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D E C I S I O N
of 29 June 2004

Case Number: T 0186/02 - 3.4.3

Application Number: 97116644.2

Publication Number: 0814437

IPC: G07D 7/00

Language of the proceedings: EN

Title of invention:

Method and apparatus for discriminating, authenticating and/or counting documents

Applicant:

CUMMINS-ALLISON CORPORATION

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 76, 96, 113(1)

EPC R. 51, 67, 68

Keyword:

"Basis for decisions: opportunity to comment (no)"

"Procedural violation (yes)"

"Reimbursement of the appeal fee (yes)"

Decisions cited:

T 0951/92

Catchword:

-



Case Number: T 0186/02 - 3.4.3

D E C I S I O N
of the Technical Board of Appeal 3.4.3
of 29 June 2004

Appellant: CUMMINS-ALLISON CORPORATION
891, Freehanville Drive
Mount Prospect
Illinois 60056 (US)

Representative: Grünecker, Kinkeldey,
Stockmair & Schwanhäuser
Anwaltssozietät
Maximilianstrasse 58
D-80538 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 26 July 2001
refusing European application No. 97116644.2
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. K. Shukla
Members: V. L. P. Frank
P. Mühlens

Summary of Facts and Submissions

I. The appeal lies against the decision of the Examining Division dated 26 July 2001 to refuse the European patent application No. 97 116 644.2, which is a divisional application from the earlier European patent application No. 95 931 767.8 (in the following this application will be referred to as the parent application) on the sole ground that the divisional application in suit did not comply with the requirements of Article 76(1) EPC.

II. In the sole communication dated 6 September 1999 pursuant to Article 96(2) and Rule 51(2) EPC the Examining Division observed in connection with the objection under Article 76(1) EPC (cf. point 3 of the communication, emphasis added by the Board) that:

"The applicant has not indicated from which parts of the parent application as originally filed the present divisional application was derived. It appears that the description and drawings correspond to the description and drawings of the parent application as filed.

Independent claim 1 corresponds to neither of the independent claims of the parent application as originally filed. The examining division presently is of the opinion that the requirements of Art. 76(1) EPC are not met.

For each step in the subsequent procedure the examining division asks the applicant to submit indications in handwritten form on a copy of the parent application as filed under the PCT, chapter II in order to facilitate

the examination of the conformity of the amended application with the requirements of Art. 76(1) EPC."

III. With his response dated 17 January 2000 the applicant submitted amended claims, comprising an independent claim 1 directed to a currency evaluation device and an independent claim 10 directed to a method for receiving and evaluating bills and displaying and receiving information concerning the bills, and amended description and figures. A copy of the claims with handwritten indications concerning the origin of the respective features in the parent application as filed was attached.

IV. The Examining Division did not issue a further communication or contact the applicant before issuing the decision under appeal. In the decision it is stated in respect of the objection under Article 76(1) EPC (cf. point 1 of the Statement of Reasons, emphasis added by the Board):

"The examining division can find nowhere in the description of the parent application as filed a clear and unambiguous hint that the invention defined in the independent claims of the parent application as filed may be amended in the particular way leading to the combination of features listed in **independent claims 1 and 10** filed 17.01.2000.

Neither the indications submitted by the applicant in his letter dated 17.01.2000 ... nor the other passages of the parent application as originally filed give a clear and unambiguous hint that starting from one of the

independent claims as filed features may be deleted, amended or introduced in that particular way.

In fact, **independent claims 1 and 10** do not have the slightest similarity to any of the independent claims of the parent application as originally filed."

The same argument is repeated in the statement:

"In the present case, it is the opinion of the examining division that nowhere in the parent application as filed there is a clear and unambiguous hint that the invention is defined by the combination of features listed in **the independent claims** of the divisional application. It is also not permissible to mix features of various embodiments to obtain new subject-matter, see e.g. T 284/94".

It was furthermore observed in the decision that the Examining Division did not see how the application could be amended in order to comply with Article 76(1) EPC without contravening the requirements of Article 123(2) EPC (cf. penultimate paragraph of point 3 of the Statement of Reasons).

- V. The appellant (applicant) lodged an appeal against the above decision on 28 September 2001, paying the appeal fee on the same day. The statement setting out the grounds of appeal was filed on 5 December 2001.

- VI. The appellant requested that the decision under appeal be set aside.

The appellant provided in the letter stating the grounds of appeal a detailed analysis of the features of the claims and the basis for them in both the parent application as filed originally and the application in suit as filed originally. He argued that the requirements of Article 76(1) and 123(2) EPC were, therefore, fulfilled.

Reasons for the Decision

1. The appeal is admissible.
2. *Procedural matters (Article 113(1) EPC)*
 - 2.1 The appellant has not alleged any procedural violation during the proceedings before the Examining Division. The Board, however, has examined the facts of the case of its own motion pursuant to Article 114(1) EPC and has come to the conclusion that the following procedural violations were committed by the Examining Division.
 - 2.2 It follows from the facts of the case set out in item II above that in its only communication preceding the refusal, the Examining Division had informed the applicant that **the only independent claim**, ie claim 1 directed to a currency evaluation device, did not appear to comply with the requirement of Article 76(1) EPC, since it did not correspond to any of the independent claims of the parent application (emphasis added by the Board). Thus, although the ground, ie non-compliance with the requirements of Article 76(1) EPC, was identified, neither the features which were

considered as offending Article 76(1) EPC were specified nor was there any reasoning given as to why the subject-matter of claim 1 extended beyond the content of the parent application.

The communication of the Examining Division contained, moreover, an invitation to provide handwritten indications on a copy of the parent application in order that the fulfilment of the requirements of Article 76(1) EPC could be verified (cf. point 3 of the communication of the Examining Division).

2.3 In the decision under appeal, the Examining Division refused the application on the ground that the application did not meet the requirements of Article 76(1) EPC, since the combination of features of **independent claims 1 and 10** could not be derived from the content of the parent application as originally filed.

2.4 Under Article 113(1) EPC the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

In the context of the examining procedure Article 113(1) EPC is intended to ensure that before a decision refusing the application is issued, the applicant has been clearly informed of the essential legal and factual reasons on which the finding of non-compliance with the requirements of the EPC is based, so that he knows in advance the reasons as to why the application may be refused and has the opportunity to comment on this reasoning.

- 2.5 According to the established case law of the Boards of Appeal, the term "grounds or evidence" should not be narrowly interpreted. In particular, in the context of the examination procedure the word "grounds" does not refer merely to a ground of objection to the application in the narrow sense of a requirement of the EPC, but refers to the essential reasoning, both legal and factual, which leads to the refusal of the application (cf. Case Law of the Boards of Appeal of the European Patent Office. 4th edition 2001, VII.B.3.6).
- 2.6 According to Rule 51(3) EPC every communication pursuant to Article 96(2) EPC shall contain a "reasoned statement" supporting each objection to the application. Although it is clearly impossible to state in general terms when a statement has been sufficiently reasoned to comply with Rule 51(3) EPC, it can be said that the less evident the objection is the more elaborate the reasoning has to be in order to allow the applicant to respond to it.
- 2.7 Although an invitation to the applicant to identify the basis for the claims may help to expedite the examining procedure, it does not create any obligation upon the applicant nor does it affect the obligations upon the Examining Division to comply with the requirements under Article 96 and 113(1) EPC.
- 2.8 It was, therefore, necessary for the Examining Division under Article 96(2) EPC to have issued a further communication, after having received the comments of the applicant, identifying specifically the combination

of features which were objected to and the reasons why such a combination was not disclosed in the parent application (cf. T 951/92, OJ 1996, 53).

2.9 Moreover, the objection that the subject-matter of the **independent method claim 10** also did not meet the requirements of Article 76(1) EPC was communicated to the applicant only in the decision under appeal. It follows, therefore, that no opportunity was given to the applicant to comment on this objection as required by Article 113(1) EPC.

2.10 For the foregoing reasons, in the Board's judgement, the communication of 6 September 1999 did not contain the essential legal and factual reasoning leading to the finding in the subsequent decision that the application did not comply with Article 76(1) EPC, since the subject-matters of independent claims 1 and 10 extended beyond the content of the parent application as originally filed.

The decision to refuse the application was, therefore, issued in violation of Article 113(1) EPC.

This amounts, however, to a substantial procedural violation within the meaning of Rule 67 EPC, and in the Board's judgement, it is equitable that the appeal fee be refunded.

2.11 The Board further considers that the decision of the Examining Division to refuse the application in suit does also not contain the necessary legal and factual reasoning as to why the application did not comply with Article 76(1) EPC. Apart from the general statement

specifying that the Examining Division could not find any clear and unambiguous hint in the parent application that the invention could be amended in the particular way leading to the combination of features of the independent claims, there is no factual reasoning identifying the objected features nor the reasons why they could not be combined as in claims 1 and 10. The applicant had, furthermore, pointed out in his response to the official communication where the basis for the various amendments to the claims were to be found in the description. There is no discussion in the decision, however, as to why the indicated passages of the description do not provide a basis for the amendments to claims 1 and 10. It is left to the applicant and to the Board to guess the factual reasons for the objection.

Rule 68(2) EPC, however, requires *inter alia* that the decisions of the EPO which are open to appeal shall be reasoned. This means that the legal and factual reasoning leading to the refusal has to be set out in the decision so that the parties to the proceedings know the case which is to be answered and the Board of Appeal may examine the contested decision (Article 110(1) EPC).

Thus, there was a further substantial procedural violation, since the decision to refuse the application was not reasoned in the sense of Rule 68(2) EPC (cf. Case law of the Boards of Appeal, 4th edition 2001, VI.L.6.3.3 and VII.D.15.4.4).

3. Having regard to the lack of any factual reasoning in the contested decision as to why the application does

not meet the requirements of Article 76(1) EPC, the Board does not consider it appropriate to deal with this issue of its own motion and remits the case to the department of the first instance so that the applicant's submission dated 5 December 2001 are taken into consideration in the examination of claims 1 to 12 filed on 17 January 2000.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

D. Meyfarth

R. K. Shukla