

## Summary of facts and submissions

- 1 European patent No 1883190 B1 is based upon European patent application No 07014824, filed on 27.07.2007 and claiming priority of US833822P filed on 28.07.2006.
- 2 The mention of the grant of the patent has been published in European Patent Bulletin of 15.12.2010. Proprietor of the patent is Innovative Sonic Limited
- 3 Notice of opposition has been filed by  
Telefonaktiebolaget LM Ericsson with fax of 15.09.2011  
The opponent requests revocation of the patent in its entirety based on:  
Article 100(a) (Article 54 and 56 EPC);  
Article 100(b) (Article 83 EPC)  
Article 100(c) (Article 123(2) EPC)  
and made a subsidiary request for oral proceedings, Art.116(1) EPC, in case the request for revocation could not be granted.  
The opponent based his grounds for the opposition on the following documents:  
A1: 3GPP TS 25.321 V6.6.0  
A2 3GPP TSG-RAN WG2 Meeting #49, document Tdoc R2-053076  
A2a: TSG-RAN WG2 meeting #50, document R2-060113  
A2b: 3GPP TDocs (written contributions) at meeting, Meeting: R2-49 - 2005-11-07 to 2005-11-11  
A2c: Print-out of web page at [http://www.3gpp.org/ftp/tsg\\_ran/WG2\\_RL2/TSGR2\\_49/Documents](http://www.3gpp.org/ftp/tsg_ran/WG2_RL2/TSGR2_49/Documents).  
A3: 3GPP TSG-RAN WG2 meeting #48, document R2-051957  
A3a: Print-out of email retrieved from the URL [http://list.etsi.org/scripts/wa.exe?A2=ind0508&L=3GPP\\_TSG\\_RAN\\_WG2&P=R126417&I=3](http://list.etsi.org/scripts/wa.exe?A2=ind0508&L=3GPP_TSG_RAN_WG2&P=R126417&I=3)  
A3b: Print-out of web page [http://www.3gpp.org/ftp/tsg\\_ran/WG2\\_RL2/TSGR2\\_48/Documents](http://www.3gpp.org/ftp/tsg_ran/WG2_RL2/TSGR2_48/Documents).  
A4: 3GPP TSG-RAN2 Meeting #54, document Tdoc R2-062399.  
A4a: Print-out of email retrieved from the URL [http://list.etsi.org/scripts/wa.exe?A2=ind0608D&L=3GPP\\_TSG\\_RAN\\_WG2&P=R38178&I=3](http://list.etsi.org/scripts/wa.exe?A2=ind0608D&L=3GPP_TSG_RAN_WG2&P=R38178&I=3)

A4b: Print-out of web page [http://www.3gpp.org/ftp/tsg\\_ran/WG2\\_RL2/TSGR2\\_54/Documents](http://www.3gpp.org/ftp/tsg_ran/WG2_RL2/TSGR2_54/Documents).

A5: 3GPP TS 25.321 V.7.1.0 (*substantially corresponding to D1: ETSI TS 125 321 V7.1.0 cited during the examination phase*)

The opponent provided in addition a reasoned statement objecting the validity of the priority claim of the contested patent arguing that the patent does not relate to the "same invention" and that there are no evidence that the applicant of the European patent owns right to claim the priority according to Art.87(1) EPC.

- 4 In a reply dated 30.04.2012, the proprietor, Innovative Sonic Limited, requested that the opposition should be rejected and the patent maintained as granted. As an auxiliary request, oral proceedings were requested.
- 5 The proprietor provided in addition a reasoned statement supporting the validity of the priority claim of the contested patent with respect to the "same invention" and postponed arguments, facts and evidence concerning the transfer of priority right. He further supported compliance with Art.123(2), Art. 83 EPC and novelty and inventive step of the subject-matter of claims 1-2 with respect to the combinations as submitted by the opponent.
- 6 In an official communication dated 27.05.2013, the parties were summoned to oral proceedings to take place on 29.10.2013 and informed about the addition of a legally qualified examiner.
- 7 In letter dated 26.08.2013 the opponent precautionarily requested to disregard any facts and evidence submitted by the proprietor concerning the priority transfer in the absence of a reason justification.
- 8 In response to the summons with a letter dated 30.09.2013 and in support of the validity of the claimed priority for granted claims 1 and 2, the proprietor submitted arguments based on the following evidences:
  - Exhibit E1 and E1a — Taiwanese Patent Act. Art, 7
  - Exhibit E2 and E2en — Employment Agreement Inventor
  - Exhibit E3 — US MPEP Chapter 26
  - Exhibit E4 — Assignment of Invention US 60/833, 822
  - Exhibit E5 — Nunc pro Tunc assignment US 60/833,822
  - Exhibit E6 — Legal Opinion — Nunc pro Tunc
  - Exhibit E7 — Assignment of Invention US 11/878,892
  - Exhibit E8 — US 11/878,892

Exhibit E9 — Embedded Microcontrollers, 2001

and referred to a parallel opposition proceedings between the two parties.

- 9 In response to the summon with a letter dated 30.09.2013 the opponent submitted further arguments with respect to the grounds of opposition. For supporting the arguments with respect to public availability of A1-A4 the following evidences:

A3c: Print-out of emails list 3GPP\_TSG\_RAN\_WG2 - August 2005

A4c: Print-out of emails list 3GPP\_TSG\_RAN\_WG2 - August 2006

were annexed.

- 10 In a further letter dated 21.10.2013 the opponent requested again to disregard, under Art. 114(2) EPC, any facts and evidence submitted by the proprietor with letter 30.09.2013 regarding the entitlement to claim priority.

- 11 In a letter dated 22.10.2013 the proprietor submitted observations in reply to the submission by the opponent of 30.09.2013 and further exhibits concerning the priority claim referring to parallel opposition cases:

Exhibit E10 Affidavit of Mr. Tsung-Tang Shih, Chairman of ASUSTeK Computer Inc.

Exhibit E11 Affidavit of Mr. Su-Huei Liu, Chairman of Innovative Sonic Ltd.

Exhibit E12 Affidavit of Mr. Vincent Hong, General Counsel of ASUSTeK Computer Inc.

Exhibit E13 Affidavit of Mr. Frank Lin, Patent Engineer of the Legal Affairs Center of ASUSTeK Computer Inc.

Exhibit E14 Email from NAIP (Representatives of ASUSTeK and Innovative Sonic Ltd.) to ASUSTeK regarding the report on the filing of the US provisional

application 60/833,822

Exhibit E14a Translation of E14

Exhibit E14b Enclosure from E14/E14a

Exhibit E14c Enclosure from E14/E14a, report forwarding the official filing receipt of the USPTO for the US provisional application 60/833,822

Exhibit E15 Email from NAIP to ASUSTeK, reporting on the filing of the subsequent EP application 07 014 824

Exhibit E15a Translation of E15

Exhibit E15b Enclosure from E15/E15a, report of European representatives Höfer & Partner to NAIP regarding the filing of the subsequent European Application 07 014 824 in the name of Innovative Sonic Ltd., with attachments, including the request for grant of a European patent, the receipt for documents and the designation of inventor

Exhibit E16 Copy of Decision X ZR 49/12 of the German Federal Supreme Court

- 12 In a further letter dated 23.10.2013 the opponent insisted to disregard any facts and evidence submitted by the proprietor with letter 30.09.2013 regarding the entitlement to claim priority and provided further argumentation.
- 13 In an communication dated 25.10.2013, the parties were informed of the cancellation of the oral proceedings scheduled for the 29.10.2013 and in a following communication dated 13.11.2013, the parties were summoned to oral proceedings to take place on 23.01.2014.
- 14 In response to the summons, with a letter dated 23.12.2013 the opponent requested again to reject as inadmissible under Art.114(2) EPC the facts and evidence submitted by the proprietor with its letters of 30.09.13, 22.10.13 and provides further arguments against the valid transfer of priority also based on new documents:
- A6: Prof. Georg H.C. Bodenhausen, Guide to the Application of the Paris Convention for the Protection of Industrial Property As Revised at Stockholm in 1967, World Intellectual Property; 1 February 1968, PP. 1-5, 35-38
- A7: Affidavit dated January 17, 2013 by Chung-Jen Hong (also referred to in the affidavit as Vincent Hong) (filed during the opposition proceedings relating to European patent EP 2 077 691 B1)
- A8: Affidavit dated January 18, 2013 by Su-Huei Liu (filed during the opposition proceedings relating to European patent EP 2 077 691 B1)
- A9: Copy of the opponent's letter of March 5, 2013 filed during the opposition proceedings relating to European patent EP 2 077 691 B1
- A10: Letter of February 27, 2013 of Peter Moye and David Frazee, K&L Gates, LLP (filed during the opposition proceedings relating to European patent EP 2 077 691 B1, as annexed to A9)
- A10a Memorandum, dated February 27, 2013, attached to A10
- 15 In a letter dated 22.01.2014 the proprietor provided further arguments supporting the validity of the transfer also based on new document

E17: Opinion of a barrister of law admitted on the roll of the Supreme Court of Mauritius (filed during the opposition proceedings related to European Patent EP2077691 B1 as enclosure E52)

- 16 Oral proceedings before the Opposition Division finally took place on 23.01.14. At the end of the Oral Proceedings, the Chairman announced the decision of the Opposition Division to revoke the patent, having regard to the disclosure of document A4 constituting prior art under Article 54(2) EPC, following the consideration that the transfer of the right to claim priority was not valid, which resulted in lack of novelty of the subject-matter of Claim 1. The corresponding opposition ground under Article 100(a) EPC hence prejudiced the maintenance of the patent.

### Reasons for the decision

The opposition is admissible because it meets the requirements of Articles 99 (1) and 100 EPC and of Rule 76 EPC. It is to note that the admissibility of the opposition has not been contested by the proprietor.

- 1 TREATMENT OF THE PATENTEE'S SUBMISSION OF 10 JUNE 2013
- 1.1 During the oral proceedings the proprietor referred to his submission of 10 June 2013. At this stage it emerged that a copy of said submission had erroneously not been forwarded to the opponent. In EPO (*inter partes*) proceedings documents for consideration in the procedure may not be filed as confidential. If documents are marked confidential such documents are either returned to the filing party without taking note of their content (cf. T 516/89, OJ EPO 1992, 436) or, following clarification with the submitting party if applicable, the marking as confidential is interpreted as request for exclusion from file inspection.
- 1.2 In the present case the documents of 10 June 2013 were taken into consideration on behalf of the opposition division in treating the proprietor's request for change of address. Furthermore, the wording of the cover letter suggests that the proprietor was indeed tending to have the documents "only" excluded from file inspection but not to be treated as confidential in the strict sense. This was confirmed by the representative during oral proceedings who

agreed to the making available of a copy of the submission to the opponent. The petition was therefore interpreted as request for exclusion from file inspection.

- 1.3 Under Article 128(4) and Rule 144(d) EPC in conjunction with Article 1(2)(a) of the Decision of the President of the EPO dated 12 July 2007 concerning documents excluded from file inspection (Special edition No. 3, OJ EPO 2007, J.3), documents which do not serve the purpose of informing the public about the European patent can be excluded from file inspection on the basis of a substantiated request showing that public access to the documents in question would be prejudicial to specific and concrete personal or economic interests (cf., e.g. T 379/01). In the oral proceedings the proprietor was informed that the division was minded to refuse his request to exclude the documents from file inspection. The request was not reasoned and accordingly fails to establish any concrete and specific prejudice. In addition, given the relevance of the documents in question – i.e. since they had been submitted in order to establish that the legal person of the proprietor had not changed – a strict standard has to be applied. The division also expresses doubts insofar as documents from a public register are normally available to the interested public anyway and no information was submitted by the proprietor that this would be different in the case of the Virgin Islands and/or Mauritius. If this is indeed the case then it cannot be seen how a publication via the EPO Register could violate the requester's interests.
- 1.4 For these reasons the requirements for excluding the documents from file inspection according to the above-mentioned provisions and case law are not fulfilled and the request must be refused. As a consequence, the documents will be open for inspection once this decision has become final (cf. Art. 1(3) of the above-mentioned Decision of the President).
- 1.5 The division regrets the procedural error that no copy of the submission was forwarded to the opponent at the relevant time. Nevertheless, given that – as agreed by both the proprietor and the opponent - the opponent eventually received a copy from the chairman during oral proceedings and since the documents were of no relevance for the division's final decision under Article 101 EPC, it was not considered necessary - nor requested by the opponent - to repeat parts of the oral proceedings or to return to the written procedure. In

other words, despite a procedural error having occurred, it is not considered to have brought about a violation of the opponent's right to be heard under Article 113(1) EPC.

2 ARTICLES 100(c), 123(2) EPC

2.1 The OD considers the subject-matter of the claims 1 and 2 not infringing Art. 123(2) EPC because the claims have basis in the application as originally filed.

The Opponent specifically objected that the feature "setting a value of the HLBS index to 15 when a Higher priority Logical channel Buffer Status value is greater than 82 and smaller or equal 100" has no basis. He argued that the current formulation of claim 1 implies two different steps to be considered:

step a) setting a value when  $82 < \text{HLBS} < 100$

step b) setting a value when  $100 < \text{HLBS}$ .

which should also be emphasized by the use of the term "further" in the characterizing part of claim 2, wherein step a) is nowhere to be found in the application's description in the part illustrating the invention but only relating to the prior art.

The OD does not share this argument. It is directly and unambiguously derivable throughout the whole description and specifically from page 4, line 16 to page 5, line 15 the handling of the "a)" case is disclosed in combination with the "b)" case, the case b) being an improved completion of case a). Additionally, the disclosure from page 7, "step 302" at the bottom to page 8, line 11 clearly shows the combination of the two cases with respect to the prior art and the invention as claimed.

3 ARTICLES 100(b), 83 EPC

3.1 The OD considers that the patent application disclose the invention in a manner sufficiently clear and complete for it to be carried out by a skilled person.

The Opponent specifically objected that, since the invention is broadly directed to scheduling according to MAC protocols of the 3GPP specification, it is not specified how it can be carried out over the whole range, thus including 3GPP protocols where there is no scheduling information of the MAC protocol.

The OD does not agree with this objection. The subject-matter of the claims in combination with the description clearly allow a skilled person to carry out the invention, since there are sufficient and clear indication, e.g. to Standards/Drafts (page 2, page 4, last paragraph to page 6 first paragraph), or MAC scheduling protocols (page 7, last paragraph to page 8) which would allow the skilled person to understand how, and in which context the invention is to be carried out. Moreover, the use of a specific data field within the scheduling information (HLBS) is a further indication for the skilled person of the range covered.

- 3.2 Furthermore, during the oral proceedings the Opponent raised a new "fresh" ground of opposition based on Articles 100(b), 83 EPC for claim 2. Since the OD considered the ground was prima facie relevant due to a formulation which could have been interpreted as double steps and the patentee had no major objections to discuss it, it was admitted in the procedure.

Specifically, the Opponent objected that, the formulation in claim 2 "the program code comprises setting...and further comprises setting..." cannot be carried out by a skilled person since the application does not define how a single code could comprise these sort of double setting without the use of double separate instructions' steps.

The OD does not agree with this objection. The skilled person would definitely know how to implement the double comparison by the use of a program code, namely implicitly with appropriate coded instructions for carrying out the appropriate comparison and setting. Moreover, the OD does not see any different separate steps in implementing the setting of the HBLBS index.

#### 4 ADMITTANCE OF DOCUMENTS FILED ON OR AFTER 30 SEPTEMBER 2013

- 4.1 The opponent requested the documents filed by the proprietor on or after 30 September 2013 with regard to the transfer of priority to be disregarded as late-filed. Article 114(2) EPC vests the opposition division with discretion. This

discretionary power must be exercised in a correct manner. While ample guidelines exist, it is not the case – as suggested by the opponent – that a document would need to be *necessarily and automatically* refused in a given set of circumstances, which fulfil a certain criterion such as a piecemeal way of submitting evidence. Rather, correct exercise of the discretion means and requires that due account be taken of the *specific* circumstances of the case. In this regard the division notes that the way(s) in which a valid succession in title can be proven under current law and practice leaves a certain room for interpretation. Namely, it does not appear to have been finally settled whether in case of a succession by virtue of an assignment specific formal requirements would need to be fulfilled in each and every case in the same manner or whether the completion of different formal exigencies could be sufficient in a given case and, if so, according to which law or laws these requirements would need to be determined. Neither the Guidelines for Examination nor existing case law from the Boards of Appeal, including decision T 62/05, appear to exhaustively clarify this particular issue. Under such circumstances the division considers it neither unusual nor abusive that a party advances different approaches and also adapts its strategy in view of the outcome of parallel proceedings, thus waiting for the availability of the written decision in these cases. Such a “filing strategy” cannot *per se* lead to an exclusion of documents as late-filed irrespective of their relevance. In this regard the division already advanced the preliminary view in the communication of 13 November 2013 and maintained this opinion in the oral proceedings that the documents were *prima facie* relevant since they contained new evidence and arguments which may become decisive in reaching a conclusion on the entitlement to claim priority.

- 4.2 As a consequence, the documents filed by the proprietor on or after 30 September 2013 – with the exception of the submission of 22 January 2014 (see *infra*) – are admitted to the procedure under Article 114(2) EPC. Nothing else can apply to the submissions made by the opponent in reply to these documents. The opponent must be given the right to react to new evidence and arguments filed late in the procedure and such submissions cannot be disregarded under Article 114(2) EPC in a case as the present one.
- 4.3 It is only with regard to the proprietor’s submission of 22 January 2014 that a different conclusion is reached. Even in circumstances as described above, due account must be taken of the principles of procedural economy and fair treatment of the other party. A submission made only one day before oral

proceedings after the parties had been given sufficient time and several opportunities to file documents must be rigorously scrutinised. The division does not share the proprietor's view that the submission, which was made in reply to the opponent's letter of 20 December 2013, could not have been filed earlier. Particularly, the further arguments and evidence are not *prima facie* relevant in reaching a conclusion with regard to the valid transfer of the priority right. For these reasons, the submission of 22 January 2014 was not admitted into the procedure under Article 114(2) EPC.

## 5 ENTITLEMENT TO CLAIM PRIORITY AS SUCCESSOR IN TITLE

5.1 While the U.S. provisional application (US 60/940,688) from which priority is claimed was filed by the inventors Jiang (Sam Shiao-Shiang), the European application forming the basis of the present patent was filed by Innovative Sonic Ltd. ("Innovative"). Based on this non-identity Innovative only enjoys the right of priority if it is established that Innovative was the successor in title of the original applicant when the European application was filed upon expiry of the priority period (Article 87(1) EPC).

5.2 The standard of proof for establishing the formal entitlement to priority is a high one and the patentee carries the burden of proof in this regard (cf. T 1056/01, at 2.9 and 2.10; T 1008/96, at 3.3). In the opposition division's opinion, proof of the formal entitlement encompasses two inter-related but nevertheless distinct issues, namely firstly the establishment of the applicable requirements for the transfer to be valid (cf. J 19/87, at VIII.) and secondly proof that these requirements were met.

5.3 In reply to the objection raised in the notice of opposition with regard to the right to claim priority, the patentee first submitted that supplementary indications would be filed later (letter of 30 April 2012). Subsequently (letter of 30 September 2013), it was argued that the first transfer to Asustek was valid either by virtue of Taiwanese law due to the employment relationship between Asustek and the inventor (E2, E3) or under U.S. Law on the basis of the assignment of the invention to Asustek (E4). The entitlement of Innovative was based on the one hand on U.S. Law and in this context reference was made to a *nunc pro tunc* agreement between Asustek and Innovative (E5) as well as to a direct assignment (E7, E8) of the U.S. non-provisional application

US 60/833,822 from the inventor Jiang to Innovative. In addition to that the proprietor argued in the oral proceedings that German Law could be applied to the second transfer (either due to the designation of Germany in the patent-in-suit, or as the EPO's *lex fori*) and that the general policy at the time between Asustek and Innovative would meet the requirements for the assignment to be valid under this law. The different approaches will be dealt with in turn, duly taking into account the challenges brought forward by the opponent in this regard.

- 5.4 As regards the applicable law for determining the validity of a succession in title, the opposition division as administrative department follows the approach set out in section A-III, 6.1 of the Guidelines for Examination in the EPO and supported in particular by decisions J 19/87 (at 2.) and T 1008/96 (at 3.3), namely that the transfer of the application (or of the priority right as such) must be a valid transfer under the relevant *national* provisions. In this regard the opposition division duly considered decision T 62/05, to which reference was also made in decision T 382/07 (at 9.1). However, it appears that T 62/05 is mainly concerned with the applicable *standard of proof* (at 3.9) rather than the question of the applicable law for determining the validity of a transfer of a priority right and thus is not to be understood in the sense that Article 72 EPC rather than the applicable national law would determine the formal validity of an assignment for the purposes of Article 87(1) EPC.
- 5.5 However, this does not yet answer the question of how to determine the relevant national provisions. The EPC does not contain a conflict of laws provision for determining the applicable national law in this regard; in particular no indications appear to be derivable from Article 74 EPC. Further, in the cases underlying decisions J 19/87 and T 1008/96, both the application and the transferring parties (assignor and assignee) were linked to the same country (UK and Italy respectively), so that it cannot be established with certainty whether the boards in these cases applied English and Italian law based on the "origin" of the application or due to the parties' connections to the relevant country. In light of this the opposition division sees no other option than to resort - in accordance with Article 125 EPC - to conflict of laws principles generally recognised in the Contracting States, as far as these can be established by an opposition division.

- 5.6 No indications can be derived in this regard from the Paris Convention. However, the conflict of laws provisions have been harmonised to a large extent and with effect for a considerable number of EPC Contracting States, inter alia, by Regulation (EC) No 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (so-called "Rome I"). This Regulation deals in particular with the law applicable to contracts including employment contracts (Articles 3, 4 and 7), the law governing the formal validity of contracts (Article 11) and the law applicable to specific questions regarding assignments (Article 14).
- 5.7 According to these provisions certain questions - such as in particular whether an application or a priority right can be transferred at all, or whether the latter can be transferred independently from the former - are expressly governed by the law of the country where the application was filed (*lex loci protectionis*) (Article 14(2) Rome I; Münchener Kommentar zum BGB/*Drexl*, Internationales Immaterialgüterrecht (vol. 11), 5th ed. (2010), at 199). Whether the formal validity of an assignment is also subject to this law appears less certain (see in favour German Bundesgerichtshof of 16.04.2013, X ZR 49/12, at 12; Benkard/*Grabinski*, EPÜ, 2nd ed. (2012), Art. 87, at 5 [*"im Zweifel"*]; for a different view see French TGI Paris of 30.01.2009 and UK High Court of Justice of 12.06.2009 [reported in epi 2010, 19 and 20] as well as *Ruhl*, Unionspriorität, 2000, at 260 [law of the country where or for which priority is claimed]; Art. 122 Swiss IPRG [law chosen by the party, or law of the country where the assignor has his habitual residence]; for more details see *Bremi*, Traps when transferring priority rights, epi 1/2010, 17 et seq., and for an earlier discussion see *Wieczorek*, Die Unionspriorität im Patentrecht, 1975, in particular at 142 et seq.).
- 5.8 Not only the different national approaches but also the wording of Article 14 Rome I raises doubts as to the existence of a generally recognised principle that the law of the country where the application was filed would exclusively govern the formal validity of an assignment. In this regard it needs to be taken into account that a succession in title may occur by other means than a transfer or assignment, for example by virtue of a succession, bankruptcy or an employment relationship and that in such cases, too, another law than the *lex loci protectionis* could be pertinent for questions relevant to the determination of ownership of rights (*Wieczorek*, Die Unionspriorität im Patentrecht, 1975, in particular at 144 et seq.). It thus seems conceivable that in case of a succession in title by virtue of a transfer or assignment the formal

validity could also be governed by the law applicable according to Article 11 Rome I (see Münchener Kommentar zum BGB/*Martiny*, Rom I-Verordnung (vol. 10), 5th ed. (2010), Article 14, at 30; *Metzger*, Transfer of Rights, License Agreements, and Conflict of Laws, in: *Basedow et al.* (eds.), Intellectual Property in the Conflict of Laws, 2005, at 61, 64 et seq.).

- 5.9 It follows that there does not appear to be a generally recognised principle according to which only *one specific* law would *exclusively* govern the formal validity of an assignment for the purposes of claiming priority. Different approaches exist among which one is to apply the law of the country where the priority application was filed. In this regard it seems relevant to note the principle of *favor negotii* generally recognised in European private international law (see Article 11 Rome I), according to which a contract should not be considered invalid as to its form if it complies in this regard with one law to which the matter is sufficiently linked. In the opposition division's opinion these findings can be relied on under Article 125 EPC in order to determine the national law applicable to the question of the validity of an assignment for the purposes of Article 87(1) EPC, namely to scrutinise the law or laws as argued by the proprietor as long as they show a sufficient link to the succession in title.
- 5.10 As regards the first transfer, the patentee initially based its arguments on Taiwanese Law. In accordance with the principles elaborated above, it is considered that Taiwanese Law may be applied to the determination of the validity of the succession in title as the law governing the relations between the employee-assignor and the employer-assignee. The relevant content of this law was established by the patentee by reference to Article 7 of the Taiwanese Patent Act of 2011 (E1) the wording of which corresponds to Article 7 of the Patent Act in force at the relevant time (version of 06.02.2003; E1a), i.e. in 2006. According to said provision, where an invention is made by an employee in the performance of his job duties, the right to apply for a patent and the patent right thereof shall be vested in his employer, unless an agreement provides differently. In the opposition division's opinion this provision suggests that ASUSTeK Computer Inc. was the applicant of the U.S. provisional application *by operation of law* and accordingly without the need for a separate assignment to have taken place. The employment agreement (E2) is considered to support this understanding.

- 5.11 The concerns in this regard that, while the employer may originally have been the owner of all rights pertaining to the invention, the filing of the application by the inventor would have brought about the need for a subsequent assignment are not considered entirely convincing. It is not thereby disregarded that ownership of the right to a patent/an application or inventorship in general do not play a role in the context of Article 87(1) EPC (cf., e.g. T 5/05, at 4.). However, Article 7 of the Taiwanese Patent Act broadly vests all rights pertaining to an employment invention and the applications filed for such inventions in the employer and it is only due to a formal requirement under U.S. Patent Law at the relevant time that the application needed to be filed by the employee-inventor in assisting his employer in prosecuting his right to obtain patent protection. While execution of specific assignments of U.S. applications between employee-inventors and employers are indeed common, these are often not constitutive but rather made for recording purposes with the USPTO. They are thus aimed at facilitating later commercial record keeping as well as serving evidential purposes and in this sense hold a declaratory function. In the opposition division's opinion it would go too far to derive from the formal requirement under U.S. law at the relevant time that the application needed to be filed by the inventor, an effect which would override the ownership in an application by operation of law or by virtue of an assignment clause in an employment contract, and on this basis to require a subsequent constitutive re-assignment to the employer. In other words, this former formal requirement under U.S. Patent Law is not considered to override the attribution of applicantship to ASUSTeK in view of and on the basis of Article 7 Taiwanese Patent Act. This may risk confusing the question of substantive ownership of the application with questions of sufficient proof or even to suggest that only the registered applicant would be relevant in the context of Article 87(1) EPC.
- 5.12 While on this basis it is already considered as sufficiently proven that ASUSTeK Computer Inc. was the applicant of the first application in the sense of Article 87(1) EPC at the relevant time, the following additional considerations are made with regard to the validity of the transfer according to U.S. Law since the proprietor also argued on the basis of this law: Firstly, in the absence of a clearly identifiable generally recognised principle that another law than the *lex loci protectionis* would in a case such as the present one exclusively govern the formal validity of the transfer and having regard to the principle of *favor negotii* (see supra) and the sufficient link of the matter with U.S. Law (due to the fact that the priority application is an U.S. application), the opposition division considers that U.S. Law - as the law of the

country where the priority application was filed - may be applied in scrutinising the validity of the succession in title. Secondly, according to the division's knowledge (Article 114(1) EPC), and having had due regard to the parties' submissions, the relevant content of this law is as follows: Under 35 U.S.C. § 261 applications for patents shall be assignable in law by an instrument in writing. Such instrument in writing must contain clear contractual language with regard to the fact that something is or shall be assigned (rather than creating a mere intention or future obligation to assign) as well as concerning the subject-matter (i.e. application) and the parties of the assignment. The document must be signed by the party against whom the contract is to be enforced (assignor) but does not require signature of the assignee.

- 5.13 The division considers that fulfilment of these requirements has been sufficiently established on the basis of the assignment agreement E4. Although no application number is indicated, the title of the invention together with the date of the assignment sufficiently identifies US 60/940,688. The mere fact that the assignment pre-dates the filing of the application by one day although the object of the assignment is identified as "U.S. patent application executed on even date" does not create doubts in this regard. Moreover, the assignment is signed by the inventor as assignor. It follows that even if ASUSTeK Computer Inc. was not entitled under Article 87(1) EPC by operation of law according to Article 7 of the Taiwanese Patent Act, it obtained said right by virtue of the assignment E4 validly executed under U.S. Law.
- 5.14 As regards the second transfer, the proprietor first of all argued on the basis of the *nunc-pro-tunc* assignment (E5). However, in accordance with the above-referred case law of the EPO Boards of Appeal, Article 87(1) EPC as part of the EPC's complete and self-contained code of rules on claiming priority for the purposes of filing a European patent application requires the succession in title to have taken place before the filing of the later European patent application and is not considered to allow for retroactive assignments (cf. e.g. T 382/07 with further references; see also *Singer/Stauder/Bremi*, EPC, 6th ed. (2013), Art. 87, at 53). This is also considered to be in line with the basic principles concerning priority laid down in Article 4 of the Paris Convention (cf. *Wieczorek*, *Die Unionspriorität im Patentrecht*, 1975, at 142 et seq.; *Teschemacher*, GRUR Int. 1983, 695, 699, at 5.5) and to correspond to the practice of at least some national courts of EPC Member States (see, e.g. German Federal Patent Court of 28.10.2010, 11 W [pat] 14/09; UK High Court of 28.06.2010, *Edwards Lifesciences AG v Cook Biotech Inc.*, [2010] EWCA

Civ. 718). It is the division's view that allowing for retroactive assignments in the context of Article 87(1) EPC would create considerable legal uncertainty. In the interest of this legal certainty, allowability of a *nunc-pro-tunc* assignment cannot, as suggested by the proprietor, be determined on a case-by-case basis.

5.15 Moreover, while it is true – as argued by the proprietor by referring to the *Travaux Préparatoires* – that the EPC is not considered to set forth a specific form provision for an assignment to be valid (see also T 62/05, at 3.7) but rather to leave this question to the applicable national law (see *supra*), the requirement for the assignment to have taken place before the filing of the European patent application is not viewed to constitute a formal requirement in this sense. Rather, this requirement is regulated and thus inherent in Article 87(1) EPC and may therefore not be circumvented by application of a national law which attributes a retroactive effect to a later transfer. This is also considered to be in line with general principles of private international law concerning coercive provisions of the *lex fori* (*lois de police, ordre public*) which - irrespective of the applicable national law - do not allow fundamental principles of the *lex fori* to be overridden. In view of this it may be left open whether or not – as argued by the proprietor with reference to in particular E6 and as challenged by the opponent on various grounds – U.S. Law acknowledges a retroactive effect of *nunc-pro-tunc* assignments also with regard to the claiming of priority.

5.16 The proprietor furthermore argued that according to German Law, which does not require a particular form for the assignment of an application and thus allows for tacit or implicit transfers (see the decision of the German *Bundesgerichtshof* X ZR 49/12 of 16 April 2013 – E16), Innovative was the successor in title by virtue of the general policy agreed between ASUSTeK and Innovative at the relevant time. While the division has acknowledged *supra* that different laws may be applied in order to determine the succession in title for the purposes of Article 87(1) EPC and has also referred to the *favor negotii* principle, it cannot follow the proprietor's suggestion that an applicant or patentee could choose from any of the laws of the countries for which protection is sought in a European patent application. This is viewed to be in contradiction not only with general principles of private international law but also with the fundamental principle of legal certainty. Even under the aforementioned *favor negotii* principle there must be a sufficient link with the country which law is applied. In this regard the division notes that it is only

after grant that a European patent application is treated as a bundle of national patents and subjected to the relevant national provisions (Articles 2(2) and 64(3) EPC) but not at the time of filing which is the relevant point in time for determining the entitlement to claim priority (see supra). Also, where priority is claimed in proceedings before the EPO it cannot be seen how the matter would sufficiently relate to one designated country more than to any other designated Contracting State thus justifying application of the former's law.

- 5.17 Neither can the application of German Law be based on the *lex fori* principle, as argued by the proprietor. The division doubts whether German Law could be considered to constitute the EPO's *lex fori* in the context of opposition proceedings, rather than the EPC possibly together with general principles according to Article 125 EPC. Moreover, reference to the *lex fori* would be considered to include the German private international law provisions which would lead to the application of U.S. Law as the law of the country where the application was filed (see the decision of the German *Bundesgerichtshof* X ZR 49/12 of 16 April 2013 – E16). For these reasons German Law cannot be applied to the assignment in the present case with the consequence that establishment of the implicit or tacit transfer does not constitute sufficient proof for the valid succession in title.
- 5.18 Finally, the proprietor argued that Innovative became the successor in title by virtue of the assignment of US 11/878,892 (E7, E8) which is a U.S. non-provisional application claiming the benefit of the priority application at issue, i.e. US 60/833,822. *Prima facie* the division considered this new line of argumentation to be relevant and decided to postpone the oral proceedings in view of it. However, upon close scrutiny and particularly considering the opponent's letter of 20 December 2013 and the proprietor's submissions during oral proceedings the division is not convinced that in the present case transfer of the U.S. non-provisional application would automatically and necessarily include the assignment of the U.S. provisional application (or the right to claim priority from it in the context of a European patent application) from which benefit is claimed in the non-provisional application, or constitute sufficient proof for the transfer also of the provisional application.

- 5.19 On the basis of the assignment agreement E7, the division has no doubt with regard to the valid assignment of US 11/878,892 in accordance with U.S. Law (see supra). It is also recognised that a U.S. provisional application and the corresponding U.S. non-provisional application share a special relationship by virtue of 35 U.S.C. § 119(e) in that the latter benefits from the former's filing date if certain requirements are fulfilled. Still, both applications constitute independent applications. A U.S. provisional application does not, as it seems, automatically cease to be pending upon filing of a corresponding U.S. non-provisional application which claims the benefit of the former, and in such a case is not converted into the non-provisional application (as under 37 C.F.R. 1.53(c)(3)). Rather, it appears that even after filing of a corresponding U.S. non-provisional application, a U.S. provisional application may not only serve as basis for further U.S. non-provisional applications until expiry of the 12-month deadline, but also for claiming priority in the context of foreign applications. Such foreign applications may be filed by different natural or legal persons, which was also the practice agreed between ASUSTeK and Innovative. Last but not least, in accordance with the principle of legal certainty it is a requirement not only in the context of Article 87(1) EPC but also under U.S. law (see supra) that the transfer of an application (or of the right to claim priority from it) is sufficiently clear as regards the application and/or right which is assigned. As regards eventually the alleged assignment of the invention in general – rather than specifically of the application from which priority is claimed – the division is not sufficiently convinced either that - at least in the present case - such an assignment of an invention in general would automatically include an earlier filed (i.e. pre-dating the assignment contract) U.S. non-provisional application, having regard in particular to the contractual language of the assignment E7. Contrary to that, the fact that the assignment mentions the inventor as assignor rather than ASUSTeK is not considered problematic in accordance with the explanations given supra at point 5.11. However, this alone does not change the finding that E7 and E8 do not constitute sufficient proof that this assignment also included the transfer of US 60/833,822 in accordance with 35 U.S.C. § 261.
- 5.20 While recognising the difficulties in establishing the law applicable to the transfer of the priority right and the requirements which need to be fulfilled in a case as the present one, the opposition division concludes that the validity of the transfer of the priority application from ASUSTeK to Innovative Sonic Ltd. has not been sufficiently established. This operates to the detriment of the

patentee who claims the right of priority and thus carries the burden of proof to show that he is entitled to that right (cf. T 1056/01, at. 2.9 and 2.10; T 1008/96, at 3.3).

5.21 In view of this finding the question whether the European patent application relates to the "same invention" may remain open, since the insufficient proof of the valid succession in title in itself bereaves the priority claim of its validity.

6 ARTICLES 100(a), 52, 54 EPC

6.1 Public availability of A4 in the sense of Art.54(2).

The Proprietor had originally objected the public availability of the cited 3GPP contributions and specifically of A4, contesting the "public" character of the delegates working group documents and the actual date of publication.

The OD does not agree. Membership at 3GPP is open to everyone, and every member is entitle to participate to the WG activities and meeting. Oral or written discussions within and outside the WG are encouraged, as long as an explicit confidentiality agreement has not been agreed upon. Such agreements are not present at the 3GPP WGs. Rather, it is the goal of a standard organisation to achieve the widest consensus possible for public interest.

This is irrespective of the 'type' of person ("delegates") participating the meeting (see also T0202/97). Therefore, these type of documents are generally considered public available in the sense of Article 54(2), Guidelines G-IV, 7.6.

With specific reference to the document A4 it is evident that the document was public available at earliest from the 23 of August 2006, which corresponds to the date when the document was uploaded to a 3GPP public server and shown by the evidence A4b.

6.2 Novelty, Articles 52(1), 54(1) and (2) EPC

Following the public availability of A4 and the lack of entitlement to priority of the opposed patent, A4 is deemed to be comprised in the prior art under Art. 54(2) EPC. As a consequence thereof, the present application does not meet the requirements of Article 52(1) EPC because the subject-matter of claim 1 and 2 is not new within the meaning of Article 54(1) and (2) EPC for the following reasons.

Document A4 discloses, applying the terminology of present **claim 1** and the references of A4,

(1) a method for setting field data of a scheduling information in a wireless communications system according to the Medium Access Control protocol specification of the 3<sup>d</sup> Generation Partnership Project,

(Page 3, section 9.2.5.3.2, first paragraph, first sentence: "*The Scheduling Information is located at the end of the 4\_Q-e PDU and is used to provide the sen'ing Node . B with a better view of the amount of system resources needed by the* (emphasis added), wherein the Node B and CE imply a wireless communications system; section 9.2.5.3.2, first paragraph, third sentence: "

*Scheduling Information is transmitted, its contents shall always be updated*" implying setting the contents; section 9.2.5.3.2, second paragraph: "*The information [i.e., the scheduling information] includes the following fields:...*", implying setting field data of the scheduling information)

(2) the scheduling information comprising at least a Highest priority Logical channel Buffer Status field, called HLBS field hereinafter, for storing a Higher priority Logical channel Buffer Status index, called HLBS index hereinafter,

(Page 3, second paragraph: "*This information [i.e. the scheduling information] includes the following fields:...*" and page 4, paragraph below the table: "*- Highest priority Logical channel Buffer Status (HLBS), which is used to store the HLBS index (jage 4, paragraph below the table; pages 4 and 5, table 9.2.5.3.2-2; page 5, Figure 92,5.3.2-1),*

the method comprising: (3) setting a value of the HLBS index to 15 when a Higher priority Logical channel Buffer Status value, called HLBS value hereinafter, is greater than 82 and smaller or equal 100; and

(Table 9.2.5.3.2-2, last row, discloses setting a value of the 1-J1BS index to 15 when  $82 < \text{HLBS value}$ .)

The step of feature (3) of claim 1 cannot be considered new over A4, because the sub-range selected, namely  $82 < \text{HLBS value} \leq 100$ , is not sufficiently far removed from the end points of the known range (Guidelines C-IV, 9.8

“Selection inventions”, item (ii)).

(4) storing the value of the HLBS index into the HLBS field,

(Page 5, Figure 9.2.5.3.2-1 wherein the 4-bit HLBS index is stored and located in the Scheduling Information between the 5-bit TEBS field and the 4-bit HLID field)

(5) the value of the HLBS index is set to 15 when the HLBS value is greater than 100.

(Table 92.5.3.2-2, last row, discloses that the value of the I-ILBS index is set to 15 when  $82 < \text{HLBS value}$ . The step of feature (5) defines a sub-range which is not new over the range disclosed in A4 because the selected sub-range is not narrow compared to the known range).

The subject-matter of claim 1 is therefore not new (Article 54(1) and (2) EPC).

6.3 The same applies to independent claim 2 which is drafted in structural terms rather than in terms of method steps and exactly corresponds to method claim 1.

The subject-matter of claim 2 is therefore not new (Article 54(1) and (2)).

6.4 The proprietor had never argued in favour of novelty with respect to A4.

## Decision

European patent EP1883190 is revoked on the ground of Article 100(a) EPC because the subject-matter of claims 1 and 2 does not meet the requirements of Article 52(1) EPC in conjunction with Article 54 EPC (Article 101(2) EPC).