

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 4 November 2022**

**Case Number:** T 0158/21 - 3.5.02

**Application Number:** 10184050.2

**Publication Number:** 2270930

**IPC:** H01R13/646

**Language of the proceedings:** EN

**Title of invention:**

Electrical connector with improved crosstalk compensation

**Applicant:**

Panduit Corporation

**Relevant legal provisions:**

EPC R. 139, 137(5), 103(1)(a)

RPBA 2020 Art. 13(2), 11

EPC Art. 109(1)

**Keyword:**

Correction of error - set of claims - immediately evident that nothing else could have been intended (no)

Amendments - amended claims relating to unsearched subject-matter

Amendment after summons - exceptional circumstances (no)

Remittal - fundamental deficiency in first-instance proceedings (no)

Reimbursement of appeal fee - substantial procedural violation (no) - Interlocutory revision

**Decisions cited:**

G 0001/12, T 0647/93, T 0919/95, J 0037/89



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0158/21 - 3.5.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.02**  
**of 4 November 2022**

**Appellant:** Panduit Corporation  
(Applicant) 17301 S. Ridgeland Avenue  
Tinley Park, IL 60477 (US)

**Representative:** Roberts, Gwilym Vaughan  
Kilburn & Strode LLP  
Lacon London  
84 Theobalds Road  
London WC1X 8NL (GB)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 30 September  
2020 refusing European patent application No.  
10184050.2 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** R. Lord  
**Members:** G. Flyng  
W. Ungler

## **Summary of Facts and Submissions**

- I. The appeal contests the Examining Division's decision to refuse European patent application no. 10184050.2.
- II. In the contested decision, the Examining Division considered the applicant's main request and its first auxiliary request. The Examining Division held that the applicant's main request, i.e. the request for correction under Rule 139 EPC, was not allowable. The applicant requested in essence that the set of claims annexed to the electronically filed application as pdf-file be replaced by the set of claims contained in the zip-file which was also attached to the electronically filed application. Furthermore, the Examining Division held that also the applicant's first auxiliary request, i.e. that the set of claims contained in the zip-file be admitted as an amendment to the claims, was not allowable. The Examining Division refused the application "as none of the requests on file fulfils the requirements of the EPC".
- III. The appellant requested in its statement of grounds that the decision under appeal be set aside and a patent be granted (main request). The appellant requested further that the case be remitted to the Examining Division for further prosecution. Moreover the appellant noted as follows: "*We file herewith a set of claims on which we would like examination of this application to be based.*"  
In its notice of appeal the appellant requested also remittal of the case due to a procedural violation.
- IV. By communication under Rule 100(2) EPC the Board set out its preliminary observations according to which an

introduction into the proceedings of the set of claims attached to the statement of grounds of appeal was considered allowable neither by way of correction under Rule 139 EPC nor by way of an amendment to the application documents (Rule 137(5) EPC).

- V. In a letter of 5 July 2022 the appellant replied to the Board's preliminary opinion and emphasised in particular the importance of the principle of protection of legitimate expectations in the present case in view of several procedural violations which had occurred during the first instance proceedings.
- VI. The Board summoned the appellant to oral proceedings, confirming its preliminary observations in a communication pursuant to Article 15(1) RPBA 2020. In addition the Board explained its position as regards the applicability of the principle of protection of legitimate expectations in the present case.
- VII. Oral proceedings were held with the party's agreement by means of videoconference on 4 November 2022. At the oral proceedings before the Board the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the claims as re-filed with the grounds of appeal on the basis of a correction of the originally filed claims (main request), or on the basis of the same claims viewed as an amendment of the originally filed claims (first auxiliary request). As a further auxiliary request the appellant requested remittal of the case to the Examining Division for further examination of these claims. The appellant also requested reimbursement of the appeal fee for the present appeal. In addition the appellant requested remittal of the case to the

Examining Division for further examination of the originally filed claims ("EP2").

VIII. The appellant's submissions are dealt with in detail in the Reasons for the present decision.

### Reasons for the Decision

1. By its main request and its first auxiliary request the appellant aims to introduce the set of claims attached to the statement of grounds of appeal into the first instance proceedings by way of correction under Rule 139 EPC (main request) or by way of an amendment to the application documents (first auxiliary request). Thus, the question has to be dealt with as to whether this set of claims could be accepted to form the basis for any further examination under Article 94 EPC.

2. Main request - request for correction

2.1 The present application was filed on 30 September 2010 as a divisional application of European patent application 08008642.4. One day later, i.e. on 1 October 2010, a further divisional application to EP 08008642.4 was filed under the application number EP 10075635.2. When the present divisional application was filed electronically various documents were attached, including two sets of claims, one set in a pdf-file, the other in a zip-file:

44-B Technical documents	Original file name:	System file name:
B-1	Specification P41632EP2 - Claims - 300910.pdf 15 claims	SPECEPO-1.pdf
B-2	Specification P41632EP2 - Abstract - 300910.pdf abstract	SPECEPO-2.pdf
B-3	Pre-conversion archive P41632EP4 - Claims - 300910.zip	OLF-ARCHIVE.zip

2.2 According to the appellant's submissions the pdf-file containing the set of claims was erroneously attached to the present application. That version of the claims was meant for the divisional application filed one day later, i.e. for EP 10075635.2. However, the correct set of claims was contained in the zip-file electronically attached to the application form. The fact that an error had occurred could be seen from the file names containing the representative's reference numbers for the different applications. The pdf-file contained the reference number ('P41632EP2') for the divisional application filed on 1 October 2010 and the zip-file contained the reference number for the present application, i.e. the correct reference number P41632EP4. According to the appellant the error was detected after receipt of the European search opinion in December 2010. Thereafter, the request for correction by replacement of the set of claims was sent by letter of 20 December 2010.

2.3 Rule 139 EPC, first sentence, allows the correction of linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office. Thus, the rule deals with cases in which an error of expression in a declaration has occurred or a mistake in a document is the consequence of an error (cf. G 1/12, point 34 of the Reasons). As a preliminary remark it is noted that in the present case the request for correction is not directed to the correction of an error in the set of claims filed as pdf-file, but is directed to the replacement of a document, i.e. a set of claims by another set of claims filed as zip-file. Both files were submitted in electronic form as part of the package of documents filed with the request for grant of a European patent.

2.4 Furthermore it is noted that the set of claims contained in the zip-file was sent as a "pre-conversion" file as indicated in the EPO Form 1001E. Such a pre-conversion file is foreseen to be attached if the document attached to the application form (in the present case the pdf-file of the claims) has been prepared by conversion from a different electronic document format. The aim of this is to have the original file available in the case of corruption of the document due to the format conversion. Thus, the pre-conversion file is meant to be taken into account only in order to solve problems which are due to the conversion of document formats. In the present case the set of claims contained in the pdf-file did not show any sign of corruption. Thus, there was no need for the EPO to consult the pre-conversion file before establishing the extended European search report. Thus, the search report and the search opinion were rightly based on the set of claims contained in the pdf-file. With the request for correction the appellant pursues the goal that a different set of claims is taken as a basis for any further examination of the application in suit, although the search and the search opinion were rightly based on a substantively different set of claims.

2.5 According to Rule 139 EPC, second sentence, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction, if the request for such correction concerns the description, claims or drawings. The Board concurs with the appellant insofar as it appears evident that an error occurred when filing the present application in view of the different reference numbers used for the pdf- and



the zip-file. However, it is by no means obvious whether the mistake lay in the filing of an incorrect set of claims as pdf-file or whether the reference numbers themselves were incorrectly chosen. In that regard it is noted that also the file containing the abstract for the application in suit used the reference number P41632**EP2** in the file name, i.e. the allegedly incorrect reference number. If the reference numbers were erroneous themselves, the pdf-file could be considered to contain the correct version of the claims, i.e. the set of claims actually intended to be filed for the application in suit. Thus, it is not evident whether the wrong set of claims was attached as pdf-file to EPO Form 1001E or whether the reference number used for the name of that pdf-file was erroneously chosen. Thus, in view of the fact that even the kind of the error cannot be identified in an unambiguous way, it is also not immediately evident how it should be corrected. Thus, it is not evident that the correction offered, i.e. the replacement of the set of claims contained in the pdf-file by the set of claims contained in the zip-file, was in line with the original intention when filing the application in suit. The appellant's argument that the filing of two divisional applications with identical claims could not be considered as a rational behaviour is not convincing since such a filing is not forbidden by the law and might be based on legal, strategic and/or procedural reasons. Furthermore, it is noted that, even if it was accepted that the error lay in the attachment of the wrong set of claims as pdf-file, it would not be immediately evident that the set of claims contained in the zip-file was intended to be pursued in the present application. Thus, even under that assumption the correction would not be allowable.

2.6 As regards the principle of protection of legitimate expectations the following is noted in addition: According to the appellant the Examining Division based its (substantive) examination on the (corrected) version of the claims as filed with letter of 20 December 2010. This allegation is based on the Examining Division's communication dated 1 June 2016 referring explicitly to the set of claims filed with letter of 20 December 2010. However, in that context it should be taken into consideration that the appellant had previously been informed about the fact that the Examining Division would have to decide about the request for correction of the set of claims (cf. communication from the Receiving Section dated 26 January 2011). No such decision had been taken when the Examining Division's communication of 1 June 2016 was issued. Thus, the appellant should have had doubts about the correctness of the reference to the version of the claims as contained in the Examining Division's communication of 1 June 2016. In the Annex to the summons to oral proceedings of 23 April 2018 the appellant was informed of the Examining Division's intention to refuse the request for correction of the set of claims. In view of the above it is evident that the Examining Division did not base its (substantive) examination on the corrected version of the claims.

2.7 Furthermore, the appellant referred to the fact that the corrected version of the set of claims appeared on the (European Patent) Register. However, in that regard it is to be noted that the documents which can be accessed via the Register do not form the authentic (and complete) version of the file of the patent application. Moreover, reference is made to the A1-publication (EP 2 270 930 A1) of the present patent application dated 5 January 2011 containing the

uncorrected version of the claims, which can also be accessed via the European Patent Register. Thus, the fact that the corrected version of the claims could have been accessed via the Register can neither support the allegation that the Examining Division based its (substantive) examination on the corrected version of the claims nor can it be regarded as a basis for legitimate expectations on the part of the appellant.

2.8 In view of the above the Board refused the appellant's request for correction of the set of claims.

3. Amendment to the claims (Rule 137(5) EPC)

3.1 In the statement of grounds of appeal, the appellant submitted that the Examining Division had cited Guidelines for Examination, Chapter H, Part 2, 6.2 without applying logic. According to the appellant, the claims of EP4 [those in the zip-file] effectively comprised a broader set of claims than those of EP2 [those in the pdf-file]. The common features were identified by the Examining Division as not being patentable over document D1 (US 5 997 358 A), found in the search. As a result, the Examining Division applied the parallel test for unity of invention to argue that the claims did not relate to searched subject matter. However, given that document D1 was found in the search relating to common matter with EP2, clearly the subject-matter was searched. In other words, the EP4 claims related to features which formed the basis of the search in relation to the EP2 claims and hence the application should be allowed to proceed with the EP4 claims. These arguments were already submitted in the first instance proceedings, as is reflected in section 2.2 of the reasons for the impugned decision. The Examining Division addressed these arguments in section

2.3 of the reasons for the decision, see in particular the seven paragraphs at the top of sheet 9. There, the Examining Division set out the following:

*"The search has been done based on the subject-matter presented in the EP2 claims (a combination of said CTF [i.e. common technical features] providing compensation to a plug/jack combination with other features such as a plug contacts, plug interface contacts and different compensation and crosstalk zones among other). Nevertheless, the subject-matter of the claims of EP4 relates to a combination of said CTF and an electrical connector having one or more printed circuit boards comprising conductive traces. That is, EP2 was related to a plug/jack combination with crosstalk compensation for their coupling while EP4 related to a connector having crosstalk compensation for the conductive traces of its printed circuit board, and therefore the required single general inventive concept was missing. As the scope of the claims is different, the scope of the search of both set of claims EP2 and EP4 would have also been different. The fact that a document containing the CTF has been found during the search of the subject-matter of claims EP2 does not indicate that a search has been done on the subject-matter of claims EP4. A search for the subject-matter of the claims included in EP4 has not been performed. Hence, the requirements of Rule 137(5) EPC are not met."*

3.2 The appellant did not address this reasoning in the grounds for appeal and the Board finds this reasoning convincing. As the appellant has argued, the EP4 claims (i.e. those submitted as an amendment) are broader than the originally filed EP2 claims. The fact that document

D1 was found in the search relating to common matter with EP2 does not mean that a search has been carried out covering the full scope of the broader EP4 claims.

- 3.3 During the oral proceedings before the Board the appellant brought forward new submissions relating to the reasoning under point 2.3 of the impugned decision as regards the disclosure of document D1. The Board considered these submissions, which comprised new factual elements as regards the disclosure of document D1, as an amendment of the appeal case, the admittance thereof being subject to Article 13(2) RPBA 2020. According to this provision an amendment of a party's case shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned. The presence of exceptional circumstances cannot be acknowledged by the Board, because the appellant failed to provide reasons explaining why it had not been possible to put forward these submissions at the latest in a written reply to the Board's communication dated 25 April 2022, in which this topic had been explicitly addressed (cf. point 5.4 thereof).

Thus, in the absence of exceptional circumstances the Board exercised its discretion under Article 13(2) RPBA 2020 not to take into account the new submissions regarding the disclosure of D1.

- 3.4 In view of the above the Board came to the conclusion that the requested amendments of claims did not meet the requirements of Rule 137(5) EPC and were therefore not allowable.

