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**Datasheet for the decision
of 6 November 2006**

Case Number: T 0347/04 - 3.2.07

Application Number: 97919146.7

Publication Number: 0925119

IPC: B05B 5/053

Language of the proceedings: EN

Title of invention:

Control Systems for electrostatic powder spraying apparatus

Applicant:

Eurotec Surface Coating Systems Limited

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 111(1), 114(1)

EPC R. 67, 112

PCT Art. 17(3)(a)

Keyword:

"Lack of unity of invention - absence of information about the possibility of a further search report on the non-searched claims; substantial procedural violation (yes); remittal to first instance; reimbursement of appeal fee (yes)"

Decisions cited:

J 0007/83, J 0006/79, J 0014/99, J 0015/99, J 0021/98,

J 0022/98, J 0006/99, T 0005/81, T 0682/91, G 0002/92

Catchword:

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Case Number: T 0347/04 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 6 November 2006

Appellant: Eurotec Surface Coating Systems Limited
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Representative: Lyons, Andrew John
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 September 2003
refusing European application No. 97919146.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: H. Hahn
E. Lachacinski

Summary of Facts and Submissions

- I. The applicant lodged an appeal against the decision of the Examining Division to refuse the European patent application No. 97 919 146.7.
- II. The present application is based on the International application PCT/GB97/02482 for which the EPO acted as an International Searching Authority (ISA). The International Search Report was completed on 11 December 1997 but only for claims 1 to 12 since the subject-matter of the claims 13 to 21 had been considered to lack unity and no additional search fees had been paid by the applicant upon the invitation of the ISA in that respect.

An International Preliminary Examination Report (IPER) dated 23 December 1998 was subsequently drawn up by the EPO wherein it was stated that no International Search Report has been established for the - then - claims 12 to 20 thus excluding their subject-matter from international preliminary examination.

The entry into the regional phase before the EPO of the application PCT/GB97/02482 took place on 12 April 1999 on the basis of the documents on which the IPER was based. The additional claim fees for claims 11 to 20 were paid on 13 April 1999.

The Examining Division issued its first communication on 26 October 2001 and informed the applicant about the deficiencies in the application by referring to the deficiencies mentioned in the IPER, which gave rise to

objections under the corresponding provisions of the EPC.

With letter of 1 March 2002 the applicant submitted an amended set of claims 1 to 20 containing claims 12 to 20 relating to a specific powder spray coating apparatus.

In the second communication dated 15 October 2002 (see paragraph 1) the Examining Division addressed for the first time the issue of lack of unity between claims 1 and 12 under the provisions of Article 82 and Rule 30 EPC. Furthermore, the Examining Division remarked that the subject-matter of claim 12 (original claim 13) had not been searched and required that the subject-matter of said claim 12 be excised from the claims, description and drawings and suggested it be made the subject of one or more divisional applications in accordance with Article 76(1) and Rule 4 EPC, taking account of Rule 25(1) EPC for the applicable time limit.

With letter of 20 February 2003 the applicant filed an amended set of claims 1 to 20 and stated that in relation to point 1 of the second communication, claims 12 to 20 had been made dependent upon either claim 10 or its dependent claims, so the objection pursuant to Article 82 EPC, was overcome.

With its decision of 3 September 2003 the Examining Division refused the application and held that the subject-matter of claim 1 as filed with letter of 20 February 2003 lacked novelty over documents D1, D2 or D12.

- III. With a communication dated 21 October 2005 the Board informed the appellant that, in application of its discretion under Article 114(1) EPC, it intended to remit the case to the first instance for a rectification of a procedural violation which had taken place. Furthermore, the Board intended to reimburse the appeal fee, pursuant to Article 10, Rules of the Procedure of the Boards of Appeal, and Rule 67 EPC.
- IV. The appellant requested to set aside the decision and to grant a patent on the basis of the claims 1 to 20 underlying the appealed decision as filed with letter of 20 February 2003. As an auxiliary request these claims should be substituted by the amended claims 1 to 20 filed together with the grounds of appeal dated 22 December 2003.

