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**Datasheet for the decision
of 26 May 2025**

Case Number: T 2536/22 - 3.4.02

Application Number: 10830570.7

Publication Number: 2499526

IPC: G02B6/42

Language of the proceedings: EN

Title of invention:

METHOD AND APPARATUS FOR COUPLING OPTICAL SIGNAL WITH PACKAGED
CIRCUITS VIA OPTICAL CABLES AND LIGHTGUIDE COUPLERS

Applicant:

Elbex Video Ltd.

Headword:

Relevant legal provisions:

EPC R. 137(3)

RPBA 2020 Art. 12(6)

Keyword:

Amendments of application - discretion of examining division (yes) - consent of examining division (no) - error in use of discretion at first instance (no)

Late-filed request - no longer maintained in first-instance proceedings - admitted in appeal proceedings (no)

Decisions cited:

G 0007/93, T 1064/04

Catchword:



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Case Number: T 2536/22 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 26 May 2025

Appellant: Elbex Video Ltd.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 11 May 2022
refusing European patent application No.
10830570.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Bekkering
Members: B. Müller
R. Bekkering

Summary of Facts and Submissions

I. The applicant appealed against the decision of the examining division refusing European patent application No. 10830570.7 on the basis of Article 97(2) EPC because of "lack of claims" (Articles 113(2) and 78(1)(c) EPC).

II. According to the statement setting out the grounds of appeal, page 7, the applicant requested that the decision under appeal "is overturned and that the patent application be granted with the original filed claims, with the claims when entering the European phase or, otherwise, with any of the amended set of claims filed during the patent application prosecution".

As a precaution, the applicant requested oral proceedings.

III. In a communication annexed to a summons to oral proceedings, the board informed the applicant of its provisional and non-binding opinion that the examining division's decision not to admit to the proceedings the only set of claims on file (i.e. the set of claims filed with letter **L9** dated 7 March 2022) should be maintained. Moreover, since none of the other sets of claims filed during the examination proceedings was underlying the appealed decision, none of them was to be admitted to the appeal proceedings pursuant Article 12(6) RPBA.

IV. The following communications of the examining division and letters of the applicant, referred to in the appealed decision, are referred to in the present decision:

L9: Letter of the Applicant, dated 07-03-2022

C11: Amended summons to attend the oral proceedings dated 19-01-2022

C10: Brief communication sent on 08-11-2021

L8: Letter of the Applicant, dated 20-07-2021

C9: Summons to attend the oral proceedings dated 18-01-2021

L2: Letter of the Applicant, dated 23-06-2015

V. The board's preliminary opinion on the examining division's decision not to admit to the proceedings the only set of claims then on file, namely the set of claims filed with letter **L9**, was worded in the board's communication annexed to the summons as follows (see points **4** and **8** of the board's communication annexed to the summons):

"**4.** From the appealed decision, point III (and the minutes, point 26), the board understands that at the end of the first-instance examination proceedings, i.e. at the end of the second oral proceedings before the examining division, held on 7 April 2022, a single set of claims was on file, filed with **L9** (i.e. the letter dated 7 March 2022) "to replace the previous set of claims" (see page 1 of the letter dated 7 March 2022). This set of claims was not admitted into the proceedings under Rule 137(3) EPC (decision, points 10 and III).

[...]

8. Set of claims filed with the letter **L9**

The board is of the preliminary opinion that the examining division did not erroneously exercise its discretion under Rule 137(3) EPC not to admit the set of claims filed with letter **L9** into the first-instance proceedings, and that there are no circumstances of the appeal case justifying

their admittance (Article 12(6), first sentence, RPBA). Therefore, the board intends to maintain the decision of the examining division and thus to not admit the set of claims filed with letter **L9** into the appeal proceedings.

8.1 Appealed decision

The examining division decided not to admit the set of claims filed with letter **L9** into the proceedings for the following reasons:

8.1.1. Claim 1 of the set of claims filed with **L9** differed from claim 1 of the set of claims filed with letter **L2** (and re-filed with **L8**) only in that the word "sharp" had been added into the following feature of claim 1 of letter **L2**: "terminating said optical cable end by a process selected from a group comprising *sharp* cutting, trimming, shaping and combinations thereof". The examining division concluded that this "amendment did not overcome any of the objections under respective Art. 123(2), 84, 52(1), 56, 54(3) EPC as provided under items 4 to 7 of **C10**, and which were subsequently maintained in **C11**" (appealed decision, point I.9.3).

8.1.2 According to the appealed decision, point III, "[g]iven the above pending and unresolved objections, the latest set of claims filed with **L9** was not admitted into the procedure". These "pending and unresolved objections" pertain to objections under Articles 54(3), 56, 84 and 123(2) EPC, as elucidated in points II.12 to II.15 of the appealed decision.

8.1.3 During the second oral proceedings held on 7 April 2022, the examining division additionally pointed to the applicant that, in addition to the pending objections under Art. 123(2), 84, 52(1), 56, 54(3) EPC,

the present request is actually broader than the published set of claims" (appealed decision, point I.10)

8.2 Review of an examining division's discretionary decision

8.2.1 The examining division's decision not to admit the set of claims filed with letter **L9** into the proceedings under Rule 137(3) EPC is a discretionary decision the review of which is subject to constraints. According to Article 12(6), first sentence, RPBA (applicable under Articles 24 and 25 RPBA), the board shall not admit requests which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an *error in the use of discretion* or unless the *circumstances of the appeal case* justify their admittance. Article 12(6), first sentence, RPBA takes up an older version of the provision as well as the case law that the Boards have established on the matter (cf. EPO OJ Suppl. 2/2020, Table setting out the amendments to the RPBA and the explanatory remarks, page 58).

8.2.2 "It is established case law that, on appeal against a decision taken by a department of first instance in exercise of its discretion, it is not for the board to review all the facts and circumstances of the case as if it were in that department's place and decide whether or not it would have exercised discretion in the same way" (Case Law of the Boards of Appeal, 10th edition 2022, Chapter V.A.3.4.1 b)). The board's review of a discretionary decision of the examining division is essentially limited to ensuring that the examining division has not exercised its discretion in an inappropriate manner. As stated in Case Law of the Boards of Appeal, 10th edition 2022, Chapter IV.B.2.4.1, "[o]nce

an examining division has exercised such discretion, a board of appeal should only overrule it if it comes to the conclusion either that the examining division did not exercise its discretion in accordance with the right principles or that it exercised its discretion in an unreasonable way and had thus exceeded the proper limit of its discretion".

8.3 Correct exercise of discretion by the examining division

From the contested decision the board cannot discern any improper exercise of discretion in the way the examining division dealt with the case.

8.3.1 According to established case law, "[t]he 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, points 2.2 and 2.3)" (see T 1064/04, reasons of the decision, point 4).

In view of the fact that 11 communications had been issued by the examining division and 2 oral proceedings had been held, it appears that

- (a) the applicant's interest in obtaining a valid patent has been sufficiently taken into account by the examining division. Additionally, "the division proposed a number of suggestions how it would be possible for the applicant to overcome numerous pending objection [sic]" (appealed decision, point I. 5; see e.g. communication **C9**, point 4.5),

(b) the EPO's interest in bringing examination to a close was more than justified, especially since "that during entire examining procedure not a single request was filed complying with Art. 123(2) EPC" (appealed decision, point III). As explained by the examining division during the second oral proceedings, "the procedure had been very long and [...] the applicant had been given many more chances than usual" (minutes of the second oral proceedings, point 10).

8.3.2 Further factors which, in the present case, are relevant when considering the application of Rule 137(3) EPC for not admitting a set of claims into the proceedings also appear to have been considered by the examining division:

(c) The applicant had been given at least one opportunity to amend the application.

(d) The applicant returned essentially to a claim which was already considered unallowable by the examining division. In fact, claim 1 of letter **L9** differs from claim 1 of letter **L2** (and which was objected to under Article 123(2) EPC) merely by adding the word "sharp" in a feature of claim 1 which was not objected. Returning to unallowable claims without providing convincing reasons goes against the need of procedural economy.

(e) The amendment of claim 1 of letter **L9** (i.e. adding the word "sharp") was not suitable to overcome any of the objections at stake. Actually, it would appear from letter **L9**, pages 1 and 2, that the applicant did not explain at all why claim 1 had been amended by specifying that the cutting is a sharp cutting.

- (f) The examining division provided a brief yet sufficiently compelling rationale for the non-admission of the set of claims of letter **L9** (appealed decision, points I.9.2, I.9.3, I.10, I.12 to I.15, III).
- (g) The applicant had been warned about the examining division's intention to use Rule 137(3) EPC (see letters **C10**, point 1, and **C11**, points 3 and 4).
- (h) The amended set of claims of letter **L9** was filed at a (very) late stage of the proceedings, namely after the summons for a second oral proceedings. However, the later the stage at which amendments are filed, the more restrictively the discretion not to admit these amendments into the proceedings could be exercised.

In the board's view, the discretion was thus exercised in accordance with the right principles, and also not in an unreasonable way, on the contrary.

8.4 No circumstances justifying the admittance

It seems that the applicant has not put forward any special circumstances why the set of claims of **L9** should be admitted to the appeal proceedings even though the examining division had not admitted it to the first-instance examination proceedings. Nor does the board see any such circumstances.

8.5 It follows that since it appears that the examining division did not exercise its discretion in not admitting the set of claims filed with letter **L9** under Rule 137(3) EPC in an erroneous manner, and that also no circumstances justify their admittance, the board intends to uphold that decision (Article 12(6), first sentence, RPBA)".

VI. In the communication annexed to the summons, the board informed the applicant that it intended to exercise its discretion under Article 12(6) second sentence RPBA in not admitting into the proceedings any of the sets of claims requested by the applicant but not underlying the appealed decision, i.e. "the original [*sic*] filed claims, [...] the claims filed when entering the European Phase or [...] any of the amended set of claims filed during the patent application prosecution", for the following reasons (see points **12** and **13** of the board's communication annexed to the summons):

"12. Sets of claims not underlying the appealed decision

The board intends to exercise its discretion under Article 12(6), second sentence, RPBA, in not admitting into the proceedings any of the sets of claims not underlying the appealed decision for the following reasons:

12.1 According to Article 12(2) RPBA, "[i]n view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, a party's appeal case shall be directed to the requests [...] on which the decision under appeal was based".

Contrary to Article 12(2) RPBA, the applicant requested that a patent "be granted with the original [*sic*] filed claims, with the claims filed when entering the European Phase or, otherwise, with any of the amended set of claims filed during the patent application prosecution". In fact, except from the set of claims filed with letter **L9**, none of the sets of claims referred to in the applicant's statement of grounds of appeal is underlying the appealed decision.

If the board would grant the applicant's request that a patent "be granted with the original [*sic*] filed claims, with the claims filed when entering the European Phase or, otherwise, with any of the amended set of claims filed during the patent application prosecution", this would require the board itself to examine and take a final decision on sets of claims on which the examining division had not taken a final decision. This is contrary to the primary purpose of the appeal proceedings, i.e. to assess the correctness of the first-instance decision.

12.2 According to Article 12(6), second sentence, RPBA, "[t]he Board shall not admit requests [...] which were no longer maintained in the proceedings leading to the decision under appeal, unless the circumstances of the appeal justify their admittance".

In the present case, the applicant has expressly abandoned all previously filed claim sets:

- the claim set of **L9** was filed "to replace the previous set of claims" (**L9**, page 1), i.e. that of **L8**, and
- the claim set of **L8**, in turn, was filed "to replace all the set [*sic*] of claims previously filed up to the current Summons" (**L8**, page 1) - which must be understood as every claim set filed up to that point.

In other words, "the original filed claims", "the claims filed when entering the European Phase", and "any of the amended set of claims filed during the patent application prosecution" were no longer maintained within the meaning of Article 12(6), second sentence, RPBA, and shall, as a rule, not be admitted into the proceedings, i.e. be disregarded entirely.

The applicant has also not put forward any circumstances justifying a return to sets of claims which have been

replaced during the examination procedure. Nor does the Board see any legitimate reason for the applicant to revert to a set of claims which has been superseded by another set of claims during the examination proceedings.

13. Applicant's arguments in favour of admitting a set of claims into the proceedings

13.1 According to point III of the appealed decision, the patent application was refused for lack of claims.

13.2 According to the statement of grounds of appeal, the applicant provided essentially the following arguments in favour of admitting a set of claims into the proceedings (the letters B, D, L, M and P in the parenthesis below refer to those used in the statement of grounds of appeal):

- The examining division's objections are wrong (points B and P).
- The main objections under Article 123(2) and 84 EPC relate to an amendment made in the claims introducing the term 'lightguide coupler' (points C and M). However, "[t]he Examining Division must have known that lightguide couplers were already recited in the original application (even in the title, being a clear and known term" (point D).
- "[D]ue to technical/computer problems (connection problems and, afterwards, audio problems) with the videoconference, Mr. Erlberbaum the inventor could not talk in the Oral Proceedings" (point L).
- "The Examining Division should have searched to find what is *[sic]* the term [lightguide coupler] stands for. In short, the lightguide coupler comes from a name (and trademark)" (point M).

- "So, the issue involved a term or name (lightguide coupler) amended as original filed in the application [sic]. Elbex did change the name to lightguide coupler [...] for its very small device, to be a lightguide coupler" (point M).

13.3 From these arguments of the applicant, the board cannot discern any justification for the applicant's view that the Examining Division was wrong in finally not admitting any claims into the proceedings.

In particular, with regard to the submission under point L above, the board notes that the applicant was represented at the oral proceedings by a professional representative who stated that "he had brought forward all his arguments concerning why the division should consent to the amendments" (minutes of the second oral proceedings, point 12).

13.4 In conclusion, the board is not minded to set aside the impugned decision. It is highly likely that the appeal will be dismissed".

- VII. In response to the summons to oral proceedings, the applicant informed the board with its letter dated 13 May 2025 that it decided not to attend the oral proceedings. The applicant did not file any comments concerning the board's preliminary opinion as annexed to the summons.
- VIII. Following the applicant's letter of 13 May 2025, the oral proceedings were cancelled.

Reasons for the Decision

1. In its letter dated 13 May 2025 the applicant stated:
"Following your communication from 08.07.2024 regarding the Oral Proceedings that will take place in Munich on 22 May 2025, we hereby confirm that the applicant HAS DECIDED NOT TO ATTEND ORAL PROCEEDINGS" (emphasis by the applicant).

This statement is considered equivalent to a withdrawal of the request for oral proceedings (see Case Law of the Boards of Appeal, 10th edition 2022, section III.C.4.3.2 and the references cited there). Consequently, the oral proceedings were cancelled and a decision on the file as it stands is now given.

2. In the board's communication annexed to the summons, the board expressed its preliminary opinion, together with the underlying reasons, that the only set of claims then on file before the examining division (set of claims filed with letter **L9**) had been correctly not admitted to the proceedings by the examining division (see point V. above) and that the board intended to exercise its discretion under Article 12(6) second sentence RPBA by not admitting into the appeal proceedings any of the other sets of claims filed during the first-instance examination proceedings but not underlying the appealed decision (see point VI. above).

3. The applicant did not rebut the board's provisional opinion. The board sees no reason to deviate from its preliminary opinion, which therefore now becomes final.
4. It follows that the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

R. Bekkering

Decision electronically authenticated



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 2536/22 - 3.4.02

D E C I S I O N
of the Technical Board of Appeal 3.4.02
of 3 June 2025
correcting an error in the decision
of 26 May 2025

Appellant:
(Applicant)

Elbex Video Ltd.
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Representative:

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 11 May 2022
refusing European patent application No.
10830570.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: R. Bekkering
Members: A. Hornung
B. Müller

The composition of the board in the decision T 2536/22-3402 dated 26 May 2025 is corrected as follows:

Chairman: R. Bekkering
Members: A. Hornung
B. Müller

The Registrar:

The Chairman:



K. Boelicke

R. Bekkering

Decision electronically authenticated