4. Request for remittal

4.1 The appellant requested that the case be remitted to the first instance due to a substantial procedural violation. In that regard the appellant referred to the length of the first instance proceedings and in particular to the facts that the Examining Division:

- a) refused the application by decision dated 29 November 2018,
- b) set aside its decision refusing the application by interlocutory revision under Article 109(1) EPC dated 3 July 2019, but
- c) refused the application again by a second decision dated 30 September 2020.

4.2 In that regard the appellant complained that the Examining Division had misapplied the procedure under Article 109(1) EPC and had delayed the proceedings by not passing the case immediately to the Boards of Appeal. According to the appellant this procedural behaviour of the Examining Division meant a violation of the appellant's right to be heard.

4.3 The Board does not share the appellant's view. In accordance with Article 109(1), first sentence, EPC if an examining division whose decision is contested considers the appeal to be admissible and well founded it shall rectify its decision. In the present case the Examining Division set aside its first decision refusing the application due to a procedural violation. In that regard the Examining Division conceded that it had not taken into account one of the essential arguments put forward by the appellant (cf. impugned decision, point 15 of the Summary of Facts and Submissions). This argument was then dealt with by the Examining Division under points 1.3.4 and 1.9 of the Reasons of the impugned decision. Thus, the Examining

Division considered the (first) appeal to be well founded due to the aforementioned procedural violation and set aside its decision refusing the application dated 29 November 2018. This handling of the case is thus in line with Article 109(1) EPC (cf. T 647/93, point 2.6 of the Reasons). Thereafter the Examining Division resumed the proceedings in order to consider the applicant's argument which had not been dealt with in the decision of 29 November 2018 and to give the applicant the opportunity to exercise its right to be heard in particular on that point. Since further examination was required the proceedings were resumed which led ultimately to a second refusal of the application. In that regard it is noted that resumption of the proceedings does not rule out a subsequent refusal of the application (cf. T919/95, point 2.1 of the Reasons, with further references; also reflected in the Guidelines for Examination, E-XII, 7.4.1). Thus, the handling of the case by the Examining Division, i.e. the setting aside of the first refusal under Article 109(1) EPC and the resumption of the examination which led to a second refusal, does not *per se* constitute a procedural violation. As regards the alleged delay of the proceedings by the Examining Division, it is to be noted that the appellant could have requested acceleration of the proceedings, which however was not done.

- 4.4 Consequently, in the absence of a procedural violation the requirements for a remittal of the case under Article 11 RPBA 2020 are not met in the present case. Thus, the Board refused the request for remittal of the case to the Examining Division based on the corrected claims ("EP4").

4.5 During the oral proceedings before the Board the appellant requested that the case be remitted to the department of first instance for further prosecution on the basis of the original set of claims ("EP2"). In essence the appellant referred to the alleged misconduct of the proceedings by the Examining Division (cf. point 4.2 above). However, as pointed out above under point 4.3, the Board is not convinced by the appellant's arguments in that regard. Thus, in the absence of exceptional circumstances within the meaning of Article 13(2) RPBA 2020 the Board exercised its discretion not to take into account the request for remittal on the basis of the original claims ("EP2") under Article 13(2) RPBA 2020.

5. Reimbursement of the appeal fee

5.1 In the present case the Examining Division set aside its first refusal under Article 109(1) EPC due to a procedural violation but did not reimburse the appeal fee. However, in the event of interlocutory revision, reimbursement of the appeal fee is to be ordered by the department whose decision has been impugned if such reimbursement is equitable by reason of a substantial procedural violation. This is particularly the case when essential arguments, facts or evidence were not taken into consideration in arriving at a decision. In the present case the examining division rectified its (first) decision refusing the application in view of the fact that a crucial argument of the appellant had not been taken into account, constituting a violation of the appellant's right to be heard. Thus, the requirements under Rule 103(1) (a) EPC for reimbursement of the appeal fee paid on 8 February 2019 are met and therefore the Board orders reimbursement of that appeal fee.



5.2 The appellant's request for reimbursement of the appeal fee for the present appeal was refused for the following reasons: Rule 103(1)(a) EPC stipulates that the appeal fee has to be reimbursed where the board deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. The precondition for reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC, namely that the appeal be allowable, is not met in the present case. According to established case law, "allowable" is to be understood in the sense that the board, in substance at least, "follows" the relief sought by the appellant, in other words that it allows its requests (J 37/89, OJ EPO 1993, 201, Reasons, point 6). That is not however the case here, since the appeal is to be dismissed.

## Order

### For these reasons it is decided that:

1. The appeal is dismissed.
2. The appeal fee paid on 8 February 2019 is to be reimbursed.
3. The request for reimbursement of the appeal fee paid for the present appeal is refused.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated