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**Datasheet for the decision
of 20 June 2023**

Case Number: T 2381/19 - 3.4.03

Application Number: 15179928.5

Publication Number: 2991012

IPC: G06Q10/10, H04L12/58, H04W4/02

Language of the proceedings: EN

Title of invention:

METHOD, SYSTEM AND APPARATUS FOR LOCATION-BASED AND TIME-BASED
DELIVERY OF MESSAGES USING TEXT-BASED TAGS

Applicant:

BlackBerry Limited

Headword:

Relevant legal provisions:

EPC Art. 97(2), 106(1), 109(1), 109(2), 111(1), 123(2)
EPC R. 103(1)(a)

Keyword:

Amendments - allowable (no)
Interlocutory revision - substantial procedural violation (no)
- reimbursement of appeal fee (no) - reformatio in peius (no)

Decisions cited:

J 0005/08, T 0919/95

Catchword:

1. Two successive appeals, interlocutory revision, request for reimbursing first or second appeal fee.
2. Giving one single ground for the refusal, presently a violation of Article 123(2) EPC, may not be procedurally optimal, but is in itself not a procedural violation. Depending on the subject-matter claimed, it can be a defensible procedure to refrain from examining certain substantive issues, such as inventive step and novelty, as long as the division is not convinced that the potential distinguishing features have a proper basis under Article 123(2) EPC. An erroneous assessment of a substantive issue by the division is not a substantial procedural violation, either. In sum, there was no basis for the ordering of the reimbursement of the (first) appeal fee in the decision allowing the interlocutory revision (Reasons 5.9).
3. The board notes that the applicant may not have been able to avoid paying the second appeal fee in all circumstances. Even assuming for the sake of argument that the division would not have allowed the interlocutory revision and instead would have referred the first appeal to the Board of Appeal under Article 109(2) EPC, the payment of a second appeal fee might still have become unavoidable. Since the first refusal decision only dealt with added subject-matter, it would still have been quite likely that the case would have been remitted to the examining division for examination of the outstanding substantive issues even after a successful (first) appeal (Reasons 5.13).
4. Once the examining division reopens the examination, it is formally not prevented from re-examining all the issues which were already the subject of the previous decision. The principle of prohibition of reformatio in peius does not apply in this situation (Reasons 5.18).



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Case Number: T 2381/19 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 20 June 2023

Appellant: BlackBerry Limited
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 11 April 2019
refusing European patent application No.
15179928.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman T. Häusser
Members: A. Böhm-Pélissier
T. Bokor

Summary of Facts and Submissions

- I. The appeal is against the decision of the examination division to refuse the European patent application 15 179 928 (Articles 84, 123(2), 52(1) and 56 EPC).
- II. A first refusal (based on objections under Article 123(2) EPC) was appealed with letter of 20 July 2018. Interlocutory revision was granted (Article 109(1) EPC) and the examination continued, but the application was refused a second time (based on objections under Articles 84, 123(2), 52(1) and 56 EPC) at the end of a second oral proceedings. A second appeal was filed on 11 June 2019, and was not allowed by the examining division (Article 109(2) EPC).
- III. The appellant (applicant) **requests** that the decision under appeal be set aside and a patent be granted on the basis of the main request as filed during oral proceedings before the board or one of the 1st to 4th auxiliary requests, all filed with the statement setting out the grounds of appeal concerning the first appeal, also underlying the impugned decision. They also request the reimbursement of the appeal fee (Rule 103(1) (a) EPC).
- IV. **Claim 1** according to the **main request** reads as follows:
- (Feature labelling (B), (C), (D), ... and highlighting [additions/ deletions] of amendments with respect to claim 1 of the main request as discussed before the examining division were inserted by the board)

(B) A portable electronic device (101) configured for wireless communications, the portable electronic device (101) comprising:

(C) a processor (120), a memory (122), a display (126), a user input device (128) and a communication interface (124) implemented as one or more radios and configured to communicate with a network 107 via a link (109-1), the link (109-1) including a wireless link, the processor (120) configured to:

(D) receive, at the processor (120), a message and an address of a destination device (105), said receiving comprising generation, by a user of device (101), of the message in a graphic user interface (GUI) at the display (126);

(E) wherein the message comprises text for delivery to the destination device (105),

(G) the text comprising a text-based tag, the tag comprising one or more keywords associated with one or more of a location and a time to deliver the message to the destination device (105);

