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D E C I S I O N
of 9 October 2001

Case Number: T 0508/01 - 3.5.2

Application Number: 97928378.5

Publication Number: 0914669

IPC: H01J 37/244

Language of the proceedings: EN

Title of invention:
Detector Devices

Applicant:
K E Developments Limited

Opponent:
—

Headword:
-

Relevant legal provisions:
EPC Art. 96(2), 113(1)
EPC R. 51(2), 67
PCT Art. 38, 42

Keyword:
"PCT file, other than IPER, incorporatable by reference in response to Rule 51(2) EPC communication - (no)"
"Substantial procedural violation by peremptory refusal - (yes)"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0508/01 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 9 October 2001

Appellant: K E Developments Limited
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 6 February 2001 refusing European patent application No. 97 928 378.5 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: R. G. O'Connell
J. H. P. Willems

Summary of Facts and Submissions

I. This is an appeal from the refusal by the examining division of Euro-PCT application No. 97 928 378.5 on the grounds that claim 1 was not clear (Article 84 EPC).

Apart from the insertion of reference numerals, the claim concerned was the same as that which had been the subject of an IPER (International Preliminary Examination Report) and subsequently filed with the Euro-PCT application on entry into the regional phase.

II. On 30 July 1999, the examining division issued a first communication pursuant to Article 96(2) and Rule 51(2) EPC in the following terms:

"An International Preliminary Examination Report has already been drawn up for the present application in accordance with the PCT. The application documents filed with entry into the Regional Phase appear to be identical with the documents to which refers [sic] the International Preliminary Examination Report. The deficiencies mentioned in that report give rise to objections under the corresponding provisions of the EPC."

The part of the IPER referred to which is relevant to the refusal ground of lack of clarity is worded as follows:

"In claim 1, the expression "light magnifier" is not clear (Article 6 PCT). The word "magnifier" normally means enlargement in seize [sic]. It can be understood from the description that, in the embodiments, the

photomultiplier (23) is meant to be a "light magnifier" (see page 15, first para.). This is however not correct because, besides an electron multiplication, a conversion from light to an electric signal takes place in a photomultiplier. A photomultiplier is therefore not a light magnifier, nor a light amplifier, nor a light intensifier."

III. The applicant (now appellant) replied to the Rule 51(2) communication by letter dated 13 November 1999 which included the following sentence:

"The Applicants have already argued for the retention of the expression "light magnifier" - see the Response of 5th May 1998 in connection with the PCT International Written Opinion of 1st April 1998 - and see no need to amend this expression in any way."

IV. On 6 February 2001 the examining division issued the decision under appeal refusing the application for lack of clarity of claim 1 (Article 84 EPC), in particular because of the presence in the claim of the allegedly unclear term "light magnifier". In dealing with the applicant's submissions the decision quoted the sentence at point III above and added the following observation:

"Within the present examination procedure under the EPC, the applicant has simply stated that he refuses any amendments with regard to the expression "light magnifier". The arguments to which the applicant refers were given in a separate procedure (chapter II under PCT) before a separate authority (IPEA) and can therefore not be considered in the present procedure before the Examining Division of the EPO. Only the

IPER is part of the EPO file."

V. The appellant's arguments can be summarised as follows:

(i) *Procedural issues*

The applicant's comment in the response of 13 November 1999 was not a refusal to amend claim 1, merely a submission that amendment was unnecessary, the reasons supporting the submission being given by reference to the applicant's response to this objection in the preceding PCT Chapter II procedure in which the EPO acted as IPEA (International Preliminary Examination Authority).

It seemed grossly unfair that the examining division could incorporate the IPER by reference in its Rule 51(2) communication, but that the applicant could not, in its response thereto, similarly incorporate by reference its reply to the 1st written opinion in the PCT Chapter II procedure. In particular it was noted that the examiner who signed the Rule 51(2) communication was also responsible for the IPER, so that it appeared only reasonable that he should be referred to the applicant's reply in the PCT procedure so that he could give it further consideration. It was equally a reasonable expectation of the applicant that he should be given a reasoned explanation by the examining division as to why his reasoned submissions incorporated by reference in the response to the Rule 51(2) communication were not considered cogent. The fact that the examining division refused the application out of hand, without taking account of the substance of the applicant's response to the Rule 51(2) communication, should be regarded as a substantial

procedural violation justifying reimbursement of the appeal fee.

(ii) *Substantive issues*

In the statement of grounds of appeal the appellant quoted his response dated 5 May 1998 to the first written opinion of the IPEA, which he had sought to incorporate by reference in the response to the Rule 51(2) communication, and made further detailed submissions on the substantive issues which need not be elaborated here.

VI. The appellant requests that the decision under appeal be set aside and that the examination of the application proceed on the basis of claim 1 as refused (main request) or on the basis of amended versions of the claim incorporating proposed alternatives to the allegedly unclear term "light magnifier" (first and second auxiliary requests).

Reimbursement of the appeal fee is also requested on the grounds that the peremptory refusal constituted a substantial procedural violation.

Reasons for the Decision

1. The appeal is admissible.

2. The examining division was correct in its finding that the applicant's response to the written opinion in the PCT Chapter II international preliminary examination procedure could not legally be incorporated by reference in the response to the Rule 51(2)

communication. The fact that this does not apply to the incorporation by reference of the IPER in the Rule 51(2) communication itself is not, as it seems to the appellant, "grossly unfair", since the asymmetry is objectively justified. The IPER, as the concluding report on the PCT Chapter II procedure, is transmitted to the applicant, is physically and legally incorporated in the Euro-PCT examination file at the start of the regional phase, and is open to file inspection. The written opinions and responses thereto are not transmitted to the designated office for the regional phase and are accordingly neither in the regional phase file nor open to inspection, the PCT Chapter II procedure - in contrast to the Euro-PCT regional phase examination - not being a public procedure (Article 38 PCT and Article 42 PCT). The fact that in this particular case the same examiner was involved in both procedures is accidental and has no bearing on the confidential nature of the international preliminary examination, or on the legal procedure to be observed in the regional phase.

3. Given that the examining division applied the law correctly in its determination above, the question then arises whether, having regard to the requirements of Article 96(2) EPC and Article 113 EPC, the examining division acted procedurally correctly when it refused the application for lack of clarity without any reference to the substantive submissions of the applicant on this point, allegedly contained in the PCT Chapter II file and which the applicant had vainly sought to incorporate by reference in his response to the Rule 51(2) communication. The examining division took the view that what was not permissible legally did not exist and therefore there was no rebuttal argument

to consider. In fact it went a bit further and, as the board views it, misconstrued the applicant's traverse of the lack of clarity objection as tantamount to maintaining the unamended claim as a single request.

4. In the judgement of the board, the examining division exalted form over substance in regarding this vain attempt at incorporation by reference as sufficient reason to disregard the clear intention of the applicant to substantiate his traverse of the objection of lack of clarity. As has been repeatedly emphasised in the established jurisprudence of the EPO Boards of Appeal, the opportunity to present comments guaranteed by Article 113(1) EPC is a core value of the examination procedure. It is a formal procedural right, but not merely formal; it is not merely a right to speak, but a **right to be heard**, ie not only the right to present comments, but also the right to have those comments duly considered. It follows that the examining division is duty bound to exercise good faith in making a reasonable attempt to understand what the applicant is trying to say. In particular, it should not be astute to seize upon formal defects to frustrate the expression of the first rebuttal. In the view of the board, the defective response should have been treated in the same way as if the response letter had referred to an enclosure which was not in fact enclosed.

5. In the present case this would have obliged the examining division to advise the applicant of the defect, eg by writen communication or telephone,and to allow him a reasonable time to correct it. In proceeding instead to refuse the application peremptorily the examining division deprived the applicant of his right to a real and substantive

opportunity to present comments pursuant to Article 113(1) EPC on the grounds for refusal foreshadowed in the Rule 51(2) communication. This constituted a substantial procedural violation within the meaning of Rule 67 EPC and also a fundamental deficiency within the meaning of Article 10 of the Rules of Procedure of the Boards of Appeal necessitating remittal of the case to the department of first instance. Since the appellant was obliged to file this appeal to claim his right to be heard, the board deems it equitable that the appeal fee be reimbursed.

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 shall be reimbursed.

The Registrar: The Chairman:

M. Hörnell W. J. L. Wheeler