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**Datasheet for the decision
of 20 July 2022**

Case Number: T 0682/22 - 3.5.03

Application Number: 14889608.7

Publication Number: 3133864

IPC: H04W48/20, H04W76/02

Language of the proceedings: EN

Title of invention:

Method and system for controlling access of CSG in
dual-connection architecture

Applicant:

ZTE Corporation

Headword:

Interlocutory revision/ZTE

Relevant legal provisions:

EPC Art. 54(3), 109(1), 111(1), 116(1)

EPC R. 103(1)(a), 103(4)(c)

RPBA 2020 Art. 11, 12(8), 20(2)

Keyword:

Decision in written proceedings: cancellation of hearing following appellant's announcement of non-attendance
Novelty under Art. 54(3) EPC - sole request (yes)
Interlocutory revision - examining division should have rectified decision (yes)
Substantial procedural violation - (no)
Remittal - (yes): special reasons for remittal
Reimbursement of appeal fee in full (no)
Partial reimbursement of appeal fee at 25% - (yes): timely withdrawal of request for oral proceedings
Inconsistency between Guidelines and Case Law

Decisions cited:

T 0139/87, T 2445/11, T 1060/13, T 0691/18

Catchword:

Different interpretation of Article 109(1) EPC from that provided for in the Guidelines for Examination in the EPO - application of Article 20(2) RPBA 2020 (see point 2.4.3 of the Reasons).



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Case Number: T 0682/22 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 20 July 2022

Appellant: ZTE Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 8 November 2021
refusing European patent application
No. 14889608.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair K. Bengi-Akyürek
Members: J. Eraso Helguera
F. Bostedt

Summary of Facts and Submissions

- I. The appeal was lodged against the decision of the examining division to refuse the present European patent application for lack of novelty (Article 54(3) EPC) with respect to the independent claims of a sole set of claims (sole request).
- II. During the examination proceedings, the examining division referred *inter alia* to the following prior-art document:

D5: WO 2015/11978 A1.
- III. The appellant requested that the appealed decision be set aside and that a patent be granted on the basis of the claims of a **sole request** filed with the statement of grounds of appeal. The appeal further requested rectification of the impugned decision under Article 109(1) EPC and the reimbursement of the appeal fee under Rule 103(1) (a) EPC.
- IV. In a communication pursuant to Article 15(1) RPBA 2020, the board stated its intention to remit the case to the examining division, the only remaining issue for discussion during oral proceedings being the appellant's request for reimbursement of the appeal fee under Rule 103(1) (a) EPC.
- V. In response to the board's communication, the appellant indicated that it would not be attending the scheduled oral proceedings and requested partial reimbursement of the appeal fee.
- VI. **Claim 1** of the sole request reads as follows:

"A method for controlling access of a Closed Subscriber Group, CSG, in a dual-connection architecture, the dual-connection architecture referring to a User Equipment, UE, simultaneously maintaining connections with two different eNBs, wherein the UE is connected to a master eNB, MeNB, which is adapted to determine a CSG status of the UE, and based on the determination, a secondary eNB, SeNB, is added for simultaneous connection between the MeNB, the SeNB and the UE,

the method comprising:

the SeNB acquiring CSG identity state information of the UE (501); and

the SeNB determining a CSG access policy of the UE according to the acquired CSG identity state information of the UE (502), wherein the CSG identity state information comprises: a CSG identity state, wherein the CSG identity state is a member or a non-member;

characterized in that,

the SeNB determining the CSG access policy of the UE according to the acquired CSG identity state information of the UE comprises: if determining that the UE cannot access the SeNB, the SeNB refusing an SeNB adding request transmitted by the MeNB;

wherein a message for the SeNB refusing the adding request contains a cause value indicating that the SeNB refuses to be added or the CSG identity state information of the UE."

Independent claim 11 of the sole request reads as follows:

"A system for controlling access of a Closed Subscriber Group, CSG, in a dual-connection architecture, applied to a second eNB, the dual-connection architecture referring to a User Equipment, UE, simultaneously maintaining connections with two different eNBs, wherein the UE is connected to the MeNB which is adapted to determine a CSG status of the UE, and based on the determination, the secondary eNB, SeNB, is added for simultaneous connection between the MeNB, the SeNB and the UE,

wherein, the system comprises:

a communication module (10) configured to acquire CSG identity state information of the UE; and

a control module (20) configured to determine a CSG access policy of the UE according to the acquired CSG identity state information of the UE, wherein the CSG identity state information comprises: a CSG identity state, wherein the CSG identity state is a member or a non-member;

characterized in that,

the control module (20) is further configured to: if determining that the UE cannot access the SeNB, refuse an SeNB adding request transmitted by the MeNB;

wherein a message for the SeNB refusing the adding request contains a cause value indicating that the SeNB refuses to be added or the CSG identity state information of the UE."

Reasons for the Decision

1. *Decision in written proceedings*

1.1 According to established case law, where oral proceedings are appointed upon a party's request and that party subsequently expresses its intention not to attend, such statement is normally considered to be equivalent to a withdrawal of the request for oral proceedings.

1.2 As the board does not consider holding oral proceedings to be expedient in this case (cf. Article 116(1) EPC), these were cancelled and a decision is handed down in written proceedings (Article 12(8) RPBA 2020).

2. SOLE REQUEST

Claim 1 of the sole request comprises the following limiting features (board's outline):

A method for controlling access of a CSG, in a dual-connection architecture, the dual-connection architecture referring to a UE, simultaneously maintaining connections with two different eNBs, wherein the UE is connected to an MeNB, which is adapted to determine a CSG status of the UE, and based on the determination, an SeNB is added for simultaneous connection between the MeNB, the SeNB and the UE, the method comprising:

- (a) the SeNB acquiring CSG identity state information of the UE;
- (b) the SeNB determining a CSG access policy of the UE according to the acquired CSG identity state information of the UE, wherein the CSG identity

state information comprises: a CSG identity state, wherein the CSG identity state is a member or a non-member;

- (c) the SeNB determining the CSG access policy of the UE according to the acquired CSG identity state information of the UE comprises: if determining that the UE cannot access the SeNB, the SeNB refusing an SeNB adding request transmitted by the MeNB;
- (d) a message for the SeNB refusing the adding request contains a cause value indicating that the SeNB refuses to be added or the CSG identity state information of the UE.

Independent claim 11 comprises corresponding features in terms of modules of a system carrying out the method of claim 1.

2.1 *Amendments*

- 2.1.1 The appellant submitted that amended claim 1 was based on a combination of previous claims 1, 4 and 5, which had been deemed to be allowable in the decision under appeal (cf. Reasons 1.2 of the appealed decision). According to the appellant, amended claim 1 "had been subjected to the following amendments" (cf. page 2 of the statement of grounds of appeal):

"(1) deleting the features 'via communication with an MME', 'the MeNB transmitting the CSG identity state information to the SeNB' and 'the MeNB determining whether the UE accesses the SeNB with an identity of a member or a non-member according to the CSG identity state information' which were previously added into claim 1 and did not contribute to patentability in view of the

Examining Division. Hence, deleting the above features previously added into claim 1 does not extend the subject matter beyond the content of the application as filed;

(2) adding the last alternative feature of former claim 4 according to which 'if determining that the UE cannot access the SeNB, the SeNB refusing an SeNB adding request transmitted by the MeNB' [feature (c)];

(3) adding all features of former claim 5 'wherein a message for the SeNB refusing the adding request contains a cause value indicating that the SeNB refuses to be added or the CSG identity state information of the UE' [feature (d)];

(4) amending the execution entity 'MeNB' to read as 'SeNB' (basis for the amendment can be found at least in original claim 4 or rather on page 6, line 8 of the description as originally filed).

Further, former claims 4 to 6 have been cancelled.

In addition, former independent claim 14 (amended independent claim 11) has been brought in line with amended independent claim 1."

2.2 *Novelty in view of D5 (Article 54(3) EPC)*

2.2.1 The appellant submitted that, as already acknowledged by the examining division in the appealed decision, document **D5** did not disclose the features of the characterising portion of claim 1 as amended, namely the ones of former claims 4 and 5 as well as former claims 17 and 18, i.e. **features (c) and (d)**.

2.2.2 The appealed decision contained novelty objections under Article 54(3) EPC with respect to independent claims 1 and 11 and dependent claims 2 to 4, 6 to 13, 15 to 17 and 19 to 25 of the then sole request. Furthermore, in point 3 of the annex to the summons (with D5 being wrongly referred to as D4, cf. also point 8 of the Facts and Submissions of the appealed decision), the examining division had made the following statements with respect to the features of dependent claims 5 and 18 subject to the appealed decision, i.e. **feature (d)**) vis-à-vis D5 (including the original emphasis):

"3 Positive statement

*3.1 It is noted that **claims 6 and 20** are **not** disclosed by **D4**, since while paragraph [48], teaches that the SeNB decides whether to admit the UE based on the CSG status, it does **not** explicitly mention that the SeNB sends a cause value indicating the refusal.*

*It appears hence that the combination of **claims 1+4+5+6** currently on file, due to the dependency of **claim 6**, which depends on **5**, which depends on **4**, which finally depends on **1**, would be new over **D4**.*

Claim 15 should be amended accordingly.

*3.2 It is also underlined that the novelty objections based on document **D2** is abandoned, since D2 seems not to disclosed [sic] the sending from MeNB to SeNB of the CSG status."*

2.3 The board sees no reason to reverse the above assessment of the examining division. It follows that

the subject-matter of independent claims 1 and 11 is new over **D5** (Article 54(3) EPC).

2.4 *Interlocutory revision (Article 109(1) EPC)*

2.4.1 Under Article 109(1) EPC, if the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision. In the context of Article 109(1) EPC, an appeal is to be considered "well founded" if the main request submitted with the appeal includes amendments which clearly overcome the objections on which the decision relies, such that the examining division could reasonably be expected to recognise this and thus rectify its decision (cf. T 691/18, Reasons 2). The board, to avoid misunderstandings, also notes that in the context of Article 109(1) EPC, an "admissible appeal" is not to be conflated with any admittance considerations whatsoever as regards newly filed claim requests.

2.4.2 It is established case law of the Boards of Appeal that other objections which arise in the current request but which were not the subject of the contested decision cannot preclude the application of Article 109(1) EPC (cf. T 691/18, Reasons 2, citing T 139/87, and Reasons 4; T 1060/13, Reasons 4.1). Thus, even if the amendments raise "new" objections not previously discussed, interlocutory revision must be allowed since the main purpose of this legal instrument is to shorten the appeal proceedings to the benefit of procedural expediency and economy and to avoid unnecessary workload for the Boards of Appeal in the interest of both the appellant and the EPO (see e.g. T 1060/13, Reasons 4.1).

2.4.3 The conclusions of point 2.4.2 are in principle also reflected in the Guidelines for Examination in their edition of March 2022. See e.g. chapter E-XII, section 7.1, 4th paragraph:

"The department concerned will rectify its decision if convinced in the light of the grounds of appeal that the appeal is admissible and well founded. This could arise, for example, because:... (iii) the decision of the department concerned does not appear to be incorrect, but the applicant ... files amendments to the application, which overcome the objections of the decision under appeal (see T 139/87)",

and chapter E-XII, section 7.4.2, 1st sentence:

"If amendments clearly overcome the grounds for refusal, interlocutory revision is granted even if further new objections arise".

Nonetheless, some passages of those Guidelines are not consistent with those conclusions. Article 20(2) RPBA 2020 stipulates that "[i]f, in its decision, a Board gives a different interpretation of the Convention from that provided for in the Guidelines for Examination, it shall state its grounds for doing so if it considers that the decision will be more readily understood in the light of such grounds". Therefore, this board - as did the deciding board in case T 1060/13 (cf. Reasons 4.3) - considers it appropriate to point out that there are (still) some significant inconsistencies between the current Guidelines and the established case law as to the interpretation of Article 109(1) EPC. More specifically, according to those Guidelines (see e.g. chapter E-XII, section 7.4.2, 6th paragraph),

"[i]f amendments made to the independent claims clearly do not meet the requirements of Art. 123(2), interlocutory revision is not granted, but the division sends the file to the boards of appeal. If there are doubts as to whether the amendments meet the requirements of Art. 123(2) or the amendments clearly meet the requirements of Art. 123(2), the division checks whether the amended claims overcome the ground(s) for refusal".

Moreover, in arriving at a decision on granting interlocutory revision, according to those Guidelines (cf. E-XII, section 7.4.2, 5th paragraph), the examiner is supposed to take into account all the grounds mentioned in the original decision, including the main or supporting arguments already raised in **previous objections** to patentability to which the applicant has had an opportunity to respond and to which reference is made in the grounds of refusal (e.g. objections mentioned in **previous communications**, during **personal consultation** or at **oral proceedings**). Conversely, on the basis of the established case law, interlocutory revision must be granted if the amendments clearly overcome the grounds for refusal, even if further new objections arise, i.e. irrespective of whether *new* objections under Article 123(2) EPC or whether *previous* objections referenced in the appealed decision were raised by the first-instance department.

- 2.4.4 In that regard, the present board is aware of T 2445/11, which hints at a different approach and disagrees with the approach adopted in T 1060/13 as possibly being "too rigid, as it leaves no room for a pragmatic assessment of the situation with a view to procedural efficiency and may result in a needless repetition of the first-instance proceedings" (cf.

Reasons 8). This decision is also referred to in the Guidelines (cf. E-XII, section 7.4.2).

However, the present board does not follow the conclusions drawn in case T 2445/11. The fact that the first-instance proceedings must be "repeated" is a consequence of the very fact that the examining division decided to refuse an application on specific grounds - and not on others - and that these specific grounds are overcome with the appeal. In such a situation and in line with the established case law, Article 109(1) EPC obliges the examining division to rectify its decision and continue examination of the application.

- 2.4.5 Hence, the established case law (see point 2.4.2 above) and the current Guidelines are inconsistent with each other.
- 2.4.6 As to the present case, it is apparent to the board that, in view of the statements made by the examining division (cf. point 2.2.2 above), the addition of at least **feature (d)** (taken from former claims 5 and 18) to the independent claims clearly overcomes all the objections raised in the appealed decision.
- 2.4.7 It follows that the appeal is "well founded" within the meaning of Article 109(1) EPC. There is also no apparent reason to contest that the appeal is "admissible" within the meaning of Article 109(1) EPC. The examining division should therefore have indeed rectified its decision and continued with the examination of compliance with the requirements of the EPC. However, for whatever reasons, they did not do so.

2.5 *Reimbursement of the appeal fee (Rule 103 EPC)*

2.5.1 The appellant originally requested the reimbursement of the appeal fee under Rule 103(1)(a) EPC, according to which the appeal fee shall be reimbursed *in full* in the event of interlocutory revision or where the board deems an appeal to be allowable, if such reimbursement is equitable by reason of a "substantial procedural violation".

2.5.2 In response to the board's communication, the appellant requested the *partial* reimbursement of the appeal fee. The appellant, however, did not specify whether this request was meant to supersede the original one or whether it was meant to be a subsidiary request.

2.5.3 In any event, the mere fact that the examining division did not rectify its decision cannot constitute a "substantial procedural violation" justifying a reimbursement of the appeal fee under Rule 103(1)(a) EPC (see e.g. T 1060/13, Reasons 4.5 and the further decisions cited therein). The appellant did not explain which specific actions of the examining division should indeed be regarded as a substantial procedural violation. Nor can the board identify any objective deficiencies in the examination proceedings. Thus, a reimbursement of the appeal fee *in full* under Rule 103(1)(a) EPC is not justified.

2.5.4 However, given that the appellant's indication of non-attendance and their request for partial reimbursement was submitted within one month of notification of the board's communication under Article 15(1) RPBA 2020 (see also point 1.1 above), the appeal fee is to be partially reimbursed under Rule 103(4)(c) EPC.

3. *Remittal of the case (Article 111(1) EPC)*

3.1 It follows from the above that the subject-matter of independent claims 1 and 11 of the main request is new (Article 54(3) EPC) in view of document **D5** and that the examining division should have rectified its decision. In the board's view, this represents a "special reason" within the meaning of Article 11 RPBA 2020 for a direct remittal of the case.

3.2 Consequently, the board remits the case to the examining division for further prosecution under Article 111(1) EPC on the basis of the sole claim request on file.

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.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated