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**Datasheet for the decision
of 24 June 2021**

Case Number: T 2431/19 - 3.5.03

Application Number: 14151069.3

Publication Number: 2765758

IPC: H04L29/12

Language of the proceedings: EN

Title of invention:

Network address management and functional object discovery system

Applicant:

Harman International Industries, Inc.

Headword:

Partial search/HARMAN

Relevant legal provisions:

EPC Art. 92, 111(1)

EPC R. 63, 103(1)(a), 137(5)

RPBA 2020 Art. 11, 12(8)

Guidelines for Examination, November 2018 edition, F-IV, 3.3 and H-II, 6.2

Keyword:

Decision in written proceedings (yes)
Substantial procedural violation - (yes): erroneous application of R. 137(5) EPC
Amended claims relating to unsearched subject-matter in accordance with R. 63 EPC - (no)
Additional search necessary - (no)
Reimbursement of the appeal fee - (yes)
Remittal to the examining division - (yes)

Decisions cited:

T 1242/04, T 1873/06, T 0789/07, T 1126/11, T 0233/12,
T 1775/12, T 1895/13, T 1520/14, T 2324/14, T 0390/18

Catchword:

Rule 137(5) EPC provides for a mandatory requirement that amended claims must fulfil to be allowable. Relating to *substantive* law rather than to *procedural* law, Rule 137(5) EPC does not provide a legal basis for the exercise of discretion. The non-admittance of an amended set of claims on the basis of that Rule alone therefore constitutes a substantial procedural violation under Rule 103(1)(a) EPC (see point 2.2 of the Reasons).



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Case Number: T 2431/19 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 24 June 2021

Appellant: Harman International Industries, Inc.
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Stamford, CT 06901 (US)

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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 16 April 2019
refusing European patent application
No. 14151069.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: K. Peirs
N. Obrovski

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing the present European patent application "for lack of compliance with Article 113(2) EPC" as a result of the examining division not admitting the sole claim request of the applicant into the proceedings under Rule 137(5), second sentence, EPC.
- II. The appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the claim request which was not admitted into the examination proceedings.

The board understands that the appellant further requests, as an auxiliary measure, that the case be remitted to the examining division for further prosecution of this claim request.

Moreover, the appellant requests that the appeal fee be reimbursed on the grounds that the examining division committed a substantial procedural violation by refusing to perform an additional search.

Oral proceedings are requested in the event that the board is minded to dismiss the appeal.

- III. **Claim 1** of the claim request underlying the decision under appeal reads as follows (additions with respect to original claim 1 are underlined whereas deletions from original claim 1 are in bold with strike-through):

"A network manager (102) configured to manage address resolution in a network communication system

(100), the network manager (102) comprising:
a network interface (204) in communication with a network (110);
a processor (P) in communication with the network interface (204), the processor configured to:
detect an electronic device (104; 106) connected in the network communication system (100), wherein the electronic device (104; 106) **comprising** comprises a plurality of functional objects (230, 232; 234, 236), each one of the functional objects (230, 232; 234, 236) belonging to a class;
for a functional object (230, 232; 234, 236) of the plurality of functional objects (230, 232; 234, 236), assign an instance identification (ID) instantiating the functional object (230, 232; 234, 236) within **a** the class to which ~~the functional object~~ it belongs, and a network address for the functional object (230, 232; 234, 236); and
update a database to include the instance ID associated with the network address for the functional object (230, 232; 234, 236)."

Reasons for the Decision

1. *Decision in written proceedings*

The appellant requests oral proceedings in the event that the board is minded to dismiss the appeal (cf. point II above). In view of the board's decision to set aside the decision under appeal and to remit the case to the examining division in accordance with the appellant's auxiliary request, the decision may be handed down in written proceedings (Article 12(8) RPBA 2020).

2. **Review of the non-admittance decision on the basis of Rule 137(5) EPC**

2.1 In point II.11 of the decision under appeal, the examining division stated that "[t]he amended claims [...] cannot be admitted into the procedure pursuant [to] Rule 137(5) EPC", and in point II.15 that they "are not admitted in the procedure pursuant to Rule 137(5) EPC". In the absence of any (admitted) claims in the proceedings, the examining division refused the application (cf. Article 78(1)(c) EPC).

2.2 The board understands from these conclusions that the examining division invoked Rule 137(5) EPC to exercise a *discretion* with respect to the admittance of the applicant's sole claim request.

The board is aware that the Guidelines for Examination in the EPO uses terminology relating to "admittance" in connection with Rule 137(5) EPC (see, for instance, the applicable edition of November 2018, F-IV, 3.3, fourth paragraph: "such amendments may not be admitted"; H-II, 6.2, third paragraph: "such amendments are not admissible"). Moreover, some decisions (e.g. **T 789/07**, Facts and Submissions II and Reasons 11) apparently endorse the reliance on Rule 137(5) EPC regarding a discretionary decision in first-instance proceedings on admittance of a claim request into the proceedings.

However, the board holds that Rule 137(5) EPC, as opposed to Rule 137(3) EPC, does **not** confer any discretionary power to the examining division for the reasons set out below:

2.2.1 Rule 137(3) EPC provides that "[n]o further amendment may be made **without the consent** of the Examining

Division" (board's emphasis). In the context of Rule 137(1) and (2) EPC, this means that any second and further amendment to the description, claims and drawings of a European patent application requires the consent of the examining division. This makes the admittance of such a further amendment a matter of discretion for the examining division (see e.g. **T 233/12**, Reasons 6). The admittance of an amendment under Rule 137(3) EPC is a *procedural* matter which is distinct from matters relating to *substantive* law (see **T 1775/12**, Reasons 8 and 8.1).

2.2.2 Rule 137(5) EPC, by contrast, stipulates the following (board's emphasis):

*"Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. **Nor may they** relate to subject-matter not searched in accordance with Rule 62a or Rule 63".*

2.2.3 Thus, Rule 137(5) EPC does not refer to the act of *making* an amendment, but rather to the amended claims themselves. More specifically, the phrase "amended claims may not" or "nor may they" in Rule 137(5) EPC expresses - in the form of a prohibition - a *substantive* and *mandatory* requirement for amended claims to be allowable. This requirement does not leave any room for discretion on the part of the deciding body. Accordingly, and contrary to Rule 137(3) EPC, there is no reference to consent by the examining division in Rule 137(5) EPC. Rule 137(5) EPC hence relates to a matter of **substantive** law rather than to a matter of **procedural** law. It lays down substantive requirements, non-compliance with which leads to the refusal of a European patent application under Article 97(2) EPC (cf. **T 1126/11**, Reasons 3.5).

The Board further refers to the Office's Notice dated 1 June 1995, OJ 1995, 409 on the introduction of Rule 86(4) EPC 1973, i.e. the predecessor of Rule 137(5) EPC (see in particular pages 420 and 421, points 1 to 3; board's emphasis):

"1. Hitherto, the Convention contained nothing to stop applicants switching to unsearched subject-matter in the reply to the first communication from the examiner ...

3. The EPC however assumes that a search fee **must always** be paid for an invention presented for examination (see G 2/92). This implicitly **rules out** amendments to the application which circumvent this principle. New Rule 86(4) [Rule 137(5) EPC] makes this clear ...".

In the board's view, this statement likewise expresses that Rule 137(5) EPC does not confer any discretionary power to an examining division.

- 2.2.4 In the context of allowability, Rule 137(5) EPC is to be applied independently of Rule 137(3) EPC (cf. **T 1126/11**, Reasons 3.5). However, in the context of exercising discretionary power under Rule 137(3) EPC, an examining division may deny their consent to an amendment because of *prima facie* deficiencies (cf. **T 2324/14**, Reasons 2.3). *Prima facie* deficiencies concern requirements of substantive law. Hence, they may also concern a deficiency under Rule 137(5) EPC (cf. **T 1520/14**, Reasons 2.1; **T 390/18**, Facts and Submissions IV and Reasons 2.3). Rule 137(5) EPC does not, however, provide a separate legal basis for taking a discretionary decision on the admittance of amended claims which could be relied upon independently from Rule 137(3) EPC.
- 2.2.5 Moreover, the question whether a patent application is refused on the grounds that a sole claim request is *not*

admitted into the examination proceedings or is *not held allowable* under Rule 137(5) EPC does not constitute merely a trifle or an academic issue. The difference between such an assessment *in full* and in a *prima facie* way in the context of admittance is that the latter does not extend beyond what is necessary to justify the non-admittance decision (see **T 2324/14**, Reasons 2.2.2). Furthermore, such "[a] *prima facie* judgment is one which is made at first sight and is commonly understood to be one assumed to be correct until proven otherwise" so that it "may not survive further scrutiny and may turn out to be incorrect on further investigation" (cf. **T 2324/14**, Reasons 2.4). Thus, it can indeed be decisive for the outcome of a case whether a claim set is examined only in a *prima facie* way or in full.

2.3 In the present case, the examining division took a decision on the **admittance** of the claim request and based this decision exclusively on Rule 137(5), second sentence, EPC, i.e. without reference to Rule 137(3) EPC in conjunction with the well-established criterion of "clear allowability". However, relying exclusively on Rule 137(5) EPC would have required the examining division to examine compliance with that provision *in full*, not only in a *prima facie* way in the context of an admittance decision. Alternatively, the examining division could have relied on Rule 137(3) EPC as a legal basis for exercising discretion in the context of an admittance decision. Having done neither, the examining decision exercised discretion on the basis of a Rule - i.e. Rule 137(5) EPC - which does not confer any discretion (see point 2.2.3 above).

2.4 It follows from the above that the examining division exceeded the limits of their discretionary power. In

other words, the incorrect interpretation and application of Rule 137(5) EPC in the present case constitutes a *substantial procedural violation* within the meaning of Rule 103(1)(a) EPC as well as a *fundamental deficiency* under Article 11 RPBA 2020, justifying a remittal to the examining division for further prosecution (Article 111(1) EPC).

3. ***Compliance of claim 1 with Rule 137(5), second sentence, EPC***

3.1 The appellant requested a remittal for further prosecution on the basis of the set of claims which was not admitted into the examination proceedings (cf. point II above). In view of this request and the need for procedural economy, the board considers it expedient to provide also guidance on whether claim 1 complies with Rule 137(5), second sentence, EPC.

3.2 *The search phase*

3.2.1 The requirements for performing a search and drawing up a European search report are laid down in Article 92 EPC (board's emphasis):

"The European Patent Office shall, in accordance with the Implementing Regulations, draw up and publish a European search report in respect of the European patent application on the basis of the claims, **with due regard to the description and any drawings.**"

In addition, Rule 63 EPC relating to the exceptional option of an "incomplete search" reads as follows (board's emphasis):

"(1) If the European Patent Office considers that the European patent application fails to such an extent to comply with this Convention that it is **impossible to carry out a meaningful search**

regarding the state of the art on the basis of all or some of the subject-matter claimed, it shall invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched.

...
(3) When a partial search report has been drawn up, the Examining Division shall invite the applicant to restrict the claims to the subject-matter searched **unless it finds that the objection under paragraph 1 is not justified.**"

- 3.2.2 From the partial European search report and the reasons for the limitation of the search provided on "sheet C" of that search report, it is apparent that the search division deemed a search only to be meaningfully possible for the features explicitly described in the (original) claims. Accordingly, point II.12 of the appealed decision states that the "search division has restricted the search to the features explicitly described in the claims, excluding the optional features of the description that were not explicitly present in the searched claims".
- 3.2.3 The search division invoked Rule 63(1) EPC to restrict the search and, accordingly, to draw up a *partial* European search report because it deemed the application not to fulfil the requirements of Articles 83 and 84 EPC. In particular, the search division had indicated that "the application has, de facto, no technical feature" because the verbs in the description as a whole "are always used in conjunction with the word 'may'" (cf. "sheet C" of the partial European search report and point 2 of the European search opinion issued together with that search report).
- 3.2.4 Prior to drawing up the partial European search report, the search division had issued an invitation to indicate the subject-matter to be searched, stating

that, due to the excessive use of the word "may" in the description, no "meaningful search of the whole claimed subject-matter" could be carried out. In reply to this invitation, the applicant argued *inter alia* that

- the search should be made on the basis of the claims;
- the claims did not include one single optional feature;
- the broadening language used in the description, particularly in view of the word "may", did not prevent the search division to construe the claims;
- a *Rule 63(1) EPC declaration* replacing the search report should be issued only in exceptional circumstances, which was not the case here.

3.2.5 While insufficient disclosure or claims lacking support may indeed warrant a situation where Rule 63(1) EPC applies, the board notes with respect to the intended scope of the search and, in particular, the extent to which it should rely on the description that Article 92 EPC stipulates to draw up the European search report "on the basis of the claims, with due regard to the description and any drawings".

Concerning the expression "with due regard" in this Article, the board concurs with the conclusions drawn in **T 789/07** (Reasons 5.2) that the description and drawings should be considered in the search as a source for any amendments that are likely to occur during examination proceedings (see also Guidelines for Examination, edition of November 2018, B-III, 3.5). In cases where it is difficult for the search division to anticipate such "likely amendments" or where the search division's assessment proved to be inadequate, it is within the discretion of the examining division to

conduct an "additional search" (cf. point 3.3.8 below).

A prerequisite under Rule 63(1) EPC is that it must be "impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed" (emphasis added). In the current case, this prerequisite was not met, given that the search was carried out by the search division with regard to all of the original claims. Moreover, as regards Rule 63(2) EPC, the arguments provided by the applicant with the reply to the invitation to indicate the subject-matter to be searched seem to have been sufficient to overcome the deficiency noted in that invitation (cf. point 3.3.6 below).

3.3 *The examination phase*

3.3.1 Given that a search division's decision to restrict the search is not subject to appeal and thus cannot be overturned (cf. **T 1895/13**, Reasons 3, last paragraph), it must be assessed whether the examining division, being of the opinion that present claim 1 comprises amendments relating to unsearched subject-matter (cf. points 3.3.3 and 3.3.4 below), should have conducted an "additional search" (see e.g. **T 1873/06**, Reasons 4.2; see also Guidelines for Examination, edition of November 2018, B-II, 4.2(i) and C-IV, 7.2(i)).

3.3.2 While the impugned decision does not expressly identify the actual amendments made to the independent claims (the examining division apparently contenting themselves with the mere attachment of the pending and the original claims to the impugned decision), it is immediately apparent - as highlighted in point III above - that the amendments to claim 1 relate to the *electronic device* comprising "a plurality of functional

objects, each one of the functional objects [...] belonging to a class" rather than "a functional object [...] within a class to which the functional object belongs" (emphasis added in both citations).

- 3.3.3 Thus, the subject-matter to which present claim 1 relates and which the examining division must have deemed to be "unsearched" in the appealed decision can only consist of the feature that the electronic device comprises more than one functional object, each belonging to a class.
- 3.3.4 According to points II.12 and II.13 of the decision under appeal, the examining division endorsed the search division's approach. In particular, the examining division confirmed the deficiencies under Articles 83 and 84 EPC referred to by the search division to be indeed such that "no meaningful search" was possible within the meaning of Rule 63(1) EPC. Points II.13.1.1 and II.13.1.2 of the appealed decision seem to reflect the examining division's view that the skilled person would have understood "every single feature of the invention" to be "optional" because of an excessive use of the word "may" in the description.
- 3.3.5 In that regard, it has to be emphasised that Rule 63(1) EPC constitutes an exception and must as such be interpreted narrowly (cf. **T 1242/04**, Reasons 8.2, referring to Rule 45 EPC 1973 there). Against this background, a frequent use of the word "may" - which is not uncommon in the description of a patent application - does on no account warrant *per se* a restriction of the search pursuant to Rule 63(1) EPC.
- 3.3.6 Moreover, points II.13.1.1 and II.13.1.2 of the appealed decision provide an analysis of the

description in relation to the person skilled in the art, but only *linguistic* rather than *technical* skills were attributed to this skilled person. In that context, the board notes that original claim 1 does not comprise a single feature that is "optional". Hence, starting from original claim 1 and drawing upon their common general knowledge, the person skilled in the field of the present application would have analysed the seemingly *optional* features of the description from a technical perspective and would have filtered out those features that necessarily make up the invention or that are likely to be used to amend the claims. Such a technical analysis has not been brought forward, neither in the partial European search report, nor in the European search opinion, nor in the decision under appeal.

- 3.3.7 Consequently, the board considers that it was not justified to invoke Rule 63(1) EPC to restrict the search based on the alleged deficiencies under Articles 83 and 84 EPC.
- 3.3.8 At the same time, however, the extent to which the examination of present claim 1 was impeded by the restriction of the search by the search division under Rule 63(1) EPC must be assessed. As set out in point 3.3.2 above, present claim 1 differs from original claim 1 in the *electronic device* which is mentioned in these claims. The board notes that the "electronic device" is not part of the claimed "network manager": it is related to the network manager merely through its use. This use is however unaffected by the amendments to claim 1 because only one of the plurality of functional objects is considered in the interaction between the claimed "network manager" and the "electronic device". Consequently, the network manager

of present claim 1 **must** be the same as the network manager of original claim 1. Since the search division apparently included original claim 1 in their search (cf. point 3.2.2 above), the results of this search must be relevant for present claim 1 as well. As a result and contrary to the appellant's point of view (cf. point II above), no "additional search" was actually required, although for different reasons than those which have been put forward by the examining division. Under these circumstances, the fact that no additional search was conducted by the examining division can, taken by itself, not justify a finding of a substantial procedural violation.

3.3.9 As to the compliance of claim 1 with the requirements of Rule 137(5), second sentence, EPC, it should be emphasised first that the expression "subject-matter not searched in accordance with Rule 62a or Rule 63" of that provision must necessarily relate to claimed subject-matter (see in this respect the term "subject-matter claimed" in Rule 63(1) and (2) EPC as well as the requirement in Rule 63(3) EPC to restrict the claims to the subject-matter searched; emphasis added). While present claim 1 may somehow relate to unsearched subject-matter *per se*, such unsearched subject-matter was not part of the *claimed* subject-matter (cf. point 3.3.8 above). Hence, present claim 1 **cannot** relate to subject-matter **not searched** within the meaning of Rule 137(5), second sentence, EPC.

3.4 In conclusion, even if the examining division had correctly based their exercise of discretion on Rule 137(3) EPC, it would have exercised its discretion in an unreasonable way when not admitting the amended claims due to an alleged *prima facie* contravention of Rule 137(5), second sentence, EPC.

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

4.1 The substantial procedural violation mentioned in point 2.4 above had a direct impact on the outcome of the examination proceedings, i.e. the refusal of the present application.

4.2 It is therefore "equitable" to reimburse the appeal fee under Rule 103(1) (a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated