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**Datasheet for the decision
of 27 May 2011**

Case Number: J 0013/10 - 3.1.01

Application Number: ...

Publication Number:

IPC:

Language of the proceedings: EN

Title of invention:

XXX

Applicant:

N.N.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 113(1)
EPC R. 56, 111(2)
RPBA Art. 11

Relevant legal provisions (EPC 1973):

-

Keyword:

"Violation of right to be heard - Applicant's comments not
duly considered"

Decisions cited:

-

Catchword:

See points 2 to 5 of the reasons



Case Number: J 0013/10 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 27 May 2011

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the
European Patent Office of 16 November 2009.

Composition of the Board:

Chairman: B. Günzel
Members: R. Moufang
L. Bühler

Summary of Facts and Submissions

- I. The present appeal concerns a decision of the Receiving Section of the EPO pursuant to Rule 56(4)-(6) EPC which was dispatched on 16 November 2009.

- II. European patent application ... was filed on 9 June 2009, claiming the priorities of two US patent applications of 17 June 2008 and 3 June 2009.

- III. On 13 July 2009 the Receiving Section sent out a communication pursuant to Rule 56(1) EPC according to which the examination under Article 90(1) EPC had revealed that the drawings Figs. 28 to 31 were missing. The communication was made by using the EPO form 1114N having the sub-title "Missing parts of the description or missing drawings". The appellant was invited to file "the missing parts of the description and/or the missing drawing(s)" within two months after notification of the communication.

- IV. With letter dated 31 August 2009 and received by the EPO on 1 September 2009, the appellant responded to this communication and filed a new description which was said to be identical with the description of the second US priority application. The appellant stated that the new description should replace the formerly filed description whereas claims, abstract and figures remained unchanged. The letter contained a list of the amended passages of the formerly filed description. The appellant requested that the original date of filing of the application be maintained because the missing parts of the previously filed description were completely contained in the second US priority application. A copy

of the two US priority applications had already been submitted to the EPO by the appellant with a letter dated 16 July 2009.

- V. On 16 November 2009, the Receiving Section dispatched the appealed decision which was made by ticking a box on Form 1108N containing the following text:

"The references to the missing parts of the description and/or missing drawings cited in the European patent application are deemed to be deleted and any filing of the missing parts of the description and/or missing drawings is deemed not to have been made since they were not submitted within the period pursuant to Rule 56(1) EPC (EPO Form 1114) or Rule 56(2) EPC (R. 56(4)(a) EPC). The filing date remains the date on which the requirements of Rule 40(1) were fulfilled, being 09.06.09."

The decision stated that it was open to appeal.

- VI. On the same day, the Receiving Section furthermore sent out a communication according to which the amendments filed on 1 September 2009 could not be accepted pursuant to Rule 137(1) EPC since they were filed prior to the receipt of the European search report by the appellant.

- VII. According to a note concerning a consultation by telephone dated 25 January 2010, the appellant's representative called the EPO in order to get clarifications regarding the actions taken by the Receiving Section. It was explained to him that since the EPO did not receive the missing drawings the

form 1108N was the follow up for the form 1114N and that the further communication was dispatched due to the fact that the representative had sent a description which was not identical to the original description.

The appellant's submissions and requests

- VIII. In its grounds of appeal the appellant submitted that the originally filed application contained claims and figures that corresponded to the claims and figures of the second priority document whereas, accidentally, the originally filed description corresponded to the first priority document rather than to the second. It had been the intention of the appellant to file a description that matched the drawings so that parts of the description were missing rather than drawings. The appellant had thus filed the missing parts of the description since there were considerable gaps in this regard in the originally filed documents. In its petition of 1 September 2009 the appellant had furthermore indicated in detail where the missing parts of the description could be found in the second priority document in order to make clear that Rule 56(3) EPC was applicable.
- IX. The appellant considered that, although the Receiving Section wrongly assumed that only drawings were missing, the appellant had the opportunity to file what was truly missing, i.e. parts of the description, within two months after issuance of the communication under Rule 56(1) EPC. It requested that the appealed decision be revoked, that the documents filed on 1 September 2009 be accepted as missing parts of the description pursuant to Rule 56 EPC and that the original date of

filing of the application be maintained in accordance with Rule 56(3) EPC. Furthermore, an auxiliary request for oral proceedings was submitted.

- X. After having been informed by the board of its preliminary view that the appealed decision suffered from substantial procedural deficiencies which justified a remittal to the department of first instance together with ordering reimbursement of the appeal fee, the appellant, by letter dated 29 March 2011, requested to remit the case to the department of first instance and to reimburse the appeal fee.

Reasons for the decision

Admissibility of appeal

1. The appealed decision did not terminate the examination proceedings concerning the patent application in suit. Pursuant to Article 106(2) EPC, it is therefore an admissibility requirement for the present appeal that the decision allowed a separate appeal. The board considers that the Receiving Section's formulation "This decision is open to appeal" (see section V above) has to be interpreted as, at least implicitly, allowing a separate appeal. Thus the appeal is considered admissible.

Substantial procedural violation

2. Under Article 113(1) EPC, decisions may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The

right to be heard is a fundamental principle of the proceedings before the EPO. It requires that the parties are not only given an opportunity to present comments but that these comments are also duly considered. Furthermore decisions which are open to appeal shall be reasoned (Rule 111(2) EPC).

3. In the present case the appealed decision is a standard decision taken by using form 1108N. It does not mention at all the submissions made by the appellant in its letter of 31 August 2009. However, these submissions were obviously a response to the communication under Rule 56(1) EPC. While the appellant did not file the drawings which the Receiving Section had considered to be missing (Figs 28-31), it filed an amended description and argued that those parts of the newly filed description which were not contained in the originally filed description were missing parts for the purposes of Rule 56 EPC. It furthermore explicitly requested that the original date of filing be maintained pursuant to Rule 56(3) EPC since these missing parts were completely contained in the second priority document.
4. Under these circumstances the Receiving Section could not ignore the appellant's submissions in its decision and deal with them only in the context of a separate later communication on a legally different issue, i.e. the question as from which point in time the applicant may amend the application. The decision leaves it to the appellant and the board to speculate whether the Receiving Section realized that the appellant had made arguments and requests in the context of Rule 56 EPC, and whether it intended to dismiss them and, if so, for

what reasons. The decision only states that the missing drawings were not submitted within the time limit. This is inadequate reasoning.

5. To ignore requests or arguments developed by the applicant in support of a given issue which has an impact on the decision under appeal is both a violation of the right to be heard (Article 113(1) EPC) and an offence against Rule 111(2) EPC. These procedural deficiencies constitute a substantial procedural violation as well as a fundamental deficiency justifying a remittal to the department of first instance according to Article 11 RPBA (Rules of Procedure of the Boards of Appeal) together with ordering reimbursement of the appeal fee (Rule 103(1)(a) EPC). In accordance with the appellant's requests submitted in its letter dated 29 March 2011, the board therefore makes use of its discretion under Article 111(1) EPC and Article 11 RPBA, remits the case to the department of first instance and orders the reimbursement of the appeal fee.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

C. Eickhoff

B. Günzel