

[N5b] a plurality of positions previously determined by the absolute positioning system and

[N6a] an associated accuracy for each of the plurality of determined positions; and

[N6b] measurements determined by the relative positioning system; and,

[N7] when a switch is made from the first mode to the second mode, checking the history file and selecting one of the plurality of positions determined by the absolute positioning system as the starting position for the relative positioning system (304) based on the accuracy information stored in the history file."

Reasons for the Decision

1. The appellant's main request - remittal to the department of first instance - admittance (Article 13(2) RPBA 2020)
 - 1.1 The appellant requested during the oral proceedings before the board for the first time that the case be remitted to the opposition division because of a procedural violation in the first-instance proceedings.

The decision of the opposition division was erroneous, because it did not consider the arguments of the opponent with respect to sufficiency of disclosure. This became evident from the difference in formulation in paragraph 2.4 of the minutes of the first-instance oral proceedings and in section 3.3 of the reasons for the decision under appeal. Furthermore, the assessment of the opposition division was wrong in this respect which was evident from the disclosure of document D7. In addition, the minutes under point 1.2, last paragraph were not correct in stating that "*In view of the amendments made to claims 1 and 11, the opponent did not pursue his objection concerning Article 100(c) EPC*". During the oral proceedings before the opposition division the appellant merely considered it of little use to repeat its arguments and to discuss the inadmissible amendment. The appellant never had the intention to withdraw its objection under Article 100(c) EPC but the opposition division did erroneously not address the objection in its decision. There was no point in requesting a correction of the minutes of the oral proceedings in the first-instance proceedings, because the minutes were issued together with the decision. Therefore, it was justified to present these objections only in the grounds of appeal. Since the opposition division ignored the arguments and objection, the appellant's right to be heard was violated.

1.2 The patent proprietor was of the opinion that the appellant's right to be heard was not violated and that a remittal to the department of first instance was not justified.

1.3 The board does not see a substantial procedural violation committed by the opposition division during

the first-instance proceedings.

With respect to the assessment of lack of sufficiency of disclosure, the board is of the opinion that the formulation in section 2.4 of the minutes of the oral proceedings before the opposition division and in section 3.3 of the reasons for the decision under appeal do not differ in substance and that thus the decision is not based on arguments that have not been discussed in the oral proceedings before the opposition division.

With respect to the added subject-matter objection, the board relies on the minutes of the oral proceedings before the opposition division, the correctness of which was not questioned in the first-instance proceedings. Moreover, in the first-instance proceedings the appellant has never raised an added subject-matter objection against the amended claims filed by the patent proprietor with the letter dated 15 March 2018. In the notice of opposition the appellant objected that the addition of the expressions "at least" in granted claim 1 extended the subject-matter of the application in an inadmissible manner. In the independent claims filed with the letter dated 15 March 2018 the objected expressions were deleted. The appellant did not object to the amended wording in writing and the minutes of the oral proceedings before the opposition division only state: "*In view of the amendments made to claims 1 and 11, the opponent did not pursue his objection concerning Article 100(c) EPC*". The appellant did not contest this statement when the minutes were sent to the parties, nor did it do so in the grounds of appeal. In the grounds of appeal the appellant merely objected that the opposition division did not indicate the reasons why it considered that the

amended claims fulfilled the requirements of Article 100(c) EPC. However, the board does not consider it erroneous that the opposition division did not give reasons for the admissibility of the amendments, since, as stated in the minutes, the admissibility of the amendments in the claims was not questioned by the appellant, and evidently the opposition division did not see any reason to do so itself. If the minutes were incorrect in this respect, the appellant should have requested a correction of the minutes in order to preserve its rights (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, III.C.7.10.3), irrespective of whether the minutes were sent together with the written decision or before.

- 1.4 The board, exercising its discretion under Article 13(2) RPBA 2020 and on the basis of the arguments submitted by the appellant, comes therefore to the conclusion that the appellant's main request is not to be taken into account.
2. The appellant's auxiliary request - the patent in the version as found allowable by the opposition division - sufficiency of disclosure (Articles 83, 100(b) EPC)
 - 2.1 The appellant was of the opinion that the claimed invention was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. By deleting "at least" in the claim, feature M2 reflected the teaching that the positioning device was arranged in the first mode to determine the position only with the absolute positioning system, whereas in the second mode, the determination of the initial position was to be carried out with both the relative positioning system and the absolute positioning system. The formulation of feature

M5 defined that the history file should include measurements determined by the relative positioning system in addition to the positions previously determined by the absolute positioning system. However, no teaching could be taken from the patent as to how the history file should contain measurements determined by the relative positioning system, if according to feature M2 in the first mode only the position was determined using the absolute positioning system.

Paragraphs [0121] and [0122] of the patent referred to by the opposition division also failed to provide sufficient disclosure, as neither paragraph [0121] nor paragraph [0122] disclosed how, in the first mode, measurements were to be made by the relative positioning system in addition to the determination of the positions by the absolute positioning system. In respect of the claimed subject-matter, it was thus also not comprehensible to the skilled person how positions that had to be previously determined by the absolute positioning system described in the paragraphs [0045 continued] were then to be used as initial positions for the relative positioning system. According to paragraphs [0045 continued], the positions to be stored in the history file were determined with the absolute positioning system in real time, so that a previously determined position could not be included in the history file with measurements of the relative positioning system to be used as initial position for the relative positioning system (see grounds of appeal, section 2).

In the oral proceedings before the board the appellant added that paragraphs [0117] to [0121] of the patent made reference to a prior art teaching and could not be used as a disclosure of the claimed invention.

Furthermore the disclosure of these paragraphs was not reflected in features M2 and M3 of the claim. The claimed device excluded that in the first mode the position was determined using the relative positioning system.

- 2.2 The respondent submitted that the opposition division was entirely correct in their explanation regarding the difference between a step of obtaining measurements using the relative positioning system and a step of then using these measurements to determine a position, e.g. in the second mode. In the first mode, the position of the vehicle could be determined directly using (potentially only) the absolute position measurements. By contrast, a relative positioning system, as described in the patent, may comprise a distance meter (such as an odometer) and/or a gyroscope, or similar, that could be used to determine a relative distance travelled and bearing within the vehicle's own (local) frame of reference. By themselves, these measurements merely provided a measure of how far the vehicle has travelled, and in which direction. These measurements could therefore be obtained at any time. However, in order to determine a position from these measurements in a second mode, it was necessary to also have a starting point defined in the absolute frame of reference. The position of the vehicle could then be determined by calculating how far the vehicle had travelled from the starting point. Thus, in the second mode, the position was determined using measurements from the relative positioning system in combination with a starting position determined by the absolute positioning system. Because the invention "looked back" and selected a previously determined position to be the starting position, it was also necessary to store the relative position measurements

in the region extending between the selected starting position and the position at which the switch was made, in order to be able to interpolate from the selected starting position to the position of the switch. Thus, as described at paragraph [0120], the positioning device also stored these measurements. These measurements could still be obtained in the first mode, when the history file was being generated. However, the measurements did not need to be used to determine a position until after the switch had been made into the second mode. The history file did not therefore need to store positions determined in the second mode, and this was not what was recited in the claims. The claims therefore precisely reflected 'Embodiment 3' described at paragraphs [0117] to [0121] of the patent, such that the skilled person would have no difficulties in performing the invention (see reply to appeal, section "Sufficient Disclosure - Article 100(b) EPC" on pages 2 and 3).

In the oral proceedings before the board the respondent emphasised that the description with respect to the third embodiment, in particular paragraph [0121], provided a clear teaching of the claimed invention. The person skilled in the art had no difficulty to understand how to implement the invention. The deletion of the expression "at least" did not introduce a lack of disclosure because from the claim it was still clear that measurements determined by the relative positioning system were not identical to a position determined by the relative positioning system and that measurements determined by the relative positioning system could still be performed in the first mode when only the absolute positioning system determined the position of the vehicle.

2.3 The board shares the opinion of the respondent and the opposition division. From the claim wording it is clear that the relative positioning system provides on the one hand measurements that are stored in the history file and on the other hand determines the position in the second mode. The claim does not define that these measurements are only performed in the second mode. The measurements are stored in the history file together with positions determined by the absolute positioning system. From the patent it is clear that measurements determined by the relative positioning system are a requirement for position determination in the second mode and not an equivalent. Therefore, measurements can be performed without determining the position from these measurements. The deletion of the words "at least" in features M2 and M3 (*arranged to work in a first mode, in which the position is determined using the absolute positioning system, and in a second mode, in which the position is determined using the relative positioning system in combination with a starting position determined by the absolute positioning system*) does not exclude that in the first mode the relative positioning system determines measurements that are stored in the history file. The person skilled in the art can carry out the invention claimed in independent claims 1 and 11 with the disclosure of the patent, in particular paragraphs [0117] to [0122] which describe an embodiment of the invention and not a prior art example.

2.4 The board therefore considers the patent to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

3. The appellant's auxiliary request - the patent in the version as found allowable by the opposition division - objection of added subject-matter and extension of protection (Article 123(2) and (3) EPC) - admittance of objections (Article 12(4) RPBA 2007)

3.1 The appellant argued in the grounds of appeal that the deletion of the expressions "at least" in claim 1 gave cause for an objection of added subject-matter and extension of the protection. The opposition division did not consider this aspect and therefore the contested decision had to be set aside (see grounds of appeal, point 4).

In the oral proceedings before the board the appellant argued that an objection under Article 100(c) EPC was already raised with the notice of opposition so that the added subject-matter objection had always been in the proceedings and did not need to be introduced. A claim wording without the words "at least" and defining only one system in features M2 and M3, respectively, had no basis in the original application documents. In addition the scope of protection of the independent claims was broadened by deleting the limitation imposed by the expression "at least", because "at least" meant that e.g. not only the absolute positioning system was used but in addition a further unit which, due to the deletion of "at least", was no longer required.

3.2 The respondent put forward that such objections were not pursued by the appellant during the first-instance opposition proceedings so that there were no such objections for the decision to address. Since it was a new objection it should not be admitted in the appeal proceedings (see reply, section "Added-Subject Matter - Article 100(c) EPC").

In the oral proceedings before the board the respondent submitted that the claims were amended to overcome the added subject-matter objection of the appellant and the appellant did not raise an added subject-matter objection against the present claims in the proceedings at first instance. In addition the amendment by deleting the words "at least" did not add subject-matter not originally disclosed. The originally filed claims defined: *"in a first mode, in which the position is determined using the absolute positioning system and possibly the relative positioning system, and in a second mode, in which the position is determined using the relative positioning system and possibly the absolute positioning system"*. The word "possibly" made clear that the subsequent feature was an optional feature and deleting the optional feature could not add subject-matter. The deletion of the expression "at least" did plainly not broaden the scope of protection. The device of claim 1 was now restricted to the use of the absolute positioning device in the first mode and the relative positioning device in the second mode to determine the position. The wording "at least" did not mean a requirement in the sense of "and more" but an option.

- 3.3 The board notes that the appellant explicitly did not raise objections under Article 123(2) and (3) EPC with respect to the current claims 1 and 11 during the first-instance opposition proceedings (see in particular minutes of the oral proceedings before the opposition division, point 1.2, last sentence). The opposition division did not raise such an objection of its own motion either and concluded in the decision under appeal that the amended patent and the invention to which it relates met the requirements of the EPC,

which includes the requirements of Article 123 EPC. The appellant did not give any reasons why it could not raise such objections in the first-instance proceedings, although the claims were filed well ahead of the oral proceedings before the opposition division. Therefore, the objections could and should have been filed in first instance proceedings. The board has therefore the discretion not to admit the objection filed with the grounds of appeal in accordance with Article 12(4) RPBA 2007.

In view of the arguments put forward by the respondent the board cannot see *prima facie* that these objections are clearly convincing.

3.4 Therefore, the board, exercising its discretion under Article 12(4) RPBA 2007, did not admit into the proceedings the objection of added subject-matter within the meaning of Article 123(2) EPC and the objection of unallowable extension of protection within the meaning of Article 123(3) EPC.

3.5 Objection under Rule 106 EPC

The appellant raised in writing an objection under Rule 106 EPC during the oral proceedings. It objected that its right to be heard had been infringed in that the opponent had not been allowed to pursue the ground for opposition under Article 100(c) EPC which was part of the proceedings at first instance. More specifically, the opposition division took the liberty of considering the ground for opposition settled without the express consent of the opponent, and the board agreed with the opinion of the opposition division and considered further factual arguments submitted with the grounds of appeal inadmissible.

