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**Datasheet for the decision
of 6 October 2023**

Case Number: T 1183/21 - 3.5.05

Application Number: 16198767.2

Publication Number: 3220296

IPC: G06F19/00, H04L29/06,
G06F3/0481, G06F3/0484,
H04L29/08

Language of the proceedings: EN

Title of invention:
WEB APPLICATION FOR TRANSMITTING CONTENT TO A PATIENT

Applicant:
Bremer, Mattias

Headword:
Content to patient/BREMER

Relevant legal provisions:
EPC Art. 123(2)
RPBA 2020 Art. 12(6)

Keyword:
Amendments - allowable (no)
Late-filed request - no longer maintained in first-instance
proceedings (yes)



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Case Number: T 1183/21 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 6 October 2023

Appellant: Bremer, Mattias
(Applicant) Tehtaankatu 26 B 47
00150 Helsinki (FI)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 16 April 2021
refusing European patent application No.
16198767.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair A. Ritzka
Members: E. Konak
K. Kerber-Zubrzycka

Summary of Facts and Submissions

I. The appeal is against the examining division's decision to refuse the application on the grounds that the sole request then on file did not meet the requirements of Articles 123(2) and 56 EPC. The sole request comprised the following:

description pages 1-13 as originally filed
claims 1-5 filed in electronic form on 11 June 2020
drawings sheets 1/4-4/4 filed in electronic form on
11 June 2020

II. In his statement setting out the grounds of appeal, filed on 9 July 2021, the appellant formulated his requests as follows:

"Main request:

Description as originally filed

Patent application with claims 1-5 as filed 11.06.2020

*Claims 1-5 as filed 11.06.2020 with all auxiliary
drawing options*

Auxiliary filings for Claims 1 and 5 on page 12.

Applicable with all Auxilliary drawing options.

*Auxiliary filings for Drawings 1 on page 17. Drawings
as in the US patent. Filed with USPTO 12.2015 Filed
with EPO: 11.06.20,20.11.17,05.06.17*

*Auxiliary filings for Drawings 2 on page 19. Drawings
as posted with the EPO.03.07.2017*

Auxiliary filings for Drawings 3 on page 19. Drawings removed."

III. The board summoned the appellant to oral proceedings. In a communication pursuant to Article 15(1) RPBA, it gave its preliminary opinion.

Given that the main request was formulated as

"Description as originally filed

Patent application with claims 1-5 as filed 11.06.2020

*Claims 1-5 as filed 11.06.2020 **with all auxiliary drawing options** [emphasis by the board]"*

and the first *"auxiliary drawing option"* mentioned was

"Auxiliary filings for Drawings 1 on page 17. Drawings as in the US patent. Filed with USPTO 12.2015 Filed with EPO: 11.06.20,20.11.17,05.06.17",

the board understood the appellant's main request as being that the decision under appeal be set aside and that a patent be granted on the basis of the sole request on which the contested decision was based.

Regarding this request, the board agreed with the contested decision that it at least did not meet the requirements of Article 123(2) EPC.

As to the appellant's auxiliary requests - or "auxiliary filings" as the appellant called them, their exact number, order and content was not clear to the

board from the way the appellant filed his requests. Irrespective of that, the board was not minded to admit them into the appeal proceedings.

The board also noted that a request for the reimbursement of the appeal fee had been made in the notice of appeal. The board saw no legal basis for granting this request in the case at hand.

- IV. In reply, the appellant made a number of submissions including a revised version of the statement setting out the grounds of appeal, filed on 17 June 2023, in which the appellant reformulated his requests as follows:

"Main request:

Description as originally filed

Patent application with claims 1-5 as filed 11.06.2020, Annex1 + Drawings deemed deleted.

Claims 1-5 as filed 11.06.2020 Annex 1, with all auxiliary drawing options (See Appellant reply to board preliminary reply. Drawings deemed deleted.)

*Auxiliary request filings for Claims 1 and 5 on page 16-19 and Annex3 (New ref See Appellant reply to preliminary board reply) **Applicable with all Auxilliary request drawing options.***

Auxiliary request filings for Drawings 1 on page 20, Annex12. Drawings as in the US patent. Filed with USPTO 12.2015 Filed with EPO: 11.06.20,20.11.17,05.06.17 (New insert US patent drawings are attached as Annex12 and are the ones filed later. However, these seem not

allowable due to procedural and examination violation with original filing date or a date very near the filing date when the receiving section were supposed to invite to remedy the forbidden items in drawings additionally there are parts missing, they not only appear to do so.)

Auxiliary request filings for Drawings 2, Annex 2. Drawings as posted with the EPO.03.07.2017 (New insert these are drawings containing forbidden matter and that show parts to appear missing relating to subject matter in the drawing. The receiving section, examiner, formalities, and board preliminary reply should have noted that these should have been notified of concerning text, and need to be deleted. Major procedural violation makes a mess out of drawings. See Appellant reply to preliminary board reply.)

Auxiliary request filings for Drawings 3. Drawings removed. (New insert, see Appellant reply to board. The receiving section is responsible by law to invite to remedy forbidden items immediately on filing and there are parts missing too that one can remedy. If the applicant does not file the missing parts within this period (2m), all references to the missing parts are deemed to be deleted.

[...]

Fees Paid back in full."

V. Oral proceedings were held before the board.

In the course of the discussion regarding the admissibility of the main request filed on 17 June 2023, which the board, due to the expression "+

Drawings deemed deleted.", had assumed to include a different set of drawings from those of the main request filed on 9 July 2021, the appellant submitted that his requests made in the statement setting out the grounds of appeal filed on 9 July 2021 had not changed. The appellant had merely clarified them with the revised statement setting out the grounds of appeal filed on 17 June 2023.

At the end of the oral proceedings, the appellant confirmed that his final requests were the same as those formulated in the statement setting out the grounds of appeal filed on 9 July 2021.

At the end of the oral proceedings, the chair closed the debate and announced the decision that the appeal was dismissed.

- VI. After the oral proceedings, the appellant continued to make further written submissions including arguments and potential changes to his requests. However, the board's decision had already been announced at the oral proceedings and had become effective, terminating the appeal proceedings. Therefore, these submissions are without any legal effect (see Case Law of the Boards of Appeal of the European Patent Office, 10th Edition, July 2022, V.A.7.1.2 "Proceedings after delivery of the decision").

In one of these letters, dated 25 October 2023, the appellant also requested the correction of the minutes of the oral proceedings before the board. He wrote:

"Initially noting the minutes should contain the discussion at the end to next steps in proceedings

where the registrar noted a divisional application can be launched.

*The appellant added and said that he may also file a petition to the enlarged board of appeal to which the registrar immediately bursted out a **NO!**"*

Reasons for the Decision

1. Main request - Added subject-matter (Article 123(2) EPC)
 - 1.1 The board sees no prejudicial error in the conclusion of the contested decision that the main request does not meet the requirements of Article 123(2) EPC. The examining division's objections under Article 123(2) EPC concern amendments to the drawings as well as amendments to the claims. The board prioritised the discussion of the issue of amendments to the drawings.
 - 1.2 The application at hand was filed on 15 November 2016 by reference to a previously filed application filed at the USPTO (Rule 40(1)(c), (2) EPC). According to Rule 40(3) EPC, a certified copy of the previously filed application is to be filed within two months of filing the application. In the case at hand, such a certified copy was transmitted by the USPTO on 3 July 2017.
 - 1.3 It is not disputed that the drawings of this certified copy, namely the drawings as originally filed, were not the drawings that the appellant intended to file. The appellant later filed the correct drawings with the EPO on several dates.

The board understands that the replacement of the wrong drawings with correct drawings was possible in the appellant's proceedings before the USPTO and that the appellant obtained a patent with the correct drawings from the USPTO. However, the events before the USPTO have no bearing on the procedure before the EPO.

The question to be answered is whether the legal remedy sought by the appellant when it filed his main request was allowable under the EPC.

1.4 In the contested decision, the examining division interpreted the remedy sought as a request to correct an error within the meaning of Rule 139 EPC and then concluded that Rule 139 EPC did not provide a remedy to correct the error at hand. The appellant submitted that Rule 139 EPC was not the remedy he sought anyway.

1.5 Instead, the appellant sought a remedy in the provisions of Rule 56 EPC regarding missing drawings. He argued that since the drawings as originally filed were wrong, they should legally be considered as missing drawings within the meaning of Rule 56 EPC. He referred in particular to Rule 56(1) EPC which reads as follows:

"If the examination under Article 90, paragraph 1, reveals that parts of the description, or drawings referred to in the description or in the claims, appear to be missing, the European Patent Office shall invite the applicant to file the missing parts within two months. The applicant may not invoke the omission of such a communication."

1.6 From the wording of the provision ("If the examination under Article 90, paragraph 1, reveals [...]), it

follows that this provision is applicable in a situation in which the examination under Article 90 EPC reveals deficiencies and the EPO invites the applicant to remedy the identified deficiencies. The examination under Article 90 EPC is the examination on filing as to formal requirements by the receiving section (cf. Articles 16 and 90 EPC and Rule 10(1) EPC). In the case at hand, examination under Article 90 EPC by the receiving section did not reveal any deficiency regarding the drawings of the certified copy and thus no invitation was sent to remedy it. Instead, the discrepancy between the list of drawings on pages 11-12 of the description and the drawings as originally filed was identified later when the search opinion was issued. Therefore, the remedy sought according to Rule 56(1) EPC fails from the very beginning.

- 1.7 The appellant argued that the receiving section had not carried out its responsibilities under Articles 16 and 90 EPC and Rule 10(1) EPC by failing to send an invitation within the meaning of Rule 56(1) EPC. He drew attention to further deficiencies of the drawings and the application documents as filed with reference to other rules of the EPC, such as a full page of text within the drawings which was "forbidden" or inconsistent reference signs. None of these deficiencies had been reported to him by the receiving section. If the receiving section had done its duty, informed him about the deficiencies and guided him on possible remedies, he would have corrected them in due time. The board cannot accept this line of argumentation. The appellant argued in essence that the departments of the EPO bear the responsibility not only for the consequences of an error he made when filing his application with the USPTO but even for providing remedies to all deficiencies within the application

documents. This is not correct and would be entirely against the principle that the ultimate responsibility for filing the correct set of application documents lies with the applicant (cf. Article 113(2) EPC).

1.8 For the sake of completeness, the appellant's understanding of when a drawing should be deemed to be missing is not in line with how this is understood in case law of the boards of appeal. A wrong drawing is not necessarily a missing drawing. In the case at hand, the only part of the description which refers to drawings is the list in paragraph [0017]. The description does not discuss the drawings any further. In this list, there are Figures 1 to 7. Drawings bearing all these numbers are among the drawings as originally filed. Therefore, it is not surprising that the examination under Article 90 EPC did not reveal any "missing" drawing (cf. the wording of Rule 56(1) EPC, i.e. "[...] drawings referred to in the description or in the claims, appear to be missing [...]").

1.9 The appellant also sought a remedy to the error at hand under the provisions of Rule 53 EPC and other provisions of the EPC related to priority documents. These provisions are irrelevant to the case at hand. The correction of an error has nothing to do with priority. As far as the board could see, the appellant expected that since the reference to a previously filed application under Rule 40(1)(c) EPC was to the same US application from which the applicant claimed priority, the EPO should have looked at the relevant US patent applications and found out which drawings were the correct ones. However, once again, the responsibility for filing the correct set of application documents lies with the applicant.

- 1.10 Referring to Article 133(1) EPC, which states that, subject to paragraph (2), no person shall be compelled to be represented by a professional representative in proceedings established by the convention, the appellant argued that there was no excuse for his not having been informed of the correct procedure for conducting the examination before the EPO. However, the parties in proceedings before the EPO are treated equally irrespective of whether or not they are represented by a professional representative. As stated above, the responsibility for filing the correct set of application documents lies with the applicant. If an applicant chooses not to be represented by a professional representative but lacks information regarding the correct procedures to be followed, it cannot expect the EPO to assume this responsibility for it.
- 1.11 The appellant argued that drawings did not define the extent of protection of a patent, so their replacement with the correct drawings did not violate the provisions of Article 123(2) and (3) EPC. In particular, the claims were now narrower in scope than originally filed. The appellant's arguments regarding Article 123(3) EPC, which concerns amendments to European patents, are obviously irrelevant to the case at hand, since there is as yet no patent. As to Article 123(2) EPC, this forbids a patent application - including the drawings - from being amended in such a way that it contains subject-matter which extends beyond the content of the application as filed, not only the claims as argued by the appellant.
- 1.12 Therefore, the main request does not meet the requirements of Article 123(2) EPC as a result merely of the amendment made by replacing the drawings as

originally filed with the drawings filed on 11 June 2020.

2. Admission of the auxiliary requests

2.1 According to Article 12(6) RPBA, the board shall not admit requests which should have been submitted, or which were no longer maintained in the proceedings leading to the decision under appeal.

2.2 In the case at hand, the contested decision is based only on the main request. The auxiliary requests involve either returning to drawings as originally filed or deleting the drawings; neither of these options was maintained in the examination proceedings as an auxiliary request. The appellant had requested that the drawings be deleted as an auxiliary request on 21 January 2021 but then explicitly withdrew this request on 20 March 2021. After the filing of the drawings on which the contested decision was based, the drawings as originally filed were replaced and were never maintained as an auxiliary request.

2.3 The appellant argued that Article 12(6) RPBA provided for an exception if the circumstances of the appeal case justified the admittance of requests which were not maintained. In the case at hand, the circumstances of the appeal case justified their admittance, because there were violations everywhere, the receiving section and the examination process could not be relied upon and finally the board was interpreting the law wrongly and dissecting the law to suit its purpose. The board understands that the appellant was unhappy with all departments of the EPO, however, it cannot see how this could justify the admittance of requests which had not been maintained in examination proceedings.

2.4 Therefore, the board did not admit the auxiliary requests into the appeal proceedings.

3. Request for reimbursement of the appeal fee

3.1 The appellant requested the reimbursement of the appeal fee according to Rule 103(1)(a) EPC, which reads as follows:

"The appeal fee shall be reimbursed in full
(a) in the event of interlocutory revision or **where the Board of Appeal deems an appeal to be allowable** [emphasis by the board], if such reimbursement is equitable by reason of a substantial procedural violation."

3.2 In the case at hand, since the appeal is not allowable, there is no legal basis for a reimbursement of the appeal fee. Therefore, the request for the reimbursement of the appeal fee was rejected.

4. Request for the correction of the minutes

4.1 In his request for the correction of the minutes, the appellant complained that some statements which, according to the appellant, had allegedly been made by the registrar at the end of the oral proceedings were not mentioned in the minutes. The board cannot follow this request since the registrar of the board was not present at the oral proceedings and, thus, cannot have made any statements at the oral proceedings. Therefore, the request for the correction of the minutes is rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



A. Chavinier

A. Ritzka

Decision electronically authenticated