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**Datasheet for the decision  
of 8 July 2021**

**Case Number:** T 0222/21 - 3.5.06

**Application Number:** 11790209.8

**Publication Number:** 2577450

**IPC:** G06F9/455

**Language of the proceedings:** EN

**Title of invention:**

VIRTUAL MACHINE MIGRATION TECHNIQUES

**Applicant:**

Microsoft Technology Licensing, LLC

**Headword:**

Virtual Machine Migration/MICROSOFT

**Relevant legal provisions:**

EPC Art. 111(1)

EPC R. 71(3), 71(6), 137(3)

RPBA 2020 Art. 11

Guidelines for examination H-II, 2.4, 2.5.1

**Keyword:**

**Decisions cited:**

G 0007/93, T 1399/10

**Catchword:**

Proper exercise of discretion under Rule 137(3) EPC in respect of amendments filed pursuant to Rule 71(6) EPC (no)



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Case Number: T 0222/21 - 3.5.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.06**  
**of 8 July 2021**

**Appellant:** Microsoft Technology Licensing, LLC  
(Applicant) One Microsoft Way  
Redmond, WA 98052 (US)

**Representative:** Grünecker Patent- und Rechtsanwälte  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 17 September  
2020 refusing European patent application No.  
11790209.8 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman** M. Müller  
**Members:** T. Alecu  
B. Müller

## **Summary of Facts and Submissions**

- I. The applicant's appeal is against the decision of the Examining Division to refuse European patent application No. 11 790 209.8. The refusal is the consequence of the fact that, pursuant to Rule 137(3) EPC, the Examining Division did not consent to the set of amended claims according to the main request of 11 October 2018, which the appellant, under Rule 71(6) EPC, filed in response to a communication under Rule 71(3) EPC. The set of claims being the subject of that communication were relegated to the applicant's auxiliary request. According to the grounds of appeal (the first page):

*The appellant seeks clarification solely for the question whether or not the Examining Division was right to not admit the Main Request into the procedure and, in particular, if the standards and the procedure applied by the Examining Division when deciding on the matter were in line with the applicable law.*

- II. The Examining Division noted that, as the main request, the appellant filed a "completely new set of claims" after it had already issued an intention to grant on 8 May 2018 for a set of claims as filed by the applicant on 10 April 2018 (including a minor modification by the examiner).

In respect of the admittance of amendments filed at an advanced stage of the proceedings the Examining Division quoted the "Guidelines for Examination", version November 2019, section H-II, 2.4. It considered that the decision of the Enlarged Board of Appeal in case G 7/93 (OJ EPO 1994, 775), points 2.2 to 2.5 was

also relevant. It required that, at an advanced stage of the proceedings, the effort of the Examining Division to bring the procedure to a close and the applicant's interest in obtaining a legally valid patent were balanced.

The Examining Division explained that the completely new set of claims would require the re-opening of substantive examination and that the only reasons provided by the appellant for the extensive amendments were essentially a change of mind, and therefore not good reasons for proposing the changes only at this stage of the proceedings (referring to Guidelines H-II, 2.4).

- In its statement of grounds of appeal, the appellant disagrees that extensiveness per se is a factor to consider in the balancing process referred to in G 7/93. It was not the extent of change to the claims that mattered, but their content. In the present case, the changes would not have required a large amount of work on the part of the Examining Division, because the feature conferring inventiveness was not removed, and the applicant provided support to the Examining Division for analysing the changes. It required more work to refuse the application than it would have required to analyse the requested amendments. Those amendments were not proposed because of a change of the applicant's mind, but rather because the in-house attorney saw the text intended for grant only upon the issue of the communication under Rule 71(3) EPC. There had been an internal communication error, and the applicant had not been informed of the amendments proposed by the former representative. He was immediately replaced by the

applicant with the current representative who considered the proposed claim set as not useful.

Furthermore, although the stage of the proceedings was advanced, the examination proceedings overall were not long, comprising only one telephone communication.

It had also to be recognised that Rule 71(6) EPC itself gave an applicant the right to refuse a proposal for grant and specified that in that case the examination had to be resumed. That rule did not include a condition relating to the amount of changes.

In not considering all these factors, the Examining Division failed to correctly exercise their discretion under Rule 137(3) EPC.

III. The appellant requests (on the last page of the grounds of appeal)

*to set aside the decision [...], to decide on the admissibility of the Main Request into the procedure and to remit the case back to First Instance to decide on the allowability of this Main Request and for issuance of a new communication under Rule 71(3) EPC on basis of such claims. Auxiliary, oral proceedings are requested.*

IV. The appellant was informed over the telephone of the decision the board intended to take. In response, with a letter dated 8 July 2021, the appellant withdrew the request for oral proceedings on [the] basis of the understanding that the Boards of Appeal [would] set aside the appealed decision and remit the case back to the first instance.

## **Reasons for the Decision**

1. In the decision under appeal the Examining Division stated that it decided not to admit the Main Request dated 11 October 2018 under Rule 137(3) EPC. It exercised its discretion under Rule 137(3) as it did not consent to the amendments filed by the applicant in accordance with Rules 71(3) and 71(6) EPC.
2. The Board notes that, in response to a communication pursuant to Rules 70(2) and 70a(2) EPC dated 24 April 2014, with a letter dated 4 November 2014, the applicant filed amendments and requested further examination on the basis thereof. This was in line with Rule 137(2) EPC. Subsequently, in a response of 10 April 2018 to a telephone consultation with the examiner of 2 October 2017, the applicant requested further examination on the basis of another amended set of claims.
3. It follows that, as the appellant amended the application pursuant to Rule 137(2) EPC, its further amendments made pursuant Rule 71(6) EPC are subject to the consent of the Examining Division under Rule 137(3) EPC.
4. The Examining Division exercised its discretion under Rule 137(3) EPC in not admitting the set of amended claims filed as Main Request. It based its decision on the Guidelines for Examination (version of November 2019, hereinafter "the Guidelines"), Part H-II, 2.4 and 2.5.1 and the decision of the Enlarged Board of Appeal in case G 7/93, points 2.2 to 2.5.
5. As confirmed in G 7/93 (point 2.1), the Examining Division has a discretion under Rule 137(3) EPC to give

consent to an amendment of the application until the issue of a decision to grant the patent, irrespective of whether the applicant has already agreed to a text. The Examining Division is required to exercise its discretion considering all relevant factors, in particular the applicant's interest in obtaining a patent which is valid in all designated states, and the EPO's interest in bringing examination to a close, and must balance these against one another (G 7/93, point 2.5). Furthermore, a Board of Appeal may overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance with the right principles, or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion (G 7/93, point 2.5 and 2.6).

6. In respect of the stage of the proceedings, the Board notes that the claims proposed for grant were essentially those filed by the applicant and the substantive examination had come to a conclusion. The relatively short duration of the examination proceedings of roughly 8 months between the start of examination (by the telephone conversation of 2 October 2017) and the issuance of the communication under Rule 71(3) EPC (of 8 May 2018) in this case is not a decisive factor weighing in favour of admitting amendments.
7. As to the balancing act that the Examining Division is required to perform in exercising its discretion under Rule 137(3) EPC (point 5 above), the Guidelines provide factors that are meant to be considered according to



their relative importance at various different stages of the proceedings.

8. Correspondingly, point H-II, 2.4 is entitled "At an advanced stage of the proceedings". In pertinent part, it reads as follows:  
*Any request by an applicant to replace the text of the application on the basis of which a patent could be granted by a text that has been **extensively revised** should be refused, unless the applicant gives good reasons for proposing the changes only at this stage in the proceedings. (emphasis added)*
9. In this case the Examining Division (in point 21 of the decision under appeal) considered that the "completely new set of claims [...] would require the reopening of the substantive examination".
10. It noted that the amendments were "extensive" and focused on the absence of "good reasons" in the meaning of point H-II, 2.4 of the Guidelines reproduced above. The only reasons advanced for the extensive amendments were that the applicant "changed his mind, was not satisfied with the claims and changed the representative".
11. The Board agrees that, from the perspective of the Examining Division, the amendments had to appear to be the result of a change of mind of the applicant, who is always responsible for the request(s) it files, irrespective of the chosen representative. The absence of good reasons is however only of importance if the amendments are found to be extensive.
12. It cannot be denied, and the appellant did not contest, that the text has been extensively revised, as laid out

in detail in point 19 of the decision under appeal. As stated there, in particular, the last six lines of claim 1 were deleted and replaced by an unrelated feature.

13. The Board however is of the opinion that point H-II, 2.4 of the Guidelines relating to a "advanced stage of the proceedings", which could be a stage before issuance of a communication under Rule 71(3) EPC, is not complete insofar as it merely refers to the criterion of whether the **text** was "extensively revised", i.e. a quantitative criterion. This point should be read in conjunction with point H-II, 2.5.1 of the Guidelines, which the Examining Division also cited. This point, in its second paragraph, applies the principles of G 7/93 to amendments filed in response to the communication under Rule 71(3) EPC, and thus to an even later stage of the proceedings than the stage to which point H-II, 2.4 relates. Point H-II, 2.5.1 reads in pertinent part (emphasis added):

*At this stage of the proceedings, the substantive examination has already been completed and the applicant has had the opportunity to amend the application and therefore normally only those **amendments** which do **not appreciably delay** the preparations for grant of the patent will be admitted under Rule 137(3).*

It follows from points H-II, 2.4 and H-II, 2.5.1 read in conjunction, correctly in the Board's view, that what matters for the exercise of the discretion to admit or not to admit, if the text was "extensively revised", is the content of the amendments and the consequential amount of time for examination that the amendments *prima facie* require. It is this amount of

time that determines whether the amendments are extensive. The Board is of the view that, for instance, where a request is *prima facie* allowable, the amount of time needed will generally be quite limited so that the amendments will not appreciably delay the preparations for grant of the patent. Admittance of the request into the proceedings under Rule 137(3) EPC may then be justified. On the other hand, if an Examining Division comes to the conclusion that a request is not *prima facie* allowable but introduces new deficiencies, it is justified for the division to refuse the request under Rule 137(3) EPC (cf. T 1399/10, point 1.3, of this Board in a different composition).

14. The Board thus agrees with the appellant that the extent of amendments per se is not a pertinent factor for the exercise of discretion to consent to amendments, it is their content, or rather, the amount of examination that they might require, which is the decisive factor to consider. In order to conclude that examination needed to be restarted, the Examining Division should have carried out a *prima facie* analysis of the claims to identify any possible issues preventing a grant.
  
15. The Board concludes, that the Examining Division, in solely relying on point H-II, 2.4, when exercising its discretion, i.e. extensiveness per se, failed to consider the correct factor, i.e. the time for examination that the amendments might require and thus the potential delay to the preparations for the grant of the patent. The Examining Division not having exercised its discretion in the right way, the appeal is allowable. On the other hand, the examination of the application has to be continued, because a decision must be given on whether the main request is to be

admitted into the proceedings and, if so, on whether it is allowable.

16. In the statement of grounds of appeal, the appellant asserted that a procedural violation had taken place in the proceedings before the Examining Division:  
The appealed decision lacked any reasons for the exercise of discretion under Rule 137(3) EPC pertaining to this specific case. Point 20 of the decision was a mere repetition of portions of the Guidelines (headline: "Relevant legal provisions") and therefore the decision lacked weighted arguments that spoke for or against admitting the Main Request into the proceedings thereby dealing with the details of the situation at hand. In other words, no evaluation of the relevant factors had been undertaken. This constituted a procedural violation.
  
17. In this respect, the Board reiterates that the Examining Division, in point 21 of the decision under appeal, did give reasons for the exercise of its discretion. However, it did not exercise its discretion in the right way. Errors in the exercise of discretion per se, however, are substantive and not procedural errors. Likewise, errors of substantive judgment do generally not amount to fundamental deficiencies in the proceedings within the meaning of Article 11 RPBA 2020. As a consequence, the example of an exception to non-remittal under Article 111(1) EPC provided in Article 11 RPBA 2020 does not apply.
  
18. The Board, making use of its discretion, nonetheless decides to remit the case to the Examining Division for further prosecution. As a rule, proceedings before the EPO are designed such that issues may generally be decided by two instances, i.e. an administrative first-

instance department and, upon judicial review, by the boards of appeal. Remittal to the Examining Division, which has not examined the appellant's main request as to admittance according to the proper criteria and, if it were to be admitted, as to substance at all, will be in compliance with this rule. These circumstances constitute "special reasons" to remit within the meaning of Article 11, first sentence, RPBA 2020.

19. Remitting the case will also serve the purpose of this appeal, which, in the appellant's words, was to review *if the standards and the procedure applied by the Examining Division when deciding on the matter were in line with the applicable law.*
20. Incidentally, the board having taken this case considerably out of turn, a remittal will not unduly delay examination of this case.
21. It is noted that the appellant stated that the claim was most likely still new and inventive, as the feature *"a group of ... pages to be mapped as writable.."*, argued to be the inventive difference with the prior art in the letter of 4 November 2014 (page 4, top) is still present in the claim. This would mean that its examination should not require a considerable effort from the Examining Division. It will be up to the Examining Division, however, to assess this reasoning if it considers it to be relevant.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



L. Stridde

M. Müller

Decision electronically authenticated