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D E C I S I O N
of 8 May 2000

Case Number: J 0020/99 - 3.1.1

Application Number: 93310046.3

Publication Number: 0604095

IPC: D21H 17/69

Language of the proceedings: EN

Title of invention:

Process for the treatment of waste material suspensions

Applicant:

ECC INTERNATIONAL LIMITED

Opponent:

-

Headword:

Approval of the text of the patent to be granted/ECC

Relevant legal provisions:

EPC R. 25(1), 51(4), 51(6), 67

Keyword:

"Rule 51(6) EPC communication after the reopening of the proceedings following a Rule 51(4) EPC communication (no) - fresh Rule 51(4) EPC communication (yes) "

Decisions cited:

G 0010/92, J 0029/95

Catchword:

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Case Number: J 0020/99 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 8 May 2000

Appellant: ECC INTERNATIONAL LIMITED
1015 Arlington Business Park
Theale
Reading
Berkshire RG7 4SA (GB)

Representative: Nash, David Allen
Haseltine Lake & Co.
Imperial House
15-19 Kingsway
London WC2B 6UD (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office dated 22 January 1999
refusing the issuance of a second Rule 51(4) EPC
communication concerning European patent
application No. 93 310 046.3.

Composition of the Board:

Chairman: J.-C. Saisset
Members: J.-C. M. De Preter
C. Rennie-Smith

Summary of Facts and Submissions

- I. The present appeal lies from a decision of the Examining Division of 22 January 1999 concerning European patent application No. 93 310 046.3 according to which appellant's request of 16 December 1998 that the Rule 51(6) EPC communication dated 7 September 1998 be withdrawn and that a new Rule 51(4) EPC communication be issued was refused.

- II. The initial Rule 51(4) EPC communication was issued on 18 August 1995 whereupon the applicant filed an amended set of claims and an amended page 3 of the description. On 29 January 1996 the Examining Division issued a communication raising an Article 123(2) EPC objection whereupon the applicant filed amended claims. In a communication of 21 January 1997 the Examining Division raised further substantive objections. The same happened on 5 February 1998 after the applicant had again filed amended pages of the description and a replacement set of claims. After the applicant replied to that communication, again filing replacement pages of the description and an amended claim 1, the Examining Division issued a Rule 51(6) EPC communication dated 7 September 1998 in which it was stated that, further to the communication under Rule 51(4) EPC dated 18 August 1995, the Examining Division had accepted the last proposed and agreed amendments.

- III. By its letter of 29 September 1998 the applicant requested cancellation of this communication and the issuance of a second communication under Rule 51(4) EPC pointing out that the proceedings had been resumed by the Examining Division of its own motion and the

Division's action had deprived the applicant of the opportunity to review the text considered allowable and to submit a divisional application before expiry of the term referred to in Rule 25 EPC.

- IV. By its communication of 6 November 1998, which represented the result of a consultation by telephone with the applicant, the Examining Division stated that its communication under Rule 51(6) EPC was correctly issued and would not be cancelled. It was argued *inter alia* that, in a situation such as this in which the applicant had reacted to the communication under Rule 51(4) EPC with a request for amendments, Rule 51(6) EPC stipulates that the Examining Division can establish the applicant's approval of the text intended to be granted taking account of any proposed amendment. This meant that the Examining Division could proceed on the basis of the amendments and that the documents to which no amendments had been made remained unchanged. Such course of action was said to be in the interest of a streamlined procedure.
- V. In a letter of 16 December 1998 the applicant requested an appealable decision. As an auxiliary request it sought grant of the application, filing a translation of the claims into French and German and paying the fees for grant and printing. As regards the main request, the applicant emphasised that the Examining Division had clearly reopened the proceedings and referred to Opinion G 10/92.
- VI. After issuing the decision under appeal of 22 January 1999 pursuant to Rule 69(2) EPC, in which the Examining Division referred to the communication of November 1998

mentioned above and which was accompanied by a communication according to Rule 68(2) EPC, a decision to grant was rendered on 25 February 1999 i.e. before the time for appealing the Rule 69(2) EC decision expired.

VII. An appeal against the decision of 22 January 1999 was lodged on 5 March 1999 together with a written statement setting out the grounds of appeal. The appeal fee was also paid on the same day. The appellant requested:

- the Board of Appeal to set aside the decision under appeal;
- that a fresh communication under Rule 51(4) EPC be issued;
- the refund of the appeal fee;
- suspension of the grant proceedings and, specifically, cancellation of any mention of the grant in European Patent Bulletin of 7 April 1999 and confirmation that the premature decision to grant constituted a substantial procedural violation
- expedited handling of the appeal since prosecution of European Patent application No. 98 119 742.9, a divisional application of the present application, filed on 21 October 1998, was held up because the Examining Division considered it to have been filed out of time following its premature Rule 51(6) EPC communication
- as an auxiliary request, oral proceedings.

The appellant submitted that the failure of the Examining Division to issue a fresh Rule 51(4) EPC communication prior to the issuance of the Rule 51(6) EPC communication, following reopening of the examining proceedings in 1995, constituted a substantial procedural violation and referred to Opinion G 10/92.

- VIII. The publication of the mention to grant in European Patent Bulletin 99/14 of 7 April 1999 was annulled in European Patent Bulletin of 5 May 1999.
- IX. The appeal, which was originally referred to a technical Board, was transferred to the Legal Board on 17 November 1999. That Board has, as requested, expedited the appeal.

Reasons for the Decision

1. The present Board is competent as the appeal does not concern specifically the grant of a European patent.
2. The conditions provided for in Articles 106 and 108 EPC are fulfilled. This is also the case with Article 107 EPC as, in particular, following the decision under appeal the divisional application No. 98 119 742.9 filed by the appellant on 21 October 1998 could be considered as having been filed out of time.
3. According to G 10/92 (OJ EPO 1994, 633, point 7 of the reasons), if, after the approval in accordance with Rule 51(4) EPC, examination proceedings are reopened by the Examining Division because - for whatever reason - the proposed text for grant is to be amended, Rule 51(4) EPC requires that the applicant once again be informed of the text in which the Examining Division intends to grant the European patent.

In the present case it is clear that after the reply of the appellant to the Article 51(4) EPC communication the Examining Division raised Article 123(2) EPC objections on 29 January 1996 and that, thus, the examination proceedings were reopened. Further substantial objections were also raised by the Examining Division's communications of 21 January 1997 and 5 February 1998. Such a situation differs completely from that which arose in decision J 29/95 (OJ EPO 1996, 489) - which the Examining Division had in mind when it issued its communication of 6 November 1998 in which, without any quotation marks or attribution, points 3 and 4 of the reasons of that decision were verbatim repeated (see IV) - as in that case the amendments requested by the applicant in reply to the communication under Rule 51(4) EPC had been immediately accepted in the communication of the Examining Division under Rule 51(6) EPC i.e. without reopened proceedings. As a general remark, the Board would observe that all EPO departments should, if quoting a decision of the Boards of Appeal or any other legal authority, identify that authority and place the cited passage(s) in quotation marks.

Furthermore, the fact that in the present case the applicant did not give its approval in accordance with Rule 51(4) EPC but filed amended claims means there is even more reason in this case for issuing a second communication under Rule 51(4) EPC once the applicant has met the raised objections during the reopened proceedings.

4. For the above reasons the decision under appeal must be set aside and the case must be remitted to the first instance with the order to issue a fresh communication under Rule 51(4) EPC. As a consequence - even leaving aside the fact that it was prematurely rendered - the decision of 25 February 1999 lacks any legal basis and must also be set aside.

5. Although the appellant had cited Opinion G 10/92 in its letter of 16 December 1998 and had stressed that in the present case the proceedings had been reopened, the decision under appeal merely referred to the reasons set out in the prior communication of 6 November 1998 without taking into account the appellant's arguments. This amounts to a substantial procedural violation which, in the opinion of the Board, justifies the reimbursement of the appeal fee according to Rule 67 EPC.

Order

For these reasons it is decided that:

1. The decisions of 22 January and 25 February 1999 are set aside.
2. The case is remitted to the first instance with the order to issue a fresh communication under Rule 51(4) EPC.
3. The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

M. Beer

J.-C. Saisset