(H) wherein (i) when the one or more keywords are associated with the location, the tag further comprises a first given textual character designating that one or more of the keywords are associated with the location; and when the one or more keywords are associated with the time, the tag further comprises a second given textual character designating that one or more of the keywords are associated with the time, the second given textual character different from the first textual character

(I) or (ii) the tag comprises the one or more of the keywords without further comprising the first given textual character or the second given textual character;

(J) process, at the processor (120), the tag to associate one or more of the location and the time with

the message by extracting the one or more keywords from the tag;

(K) and, comparing the one or more keywords to one or more of a first contact file stored in a memory (122) of the portable electronic device (101) and associated with the address and a calendar file associated with the address to extract one or more of the location and the time from one or more of the first contact file and the calendar file;

(L) wherein, ~~if the tag does not further comprise the first given textual character or the second given textual character~~ comprises the one or more of the keywords without further comprising the first given textual character or the second given textual character, and the one or more keywords include a location name for which an address is not included in the first contact file, said processing comprises inputting one or more keywords in the text to a contact file (160) and, if the one or more keywords include a location name,

(M) populating the tag with a location from a second contact file (160) stored in a memory (122) of the portable electronic device (101) and associated with the location name that includes an address,

(N) whereby the address is extracted from the second contact file (160) and the address is added to the location name, said populating comprising recognizing other keywords in the message (1101) and automatically populating a location-based tag (1105) when an address associated with the one or more keywords is found using the second contact file (160); and,

(O) transmit, using the communication interface (124) and via the wireless link, the message for delivery to the destination device (105) using the address, at one or more of the location and the time.

V. **Claim 1** according to the **1st auxiliary request** differs from claim 1 of the main request underlying the impugned decision (i.e. with feature (L) in unamended form labelled (L')) in that essentially features (A) and (P) to (Q) cited below are added in alphabetic order:

(A) *A system (100) for location and time-based messaging using textual tags, the system (100) comprising a sending device (101), a server (103), a destination device (105), in communication using at least one communication network (107), and components for determining a current location of the device (105) which can be determined and transmitted to the server (103), wherein the sending device (101) comprises a*

(L') wherein, if the tag does not further comprise the first given textual character or the second given textual character, said processing comprises inputting one or more keywords in the text to a contact file (160) and, if the one or more keywords include a location name,

(P) wherein the server (103) comprises a processor (151) interconnected with a memory (152) and a communication interface (154) and

(Q) the processor (151) is configured to receive the transmitted message; and if the tag does not further comprise the first given textual character or the second given textual character or an address associated with the one or more keywords was found using the second contact file (160), process the tag to associate a location with the message by: extracting the one or more keywords from the tag, inputting the one or more keywords to a mapping application (190)

stored in the memory (152), the mapping application (190) being configured to query a mapping server, and receiving the location (601) from the mapping application (190); receive current locations (701) of the destination device (105) from the components of the network (107) for determining a current location;

(S) and, when destination device (105) is within a given distance from the location (601) received from the mapping application (190), transmit the message to the destination device (105) using the address (503).

VI. **Claim 1** according to the **2nd auxiliary request** differs from claim 1 of the 1st auxiliary request in that essentially Features (F), (R) and (T) are added in alphabetic order:

(F) the destination device (105) being a portable electronic device configured to communicate with a network (107) via a second link (109-3), the second link including a wireless link,

(R) the components using triangulation techniques to determine locations of device (105);

(T) via the second link (109-3).

VII. **Claim 1** according to the **3rd auxiliary request** differs from claim 1 of the 2nd auxiliary request in that essentially features (J)/(K)/(P) are replaced by features (J3)/(K3)/(P3) and features (U) to (Y) are added in alphabetic order:

(J3) process, at the processor (120), the tag to associate ~~one or more of the location and the time~~ with

the message by extracting the one or more keywords from the tag;

(K3) and, comparing the one or more keywords to ~~one or more of~~ a first contact file stored in a memory (122) of the portable electronic device (101) and associated with the address ~~and a calendar file associated with the address~~ to extract ~~one or more of~~ the location and ~~the time from one or more of~~ the first contact file ~~and the calendar file~~;

(P3) wherein the server (103) comprises a processor (151) interconnected with a memory (152) ~~and, a communication interface (154) and a time device, the time device being used by processor (151) to determine a current time; and wherein~~

(U); wherein, where the tag in the transmitted message comprises one or more keywords associated with a time to deliver the message, the processor (151) of the server (103) is further configured to

(V) process the tag to associate the time with the message by extracting the one or more keywords from the tag;

(W) and, comparing the one or more keywords to a calendar file (165) stored in the memory (152 [sic] of the server (103) and associated with the address to extract the time from the calendar file;

(X) and transmit the message for delivery to the destination device (105) using the address, at the time corresponding to the one or more keywords by:

(Y) determining a current time; and, when the time is about equal to the current time, transmitting the message to the destination device (105).

VIII. **Claim 1** according to the **4th Auxiliary Request** differs from claim 1 of the 3rd auxiliary request in that feature (Z) is added in alphabetic order:

(Z) ; and wherein the text comprises an expiry tag indicating that, if conditions specified in tags of the message are not met within a time period specified in a tag, the message is not delivered.

IX. The appellant **argued** essentially as follows in relation to added subject-matter:

- (a) Features (J) and (K) were *inter alia* based on original claims 1 and 2 and features (L) to (N) were based on the embodiment according to Figure 11 (here "4th scenario", paragraphs [0091] to [0093]) which was a specific implementation of original claims 1 and 2.
- (b) The 4th scenario referred back (paragraph [0091], first sentence) to another embodiment (e.g. "1st scenario" shown in Figure 5). Therefore, two scenarios were incorporated into the claim, the 1st scenario (features (D) to (K)) corresponding to the *first contact file* and the 4th scenario (features (L) to (N)) corresponding to the *second contact file*. Paragraph [0050] provided basis for two distinct contact files.
- (c) The skilled person knew how scanning and mapping of a keyword was to be implemented for the scenarios, if the keyword was not identifiable by a special textual character.
- (d) The same reasoning applied to the auxiliary requests.

X. In the statement setting out the grounds of appeal and in the course of the oral proceedings the appellant

argued essentially as follows in relation to the request for reimbursement of the appeal fee:

- (a) The second decision of the examining division repeated the same Article 123(2) EPC objections as the first decision. This was a misuse of the procedure foreseen by Article 109 EPC, and constituted a substantial procedural violation.
- (b) The first appealed decision was very brief, and only raised one single objection under Article 123(2) EPC. The appellant could assume that only this objection was in the way of the grant. Unexpectedly, the second decision raised additional objections, thus demonstrating that the first decision was manifestly incomplete. The second decision effectively improved the position of the examining division at the cost of the applicant.
- (c) There was no proper explanation how the first decision could have been set aside if it was not wrong in substance. This showed that the examining division ought to have forwarded the first appeal to the board, instead of setting it aside.
- (d) The fee refund should be possible in the present case even when the second appeal was not successful. The second appeal may have been avoided, and it would have been possible to finish the procedure with less costs, e.g. by withdrawing the appeal after a first appeal procedure solely on the issue of added subject-matter.

Reasons for the Decision

1. The appeal is admissible.

2. **The invention as claimed**

- 2.1 In the use of portable electronic devices, typically mobile phones and the like, it is known to provide for location and time-based messaging. For this purpose special interfaces are normally used to specify a location and/or a time for delivering a message (email, SMS, etc.). Such interfaces generally need to be provided as add-ons to and/or in applications different from, a messaging application, such that a user is required to exit a messaging GUI and enter a GUI for specifying a location and/or time for delivering the message (paragraph [0112] of the description of the application).
- 2.2 The invention proposes an implementation of location and time-based messaging using textual tags integrated within the text of a message (email, SMS). The textual tags may concern locations ("#work", "dark Horse coffee shop") or time-related keywords ("free time"). The tags may comprise significant textual characters ("#", "*") to identify keywords as tags, but the invention also contemplates solutions where the use of such special textual characters is not required. These locations and time-based textual tags (delivery conditions related to a location or delivery time) obviate the need for additional applications and interfaces.

3. **Main Request - Article 123(2) EPC**

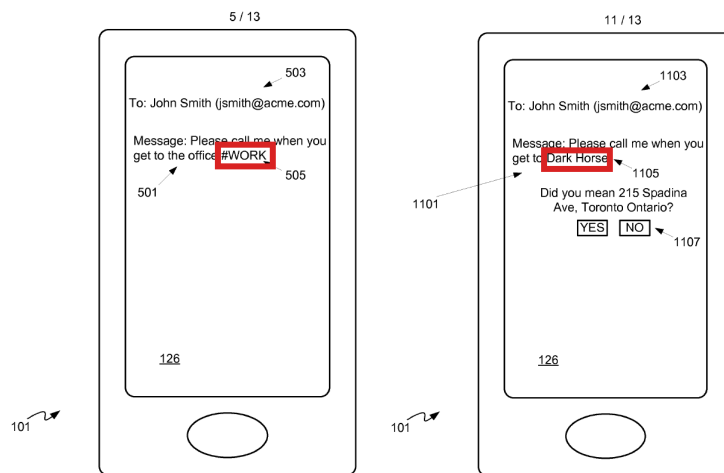
3.1 **Amendments**

Claim 1 was amended in that the processor (120) extracts a keyword and compares *the one or more keywords to one or more of a first contact file (feature(K)) and populates the tag with a location from a second contact file (160) (feature (M)) and recognizes other keywords in the message (1101) and*

automatically populates a location-based tag (1105) when an address associated with the one or more keywords is found using the second contact file (160) (feature (N)) for mapping an address to the keyword.

The first contact file corresponds to the 1st scenario, the second contact file corresponds to the 4th scenario. The appellant argued that these amendments of claim 1 were based on paragraphs [0050], [0075], [0091] to [0096], [0098] and [0099], claims 1 and 2, and Figures 5 and 11 of the application as originally filed.

3.2 Addition of originally undisclosed subject matter



Application, Figures 5 and 11, board's highlighting (□) of the keywords

3.2.1 *Features (J) and (K)* correspond to the features of the originally filed claims 1 and 2 and correspond in the context of new claim 1 to the embodiment of the "1st scenario" (paragraph [0075], Figure 5), in which an address corresponding to a keyword is stored in the (first) contact file. This address is extracted in processor 120 and used for the delivery condition related to a location. In this 1st scenario, the keyword is marked by a special textual character. This

marking with a symbol ("#" or "*") has the effect that the keyword can be identified and the corresponding address can directly be queried in a look-up table.

- 3.2.2 *Features (L) and (M) are based on the 4th scenario, i.e. the embodiment described with respect to Fig. 11 (paragraphs [0091] to [0093]). In this 4th scenario, the keywords are not identifiable by a special character ("#" or "*"). Therefore, the whole email has to be searched for keywords that could be used as a delivery condition for a location. No address is stored for the keyword in the (first) contact file and a corresponding location or address must be found in a mapping application for each keyword that could be used when a delivery condition related to a location. This address might also be found in a second contact file.*
- 3.2.3 Page 18, lines 2 to 4 of the description of the application discloses that *processor 120 inputs one or more words of text into mapping location 170 to determine if any words of text of message 1101 comprises one or more keywords that could represent a text-based location tag.* This implies that potential keywords are extracted from the email (which could be a long text containing a plurality of potential keywords), that an evaluation is made as to whether they could be a delivery condition related to a location, that an address is mapped on the portable device for all potential keywords related to a location, and that a final selection is made as to which of a variety of keywords is selected and processed.
- 3.2.4 The appellant argued that although the 1st and 4th scenarios were combined in amended claim 1, each scenario by itself, as well as the combination of both

scenarios fell within the wording of original claims 1 and 2.

3.2.5 However, the board is of the opinion that present claim 1 is formulated in such a way that when no special textual characters are used and the keywords include a location name (see the conditions in feature (L)), aspects of the 1st scenario (features (J) and (K)) and aspects of the 4th scenario (features (L) and (M)) are both executed one after the other. Such a combination is however not disclosed in the original application documents.

3.2.6 According to claim 1 (features (H) and (I)) there is the possibility of marking the keywords with special textual characters. This is intended to relate to the 1st scenario. However, since features (J) and (K) relating to the 1st scenario contain no conditions, the processing according to these features is to be carried out also when no special textual characters are used; in that case the further processing specified in features (L) and (M) relating to the 4th scenario is to be carried out afterwards. There is no basis in the original application documents for such mixing of scenarios. In particular, accessing the first contact file in the 1st scenario without using special characters is originally undisclosed, because the 1st scenario is characterized by the fact that the keywords are marked with "#" or "*".

3.2.7 Paragraph [0091] only discloses "*when device 105 is at an address that is not located at contact file 160*" as a connection point to the 1st scenario and as a starting point for the separate 4th scenario. The board is however of the opinion that this passage and the rest of the application does not directly and

unambiguously disclose the claimed combination of the 1st and 4th scenarios.

3.2.8 Consequently, the subject-matter of claim 1 of the main request extends beyond the disclosure of the original application and violates Article 123(2) EPC.

4. **1st to 4th auxiliary Request**

The same objections discussed for the main request apply *mutatis mutandis* to the auxiliary requests, because all these requests comprise a combination of the 1st and 4th scenario. This was not disputed by the appellant.

5. **Procedural violation - reimbursement of the appeal fee**

5.1 According to Rule 103(1)(a) EPC, the reimbursement of an appeal fee is to be ordered if the following conditions are fulfilled:

- (i) where the board of appeal deems an appeal to be allowable; and
- (ii) if such reimbursement is equitable by reason of a substantial procedural violation.

5.2 The appellant argues that the "misuse of the rectification procedure by the Examining Division to add further objections to their first Decision while maintaining the added-matter objection is considered a substantial procedural violation which justifies the reimbursement of the appeal fee" (page 5, last paragraph in the statement setting out the grounds of appeal). The appellant also submits that by not forwarding the appeal to the Boards of Appeal the procedure in the first instance was extended by one

year with the result that the application was refused a second time (*inter alia* with the same reasoning) and the appellant had to pay a second appeal fee.

- 5.3 However, the appellant did not explain specifically which legal provisions of the EPC or possibly which instructions of the Guidelines have been violated and how, beyond stating a misuse of the possibility of an interlocutory revision under Article 109 EPC.
- 5.4 The board can agree with the appellant that it is not desirable and might even appear generally inequitable if an applicant were forced to pay multiple appeal fees for the examination leading to the same or similar refusal grounds. This can, at least theoretically, lead to an effective perpetuation of the examination procedure, without ever giving the applicant the chance to have its case examined by a Board of Appeal, while forcing it to pay multiple appeal fees. However, the necessity to file repeated appeals and to pay multiple appeal fees may arise also without a substantial procedural violation, as demonstrated by the present case.
- 5.5 The purpose of Article 109 EPC is that the examining divisions can correct their own decisions in case of an appeal, so that the case does not have to be prolonged by a full and proper appeal procedure where the appeal appears manifestly allowable, e.g. if requests or facts have not been taken into account, and a remittal would be expected following the appeal (see also T 0919/95, point 2 of the Reasons, referring to the preparatory works of the EPC: "*The purpose of this provision is to shorten the appeal procedure in clear cases and not to refer these issues to the Board of Appeal with its complicated procedure at all*").

5.6 In the present case the examining division granted interlocutory revision by a separate decision dated 26 November 2018. This decision did not revise the decision in the sense of immediately replacing it with a decision dealing with the substantive issues, but only set the decision aside and continued the examination proceedings ("cassatory revision", cf. J 5/08 (point 19 of the Reasons), T 0919/95 (point 2 of the Reasons, last paragraph), both cited in the "Case Law of the Boards of Appeal of the EPO" [CLBA], 10th edition, 2022, section V.A.2.9.5). In its second decision refusing the application, the division added additional objections (under Articles 123(2), 84, 52(1) and 56 EPC), although the requests remained unchanged. This is not recommended by the Guidelines, but is possible (Guidelines E-XII, 7.4.1, version of November 2018). In this case, the Guidelines provide that the Examining Division should order the reimbursement of one appeal fee if a substantial procedural violation occurred (Guidelines E-XII, 7.4.1). However, this was not the case here and no reimbursement was ordered. The appellant also did not argue in its first appeal that a substantial procedural violation occurred in the procedure leading to the issuance of the first refusal. It also did not argue in its second appeal that *not reimbursing the first appeal fee* in the interlocutory decision in itself constituted a procedural violation.

5.7 Furthermore, the Guidelines recommend that if the requests remain unchanged - as in the present case - and the objections that led to the refusal are upheld (in the present case the objections under Article 123(2) EPC), the examining division should refer the appeal to the Boards of Appeal within three months (Guidelines E-XII, 7.4.1).

- 5.8 However, as the appellant also observes, these parts of the Guidelines also state that if the applicant *"has filed an appeal but no amended claims, the division checks whether the decision was correct in substance. Interlocutory revision is only allowed if the decision was not correct in substance. ... If interlocutory revision is made **and new objections arise**, the division communicates these objections to the applicant as often as necessary to reach a final decision on the file; this could include holding oral proceedings (again) and/or a second refusal"* (board's emphasis), see version of November 2018, E-XII, 7.4.1.
- 5.9 As noted above in point 5.6, the appellant did not argue and the board does not see that the refusal of the application in the first decision was tainted with a procedural violation so serious that it may have justified the refund of the (first) appeal fee. Giving one single ground for the refusal, presently a violation of Article 123(2) EPC, may not be procedurally optimal, but is in itself not a procedural violation. Depending on the subject-matter claimed, it can be a defensible procedure to refrain from examining certain substantive issues, such as inventive step and novelty, as long as the division is not convinced that the potential distinguishing features have a proper basis under Article 123(2) EPC. An erroneous assessment of a substantive issue by the division is not a substantial procedural violation, either. In sum, there was no basis for the ordering of the reimbursement of the (first) appeal fee in the decision allowing the interlocutory revision (see point 5.6 above).
- 5.10 So the question remains if there are good reasons for the reimbursement of the *second appeal fee*, that is the

fee for the present appeal. The possibility for reimbursing an appeal fee under Rule 103(1)(a) EPC serves the purpose of compensating an appellant who had to file an appeal unnecessarily due to a substantial procedural violation committed by the first instance.

- 5.11 In order to establish such a substantial procedural violation in connection with the second appeal, the board must be convinced that the procedure following the first appeal was tainted with some serious error, and the division ought have conducted the procedure differently under any circumstances.
- 5.12 Such a serious error in the procedure leading to the second refusal decision is also not apparent. It is not clear to the board how the examining division could have proceeded differently following the grant of the interlocutory revision and the rectification of the first refusal decision. As explained above in point 5.8, the Guidelines do not prohibit the raising of new objections even where the requests remain the same. This happened in the present case and the division not only maintained and possibly repeated the objections under Article 123(2) EPC, but also raised in particular inventive step objections. In view of these objections, the applicant could not have reasonably expected the grant of the patent without a further refusal following the decision to grant the interlocutory revision. Put differently, already these additional inventive step objections made the payment of the further appeal fee necessary.
- 5.13 The board notes that the applicant may not have been able to avoid paying the second appeal fee in all circumstances. Even assuming for the sake of argument that the division would not have allowed the

interlocutory revision and instead would have referred the first appeal to the Board of Appeal under Article 109(2) EPC, the payment of a second appeal fee might still have become unavoidable. Since the first refusal decision only dealt with added subject-matter, it would still have been quite likely that the case would have been remitted to the examining division for examination of the outstanding substantive issues even after a successful (first) appeal. This, in turn, would have led to a second decision which would have had essentially the same outcome as the decision underlying the second appeal (at least on the issue of inventive step, even assuming that all Article 123(2) EPC issues had been resolved before the board), with the difference that the procedure would have taken even longer to arrive at this second refusal and, consequently, at the second appeal.

- 5.14 Finally, the board points out that the appellant's conduct of the proceedings leading to the first refusing decision does not appear to have made the proceedings more efficient. There the applicant requested oral proceedings, and stated later that such oral proceedings were actually not preferred, but were not withdrawn either. Only one day before the oral proceedings did the applicant inform the examining division that they would not attend. Had the applicant appeared, they might possibly have overcome the single Article 123(2) EPC objection, which might have avoided the issuance of the first refusal decision altogether.
- 5.15 This opinion of the board concerning the procedural violation committed by the examining division, was already part of the preliminary opinion of the board pursuant to Article 15(1) RPBA, dated 20 January 2023 (essentially verbatim as set out in points 5.3 to 5.14

above). The appellant did not refute the majority of these findings of the Board at the oral proceedings, but still argued that the reimbursement was equitable, on the basis of arguments as set out above in point X, sections (b)-(d) of the facts and submissions.

5.16 These arguments are not considered to be convincing. Firstly, there is no basis for the appellant's argument that it had a legitimate expectation that the examining division's decision to allow the appeal under Article 109(1) EPC should inevitably have been followed by a decision to grant the patent. This cannot be inferred from the plain wording of Article 109(1) EPC, which requires only a decision by the examining division as to whether or not the appeal is likely to succeed. This is a different and much more limited matter than the decision on the final grant of the patent, for which all the requirements of the EPC have to be examined. It also follows from the provisions of Article 109(2) EPC that even the positive decision of the division to allow the appeal must be taken within the time limit of three months specified in that article. All these factors point to an examination procedure which, at most, allows examination of the issues raised in the appeal, but cannot guarantee that the full examination required for a grant decision will also be carried out. On the other hand, it is generally in the interest of the applicant that unresolved issues are addressed before the second appealable decision is issued by the examining division, if the division considers such additional issues to be relevant. It therefore remains the case that the proceedings may well continue with a second decision still refusing the application. See also T 0919/95, point 2.2 of the Reasons, second paragraph: *"An interlocutory decision setting aside the contested decision is in itself only a preparatory*

measure for the final decision on grant of the patent, to be taken within the - short - period specified in Article 109(2) EPC, which, if it does not yet contain a clear indication in the sense of a grant, cannot be regarded as such and thus does not give rise to any protection of legitimate expectations pointing to a positive decision".

5.17 The above considerations also explain why, in the procedure under Article 109 EPC, it is not excluded that the decision may be set aside (implying that it has been found to be wrong on the merits) and a second decision may be issued reopening an issue that has already been decided. If the examining division considers that the appeal is likely to succeed but that the patent cannot be granted on the basis of the claims in the file - simply because all the requirements of the EPC have not yet been fully examined, so that neither a positive nor a negative decision is foreseeable - it has practically no choice but to set aside the decision. Otherwise, there would be no legal basis for the examining division to issue further communications and to summon the applicant to oral proceedings in order to continue the examination. The pending appeal would not only suspend the legal effects of the impugned decision (Article 106(1), second sentence, EPC), but would also deprive the division of its usual powers, since with the appeal these powers are automatically transferred to the board dealing with the appeal as soon as it receives the appeal (devolutive effect of the appeal, see CLBA, section V.A.1.4).

5.18 However, once the examining division reopens the examination, it is formally not prevented from re-examining all the issues which were already the subject

of the previous decision. The principle of prohibition of *reformatio in peius* does not apply in this situation. As explained above, the decision whether or not to allow interlocutory revision must be taken by the examining division relatively expeditiously and only on the basis of the first decision and the appeal against it. However, once the substantive examination of the application is reopened, the ensuing in-depth examination of the case with respect to other patentability requirements may well reveal that the problems under Article 123(2) EPC are still not resolved, as the present proceedings before the board have shown. It is therefore certainly undesirable, but not excluded, that the same issues are raised again in a second decision of the examining division.

5.19 Finally, the board does not dispute that the proceedings could also have been terminated earlier and that the appellant could indeed have decided not to pursue the appeal already after the first appeal proceedings. The board understands this argument as an attempt to show that the appellant would not have had to pay two appeal fees under any circumstances. However, it is not possible to draw the inverse conclusion from this fact, namely that the necessity to pay a second appeal fee is already an indication of a substantial procedural violation, when this might not have been necessary in the circumstances of the underlying case, assuming certain possible, but still hypothetical, outcomes of the case. As the board has explained in point 5.13 above, the payment of the second appeal fee may also have occurred on the basis of what the appellant considered to be a correct procedure under the Guidelines.

5.20 Consequently, the board holds that there is no basis for the reimbursement of the second appeal fee, as no procedural violation is apparent and a reimbursement also does not appear equitable for other reasons. The question of whether reimbursement would be possible in view of the requirement of a successful appeal on the merits (Rule 103(1)(a) EPC: "... , where the Board of Appeal deems an appeal to be allowable, ..."), but also in view of the relatively unusual procedural situation of the two successive appeals, which form the core of the request for reimbursement, can be left unanswered.

6. Conclusions

6.1 Since the subject-matter of respective claim 1 of the main request and 1st to 4th auxiliary requests extends beyond the subject-matter originally filed, the examining division's decision refusing the application is confirmed. Consequently, the appeal has to be dismissed (Articles 97(2) and 111(1) EPC).

6.2 The board could not identify a substantial procedural violation neither for the first nor for the second decision of the examining division. Consequently, the request for the reimbursement of the appeal fee must be refused (Rule 103(1)(a) EPC).

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for the reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



S. Sánchez Chiquero

T. Häusser

Decision electronically authenticated