Reasons for the Decision

1. Substantial procedural violation

It is a precondition for reimbursement of the appeal fee in accordance with Rule 67 EPC that a substantial procedural violation has taken place.

- 1.1 According to J 7/83 (OJ EPO 1984, 211) a "substantial procedural violation" is an objective deficiency affecting the entire proceedings.

According to J 6/79 (OJ EPO 1980, 225), the expression "substantial procedural violation" is to be understood, in principle, as meaning that the rules of procedure

have not been applied in the manner prescribed in the EPC.

In decisions J 21/98 (OJ EPO 2000, 406, see point 16, fifth paragraph of the reasons), J 22/98, J 6/99, J 14/99 and J 15/99 (all four decisions not published in OJ EPO) it was decided that a procedural violation which had not played any part in the decision could not be considered substantial. In decision T 5/81 (OJ EPO 1982, 249) it was stated that an alleged violation affecting a part of the decision other than its *ratio decidendi* cannot be a substantial violation within the meaning of Rule 67 EPC.

In decision T 682/91 (not published in OJ EPO) the Board of Appeal emphasised that a procedural violation which did not adversely affect anyone could not be considered substantial (see point 4.2 of the reasons). The seriousness of a procedural violation derived from its adverse effects.

- 1.2 In the present case the rules of procedure have not been applied in the manner prescribed in the EPC so that a procedural violation has occurred. Even though it has not played any part in the decision, it is considered by the Board as a substantial procedural violation due to its consequences and, particularly, its possible worst case consequences for the applicant.
- 1.2.1 The present application represents an international application which entered the regional phase before the EPO as elected office on 12 April 1999, with an International Search Report drawn up by the EPO, so that no supplementary search was carried out (see

Chapter C-III, 7.13 of the Guidelines for Examination in the EPO, version June 1995 (valid at that time) as well as the version July 1999).

1.2.2 From the International Search Report of the present application it is evident that the International Search Authority found two groups of inventions, namely those according to claims 1-12 and according to claims 13-21, and that the search had been restricted to claims 1-12 since no required additional search fees had been paid (see WO-A-98 10871, international search report, Box II, observations where unity of invention is lacking).

1.2.3 According to the above cited Guidelines for Examination, if during the international search performed by the EPO an objection of lack of unity has been raised and the applicant has not taken the opportunity to have the other invention(s) searched by paying additional search fees for them and the applicant has not amended the claims so that they are limited to the invention searched and the examiner agrees with the objection of the International Searching Authority, the examiner has first to invite the applicant to pay further search fees in accordance with Rule 104b(4) EPC within a period of between 2 and 6 weeks, if the applicant wishes the application to be examined on the basis of any of the other inventions (see the Guidelines, version July 1999, C-III, 7.13 (ii)).

Thus, at the time when entering the European phase, i.e. on 12 April 1999 (see EPO Form 1200), Rule 104b(4) EPC had to be applied to the present application.

- 1.2.4 With the decision of the Administrative Council of 13 October 1999 the existing Rules 104b to 106a were replaced by new Rules 106 to 112.

Rule 112 EPC concerns the consideration of unity by the EPO and defines that "if only a part of the international application has been searched by the International Searching Authority because that Authority considered that the application did not comply with the requirement of unity of invention, and the applicant did not pay all additional fees according to Article 17, paragraph 3(a), of the Cooperation Treaty within the prescribed time limit, the European Patent Office shall consider whether the application complies with the requirement of unity of invention. If the European Patent Office considers that this is not the case, it shall inform the applicant that a European search report can be obtained in respect of those parts of the international application which have not been searched if a search fee is paid for each invention involved within a period specified by the European Patent Office which may not be shorter than two weeks and may not exceed six weeks. The Search Division shall draw up a European search report for those parts of the international application which relate to inventions in respect of which search fees have been paid; and that Rule 46, paragraph 2, shall apply mutatis mutandis".

Rule 112 EPC entered into force on 1 March 2000 (see OJ EPO 1999, 660 ff).

- 1.2.5 Consequently, when issuing the first communication on 26 October 2001, i.e. at a time when Rule 112 EPC was in force for almost more than one and half years, the

Examining Division should have applied the provisions of Rule 112 EPC, as the objection for lack of unity of invention was clearly derivable from the International Search Report underlying the present application (see point 1.6.2 above). Also in the IPER dated 23 December 1998 it was stated that claims 12-20 had not been searched and that therefore a reasoned statement with regard to novelty, inventive step or industrial applicability only had been given for the claims 1-11 (see IPER, Form PCT/IPEA/409, sections III and V).

Furthermore, the applicant had requested to proceed with the application on the basis of claims 1 to 20 underlying said IPER (see EPA Form 1200, section 6) for which the correct amount of fees had been paid on 13 April 1999 (see payment printout "Beleg-Nr: 00582885 dated 21 April 1999).

- 1.2.6 The first communication of the Examining Division merely comprised a standard phrase referring to the deficiencies mentioned in the IPER. In this context the Board remarks that a non-unity objection with respect to claims 12-20 had not been raised as such in said IPER.
- 1.2.7 Only in the second communication dated 15 October 2002 the Examining Division made for the first time an objection of lack of unity under Article 82 and Rule 30 EPC in respect of an amended set of claims (as submitted with the applicant's letter dated 1 March 2002) comprising independent claims 1 and 12. It was stated therein that "since the subject-matter of independent claim 12 (original claim 13) has not been searched, this invention is to be excised from the

claims, description and drawings if any. The subject-matter to be excised may be made the subject-matter of one or more divisional applications ...". The Examining Division thus required the applicant to excise the subject-matter of said claim 12 from the claims, description and drawings and suggested it be made the subject of one or more divisional applications.

At the time of issuing the first and second communications, the valid Guidelines for Examination (issue July 1999) required the Examining Division, however, to apply the provisions of Rule 104b(4) EPC in the same manner as worded in new Rule 112 EPC: if the Examining Division agrees with the objection of non-unity made by the International Search Authority, it should state so and allow the applicant to pay further search fees, so as to have a further search report drawn up, after which the applicant can decide with which invention the application is to proceed.

1.2.8 As a response to said second communication the applicant filed an amended set of claims and stated in relation to point 1 of the second communication that claims 12-20 had been made dependent upon either claim 10 or its dependents (see letter of the applicant dated 20 February 2003, page 1, second paragraph), so that the objection of lack of unity was, in his opinion, overcome.

1.2.9 The third and final action of the Examining Division then was the refusal of the application dated 3 September 2003. The decision of the Examining Division is silent with respect to the non-unity issue.

It is also silent whether or not claims 1 to 20 meet the requirements of Article 123(2) EPC.

- 1.2.10 By carrying out the European examination of the present application in the manner described above the applicant was deprived of his right, after paying additional search fees and a further search on claims 12-20 filed with letter of 1 March 2002, to decide on which invention the examination should be based and therefore of his right to proceed with the subject-matter of claims 12 to 20.

By not applying Rule 112 EPC as prescribed the Examining Division committed a procedural violation which in the worst case - if the appeal were to be dismissed - could have resulted in the total loss of the applicant's rights to the subject-matter of claims 12 to 20.

- 1.2.11 Therefore a substantial procedural violation to the disadvantage of the appellant is established which in the present case warrants an immediate remittal of the case to the department of first instance. It also qualifies for reimbursement of the appeal fee in accordance with Rule 67 EPC.

2. *Remittal to the first instance (Article 111(1) EPC)*

The case is therefore remitted to the department of first instance to apply the provisions of Rule 112 EPC in respect of claims 12-20 as filed with letter of 1 March 2002.

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. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders