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D E C I S I O N
of 16 March 2005

Case Number: T 1255/04 - 3.3.1

Application Number: 98958069.1

Publication Number: 1034221

IPC: C09B 11/02

Language of the proceedings: EN

Title of invention:

Dibenzorhodamine dyes useful as fluorescent labelling agents

Applicant:

Applera Corporation

Opponent:

-

Headword:

Dibenzorhodamine dyes/APPLERA

Relevant legal provisions:

EPC Art. 113(2), 97(1)

EPC R. 51(4), (5), (6), 86(3)

Keyword:

"Substantial procedural violation (yes)"

"Reimbursement of appeal fee (yes)"

"Rule 51(4) EPC communication - necessity for including reasons why higher ranking requests are not allowable"

Decisions cited:

T 1181/04

Headnote:

1. In a case where there is a request considered allowable on which a Rule 51(4) EPC communication is to be sent, but there are also not allowed higher-ranking requests, the communication under Rule 51(4) EPC is deficient if it is not accompanied by reasons why the higher-ranking requests are not allowed. This communication should also expressly mention the option of maintaining the disallowed requests, thus reminding the Applicant and the Examining Division of the possibility for the Applicant of asking for a written appealable decision on these higher-ranking requests (see point 3 of the reasons) (decision T 1181/04 of 31 January 2005 followed).

2. If the Applicant maintains a still pending higher-ranking request discussed at the oral proceedings before the Examining Division, that request cannot be refused under Rule 86(3) EPC. The decision under appeal by merely stating that the application is refused because there is no version approved of by the Applicant in the sense of Article 113(2) EPC on which a patent could be granted is inadequately reasoned because it does not give the substantive reasons why what the Applicant does approve of is not in conformity with the patentability requirements of the EPC (see point 4 of the reasons).



Case Number: T 1255/04 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 16 March 2005

Appellant: Applera Corporation
850 Lincoln Centre Drive
Foster City, CA 94404 (US)

Representative: Vossius, Volker, Dr.
Dr. Volker Vossius
Patentanwaltskanzlei - Rechtsanwaltskanzlei
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 12. Mai 2004
refusing European application No. 98958069.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: P. P. Bracke
S. C. Perryman

Summary of Facts and Submissions

- I. The appeal lies from the Examining Division's decision refusing European patent application No. 98 958 069.1, published as WO 99/27020, on the ground that there was no version approved by the applicant in the sense of Article 113(2) EPC, on which a patent could be granted.
- II. From the minutes of the oral proceedings before the Examining Division it follows, that sets of claims according to a main request and five auxiliary requests were discussed at the oral proceedings, that the main and the first to fourth auxiliary requests were rejected due to lack of inventive step and that the fifth auxiliary request was considered to be inventive. Therefore, it was stated that the Examining Division intended to issue a Rule 51(4) EPC communication on the basis of the fifth auxiliary request.
- Furthermore, it was stated in the minutes that the Representative stressed the maintenance of the main request and the first to fourth auxiliary requests.
- III. In a communication under Rule 51(4) EPC, dated 16 July 2003, the Applicant was informed that the Examining Division intended to grant a European patent on the basis of a set of claims which indisputably corresponded to the fifth auxiliary request discussed at the oral proceedings before the Examining Division. No mention was made of the rejected requests or the reasons for their refusal.

- IV. In its reply to the communication under Rule 51(4) EPC (received on 23 January 2004), the Applicant requested to replace the set of claims according to the fifth auxiliary request discussed at the oral proceedings before the Examining Division by a set of claims corresponding to the one according to the main request discussed at the oral proceedings before the Examining Division and declared their approval under Rule 51(4) EPC provided that the set of claims according to the main request was acceptable.

The German and French translations of the claims were enclosed; it was requested that the decision to grant a patent be issued; and the payment of fees for grant and printing (up to 35 pages) - 715 € - and a fee for printing the 36th and each additional page - 450 € - was ordered.

- V. Thereupon, the Examining Division decided to refuse the patent application.

In its decision the Examining Division stated as grounds for refusal that the Applicant requested grant of a patent on the basis of the main request which had already been thoroughly discussed during oral proceedings (Article 113(1) EPC). The Examining Division already informed the Applicant, during these oral proceedings, that this request did not fulfil the requirements of the EPC. Consequently, the Examining Division decided to refuse the proposed amendments by virtue of Rule 86(3) EPC. According to Article 113(2) EPC, a decision on a European patent application can only be based on the text submitted or agreed by the Applicant. The Applicant only gave his agreement to a

version of the application documents which is not allowable under the EPC. Therefore, the Examining Division has to refuse the application on the ground that there is no version approved by the Applicant in the sense of Article 113(2) EPC, on which a patent could be granted.

- VI. The Applicant, now Appellant, submitted that the Examining Division made a substantial procedural violation, since it was not entitled to refuse the patent application before giving the Applicant an opportunity to submit observations and/or amendments according to Rule 51(6) EPC.
- VII. The Appellant requested the reimbursement of the appeal fee and withdrew its originally filed request for oral proceedings before the Board, if the case is remitted to the first instance for further prosecution.

Reasons for the Decision

1. The appeal is admissible.
2. *Rule 51(5) and (6) EPC*
 - 2.1 Rule 51(5) EPC stipulates, that, if the Applicant requests amendments within the period laid down in Rule 51(4) EPC, he shall be deemed to have approved the grant of the patent as amended, if he files a translation of the amended claims in the two official languages of the EPO other than the language of the proceedings and pays the fees for grant and printing.

As the necessary translations of the amended claims were filed in due time and the fees for grant and printing were paid in due time, the requirement of Rule 51(5) EPC were fulfilled.

- 2.2 Furthermore, Rule 51(6) EPC requires, that, if the Examining Division does not consent to an amendment requested under paragraph 5, it shall, **before taking a decision**, give the Applicant an opportunity to submit his observations and any amendments considered necessary by the Examining Division.

Since in the present case the Appellant requested amendments and all the requirements of Rule 51(5) EPC were fulfilled, the Examining Division was required to afford the Applicant an opportunity to submit his observations, before taking a decision. It did not do so, thus committing a substantially procedural violation which, as argued by the Appellant, justifies the reimbursement of the appeal fee under Rule 67 EPC and remittal of the case to the department of first instance for further prosecution.

3. *Communication under Rule 51(4) EPC*

- 3.1 As already pointed out in decision T 1181/04-3.3.6 of 31 January 2005 (to be published in the Official Journal), a major problem seems to have arisen because in cases where the Applicant has submitted a main request and one or more auxiliary requests, and the Examining Division intends to allow only one of the auxiliary requests, the Applicant is sent a communication under Rule 51(4) EPC indicating the allowable request on which the Examining Division is

prepared to grant a patent, but is not told that he has the option of maintaining his disallowed requests and obtaining a written decision giving the reasons for refusing these, as an alternative to approving grant of the patent on the basis of the request the Examining Division is prepared to allow.

Although it is true that this option is not explicitly cited in Rule 51(4) EPC, as entered into force on 1 July 2002, such option is not excluded by the wording thereof. Even more, in order to ensure that the Applicant's right to challenge the refusal of higher-ranking requests by an appeal is preserved, an Applicant may not be deprived from such option.

3.2 In a case where there is a request considered allowable on which a Rule 51(4) EPC communication is to be sent, but there are also not allowed higher-ranking requests, the communication under Rule 51(4) EPC is deficient if it is not accompanied by reasons why the higher-ranking requests are not allowed. This communication should also expressly mention the option of maintaining the disallowed requests, thus reminding the Applicant and the Examining Division of the possibility for the Applicant of asking for a written appealable decision on these higher-ranking requests (decision T 1181/04 of 31 January 2005 followed). Only this is likely to ensure that both Applicants and the Examining Division know what to do.

3.3 There is, thus, no reason to deviate from the practice as set out in the relevant "Guidelines for Examination in the European Patent Office" (December 2003 version) in Part E, Chapter X: DECISIONS, 5. Reasoning of

decisions, in particular, the fifth paragraph thereof, where it is stated that, if during examination proceedings a main and subsidiary requests have been filed and a subsidiary request is allowable, the communication pursuant to Rule 51(4) EPC is to be issued on the basis of the (first) allowable request and **must be accompanied by an explanation of the reasons why the higher-ranking requests are not allowable**. Should the Applicant, in response to the communication pursuant to Rule 51(4), maintain higher-ranking requests which are not allowable, a decision to refuse the application pursuant to Article 97(1) EPC will be issued.

4. *Article 113(2) EPC and Rule 86(3) EPC*

4.1 In the present case the Appellant made clear that he was maintaining his main request in the form argued for at the oral proceedings before the Examining Division. As the request asked for had already been discussed in substance at oral proceedings, this request could not be refused under Rule 86(3) EPC as was done in the decision under appeal. Rule 86(3) EPC is intended to prevent an Applicant making an indefinite number of successive attempts to persuade an Examining Division to allow grant on requests raising new issues, it is not intended nor can it be used to deprive an Applicant from obtaining a decision giving the substantive reasons for refusal of a request already considered in substance during the proceedings. Such a decision on the substantive issues is necessary so that the Applicant can decide whether to appeal or not, and as focus for the arguments in any subsequent appeal proceedings. A decision stating, as does the decision

under appeal, that the application is refused because there is no version approved by the Applicant in the sense of Article 113(2) EPC on which a patent could be granted is inadequately reasoned because it does not give the substantive reasons why what the Applicant does approve of is not in conformity with the patentability of the EPC. Rejecting the application on this basis can only be regarded as amounting to a further substantial procedural violation requiring the decision under appeal to be set aside and the appeal fee to 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 first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

N. Maslin

A. Nuss