Text of the written submission in the submitted language:

"Es wird hiermit nach R. 106 EPÜ gerügt, dass eine Verletzung des rechtlichen Gehörs dergestalt erfolgt ist, dass der Einsprechenden nicht erlaubt wurde, den Einspruchsgrund gem. Art. 100(c) EPÜ weiterzuverfolgen, der Teil des erstinstanzlichen Verfahrens war. Konkret hat sich die Einspruchsabteilung erlaubt, den Einspruchsgrund - ohne ausdrückliche Zustimmung der Einsprechenden - als erledigt anzusehen, und die Beschwerdekammer hat sich der Meinung der Einspruchsabteilung angeschlossen und weiteren Sachvortrag aus dem Schriftsatz (sic) zur Einspruchsbeschwerde als unzulässig abgelehnt."

The board is of the opinion that the appellant's objection of added subject-matter against the patent as amended with the claims filed on 15 March 2018 has been raised for the first time in the appeal proceedings and therefore that it is within the discretion of the board under Article 12(4) RPBA 2007 not to admit the objection (see above). The board does not see a violation of the appellant's right to be heard in this respect. The appellant had the opportunity to comment on the question of admittance. The board did not share the view of the appellant and, using the criteria relevant to Article 12(4) RPBA 2007, decided not to admit this late objection into the proceedings.

Therefore the board dismissed the appellant's objection under Rule 106 EPC.

4. Documents D7 to D9 - admittance (Article 12(4) RPBA 2007)

4.1 The appellant filed document D7 and raised an objection of lack of novelty with respect to document D7 for the first time with the grounds of appeal (see grounds of appeal, point 5). The appellant also filed documents D8 and D9, but did not provide any arguments as to their relevance. The appellant did not give any reasons either why it could not file these documents earlier.

In the oral proceedings before the board the appellant argued that in the reply to the appeal the respondent had already presented arguments with respect to the relevance of document D7 and therefore accepted the admission of this document. Document D7 was highly relevant and should be admitted. Also documents D8 and D9 should be admitted in the appeal proceedings.

4.2 The respondent submitted that document D7 was plainly not relevant to the novelty of the present claims (see reply, section "Novelty - Article 100(a) EPC").

In the oral proceedings before the board the respondent argued that it had not accepted the admission of the novelty objection and the related documents, but only had to be prepared for a *prima facie* assessment of these documents. Document D7 was not more relevant than document E3 and documents D8 and D9 were even less relevant. The respondent could not see any reasons why the new documents should be admitted in appeal proceedings.

4.3 In the present case, the appellant did not file documents D7 to D9 during the first-instance opposition proceedings and did not raise a novelty attack based on document D7 so that the opposition division could not take them into account in its decision. The present

claims were filed well in advance of the oral proceedings before the opposition division and the appellant had enough time to raise such a novelty objection in the first-instance proceedings. The appellant has not given any reasons why it might have been hindered by the course of the proceedings to file documents D7 to D9 and to raise the lack of novelty objection based on document D7 in the first-instance proceedings. The board has therefore discretion not to admit documents D7 to D9 filed with the grounds of appeal in accordance with Article 12(4) RPBA 2007.

- 4.4 Therefore, the board, exercising its discretion under Article 12(4) RPBA 2007, did not admit documents D7 to D9 into the proceedings, as they could and should have been presented in the first instance proceedings.
5. Claim 1 - objection of lack of novelty with respect to document E3 - admittance (Article 13(2) RPBA 2020)
 - 5.1 In the oral proceedings before the board the appellant wished to argue for the first time in the appeal proceedings on lack of novelty of the subject-matter of claim 1 of the patent in the version as found allowable by the opposition division with respect to document E3. The appellant saw exceptional circumstances in the assessment of the features M2 and M3 and the interpretation that in the first mode also measurements were performed.
 - 5.2 The respondent could not recognise exceptional circumstances that justified admittance of a novelty attack with document E3 for the first time in the appeal proceedings during the oral proceedings. The analysis of the claim wording was the same in the proceedings at first instance.

- 5.3 The board sees no reason why the appellant was prevented from upholding this objection, which was raised during the opposition proceedings, with the statement of grounds of appeal. Instead, it decided to drop it in the appeal proceedings up to the oral proceedings and to base its appeal case, as far as lack of novelty was concerned, exclusively on document D7. Therefore, neither the respondent nor the board had to expect that the appellant would bring up again this objection at this late stage of the proceedings.
- 5.4 The board therefore decided that the objection of lack of novelty with respect to document E3 is not taken into account in accordance with Article 13(2) RPBA 2020 as the board failed to see any exceptional circumstances.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated