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**D E C I S I O N**  
**of 12 April 2002**

**Case Number:** T 1016/00 - 3.2.7

**Application Number:** 96942067.8

**Publication Number:** 0874717

**IPC:** B24D 9/08

**Language of the proceedings:** EN

**Title of invention:**  
Backing plates for abrasive disks

**Applicant:**  
NORTON COMPANY

**Opponent:**  
-

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 111(1), 113(1)  
EPC R. 67

**Keyword:**  
"Violation of right to be heard (yes)"  
"Reimbursement of appeal fee (yes)"  
"Remittal to the first instance (yes)"

**Decisions cited:**  
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**Catchword:**  
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Case Number: T 1016/00 - 3.2.7

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.7**  
**of 12 April 2002**

**Appellant:** NORTON COMPANY  
1 New Bond Street  
Box No. 15138  
Worcester  
Massachusetts 01615-0138 (US)

**Representative:** Richebourg, Michel François  
Cabinet Michel Richebourg  
"Le Clos du Golf"  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 19 June 2000  
refusing European patent application  
No. 96 942 067.8 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. Burkhart  
**Members:** P. A. O'Reilly  
U. J. Tronser

## Summary of Facts and Submissions

- I. The Appellant (Applicant) filed an appeal against the decision of the Examining Division to refuse the application.
- II. The Examining Division refused the application for lack of novelty of claim 1 of both the main and the single auxiliary request in view of the document

D1: US-A-2 749 681.

- III. The Appellant requested in his letter of 15 March 2002 that a patent be granted on the basis of claims 1 to 15 filed with that letter.

- IV. Claim 1, which is the only independent claim, reads as follows:

"An abrasive disk backing plate having a mounting aperture and an abrasive disk-bearing surface, said plate being made of a resilient material and being circular with at least three spaced and symmetrically disposed gaps in the circumference thereof, the said gaps featuring adapted shapes so that, when used with a similarly shaped abrasive disk to grind a workpiece, the said workpiece is intermitently cooled during grinding and is visible during grinding through the periphery of the disk."

- V. The claims mentioned above are the same as those filed with the single auxiliary request during oral proceedings before the Examining Division on 7 June 2000.

- VI. According to the minutes of the oral proceedings the applicant indicated some arguments in favour of the auxiliary request. The minutes do not indicate that any of the members of the Examining Division made any statements with respect to the auxiliary request.
- VII. The decision to refuse the application was given at the end of the oral proceedings.
- VIII. In their written grounds the Examining Division explained that the subject-matter of claim 1 of the both the main and the auxiliary request lacked novelty over document D1.
- IX. In his notice of appeal the Appellant stated that during the oral proceedings the Examining Division had expressed no opinion concerning the auxiliary request and put no questions concerning it.
- X. The Appellant has requested refund of the appeal fee.

## **Reasons for the Decision**

- 1. *Right to be heard*
  - 1.1 It is fundamental to the European patent system that a decision may only be taken on the basis of grounds or evidence on which the party or parties have had an opportunity to present their comments, cf. Article 113(1) EPC.
  - 1.2 The auxiliary request was presented for the first time during the oral proceedings. The Examining Division allowed the request into the proceedings, as is shown

by the fact that they treated the request in the written grounds of their decision.

1.3 The Appellant has stated that the Examining Division never expressed an opinion on the auxiliary request during the oral proceedings. This statement is corroborated by the minutes of the oral proceedings which do not mention that the Examining Division expressed any opinion or put any questions. The Board does not therefore have any doubt that the Appellant was not informed of the grounds against the auxiliary request during the oral proceedings.

1.4 At no point therefore during the proceedings before the Examining Division was the Appellant informed of the grounds on which the decision regarding the auxiliary request would be taken.

1.5 In the opinion of the Board this failure of the Examining Division to inform the applicant of the grounds on which their decision would be taken constitutes a serious violation of the right of the applicant to be heard pursuant to Article 113(1) EPC.

2. *Reimbursement of the appeal fee*

2.1 The violation justifies the setting aside of the decision and the reimbursement of the appeal fee as foreseen for such cases in Rule 67 EPC.

3. *Remittal to the Examining Division*

3.1 The Appellant should have the opportunity to present to the Examining Division comments on the grounds for the decision with respect to the auxiliary request which is

now the new main request. Remittal of the case to the first instance in accordance with Article 111(1) EPC is therefore justified, see Article 10 of the Rules of Procedure of the Boards of Appeal.

## **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 with the order to continue substantive examination on the basis of claims 1 to 15 filed with the letter of the Appellant dated 15 March 2002.
3. The appeal fee is to be reimbursed to the Appellant.

The Registrar:

The Chairman:

R. Schumacher

A. Burkhart