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D E C I S I O N
of 11 May 2006

Case Number: T 0591/05 - 3.4.02

Application Number: 97307911.4

Publication Number: 0837321

IPC: G01N 21/88

Language of the proceedings: EN

Title of invention:

Optical disc inspection equalization system and method

Applicant:

Wea Manufacturing Inc.

Opponent:

-

Headword:

Admissibility of appeal/WEA

Relevant legal provisions:

EPC Art. 21(3)(b), 86(4), 97(2), 106(1), 107, 110(1), 113(2),
122, 123(3), 138(2), 141(2)
EPC R. 25(1), 51, 57a, 86(1)

Keyword:

"Enlargement of the composition of the Board (no)"
"Admissibility of appeal against decision to grant a patent -
adversely affected (no: new prior art document found after
grant, filing of divisional application after grant, and
suspensive effect of appeal immaterial to the admissibility of
the appeal)"

Decisions cited:

G 0009/93, J 0012/83, J 0012/85, J 0028/94, J 0028/03,
T 0549/93, T 0953/96, T 0824/00

Catchword:-



Case Number: T 0591/05 - 3.4.02

D E C I S I O N
of the Technical Board of Appeal 3.4.02
of 11 May 2006

Appellant: Wea Manufacturing Inc.
1400 East Lackawanna Avenue
Olyphant
Pennsylvania 18448 (US)

Representative: Jones, Colin
Withers & Rogers
Goldings House
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London SE1 2HW (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 16 December 2004
granting European patent No. 0837321 pursuant
to Article 97(2) EPC.

Composition of the Board:

Chairman: A. G. Klein
Members: F. J. Narganes-Quijano
M. J. Vogel

Summary of Facts and Submissions

- I. The appellant lodged an appeal against the decision of the examining division granting European patent No. 0837321 pursuant to Article 97(2) EPC on the basis of patent application No. 97307911.4.

During the first-instance proceedings, the then applicant and now appellant was informed with a communication under Rule 51(4) EPC dated 08.06.2004 that the examining division intended to grant a European patent on the basis of the application documents annexed to the communication. Except for minor amendments proposed by the examining division, the application documents corresponded to the then valid request of the appellant. In reply to the communication under Rule 51(4) EPC, the appellant approved, subject to some amendments, the application documents enclosed with the communication under Rule 51(4) EPC and also complied with the remaining provisions set forth in Article 72(1) and Rule 51 EPC. In particular, the appellant paid the grant and printing fees and filed the translations of the claims in the two other official languages in due time. The decision to grant a patent pursuant to Article 97(2) EPC was then issued on 16.12.2004. According to the decision, the patent was granted with the application documents enclosed with the communication pursuant to Rule 51(4) EPC amended as subsequently requested by the appellant. The mention of the grant of the patent was published in European Patent Bulletin 05/04 of 26.01.2005.

II. In the notice of appeal dated 25.02.2005 the appellant indicated that the appeal was against the decision to grant in its entirety. With the statement of grounds of appeal dated 14.04.2005 the appellant filed document

A1 : US-A-4197011,

and requested that the decision under appeal be set aside and the case be remitted to the examining division for further prosecution, and in particular for the assessment of the relevance of document A1 to the patentability of the invention. The appellant also requested oral proceedings on an auxiliary basis. In a subsequent letter dated 19.01.2006 the appellant requested that the Board included two legally qualified members under Article 21(3)(b) EPC.

III. Oral proceedings were appointed by the Board. In a communication annexed to the summons to attend oral proceedings, the Board noted that there was no special or appropriate reason for enlarging the composition of the Board pursuant to Article 21(3)(b) EPC and expressed doubts as to the admissibility of the appeal within the meaning of Rule 65(1) and Article 107 EPC.

IV. Oral proceedings were held before the Board on 11 May 2006. The appellant maintained the requests previously submitted in writing.

At the end of the oral proceedings the Board gave its decision.

V. The arguments submitted by the appellant in support of his requests are essentially the following:

Despite the fact that the amended application documents for grant were approved, the appeal against the decision to grant is admissible in that subsequently the appellant has been adversely affected by the decision in two different ways.

First, it is agreed that the claims of the application documents on the basis of which the examining division decided to grant a patent define patentable subject-matter with regard to the state of the art known at that time. However, document A1, which came to light during parallel proceedings in the USA and was not considered during the examination proceedings before the EPO, discloses features similar to features of the invention as presently claimed. Although no amendment of the claims as granted is required, the description should give account of the document. Consideration by the examining division of the new document could assist in preventing actions against the appellant or could avoid possible adverse effects on the appellant in a possible opposition before the EPO or in subsequent revocation proceedings before a national court. Due to Article 123(3) EPC, there is greater scope of amendments available in pre-grant than there is in post-grant proceedings, and this circumstance differentiates the present appeal from the situation in decision J 12/85. This decision and decision T 549/93 only concern aspects relating to the text of the granted patent and none of them preclude that an appellant may be adversely affected in other ways even if he approved the text for grant. Thus, the decision to grant the patent in the present case has adversely affected the appellant in restricting the scope of

amendment subsequently available to him. Already for this reason, the case should be remitted to the examining division to assess the relevance of document A1 to the patentability of the invention.

Second, the appellant is also adversely affected by the decision under appeal in view of the filing by the appellant of a divisional application directed to complementary aspects of the application as originally filed. During the examination proceedings, and in response to an objection of lack of unity under Article 82 EPC raised by the examining division, the appellant already announced with his letter dated 25.03.2002 that "the applicant reserves the right to file one or more divisional applications". Due to a mistake in the attorney's office, however, the divisional application was filed after the present appeal was filed. Nonetheless, the appellant's intention was to file the divisional application in due time (Rule 25(1) EPC), and the appellant took all due care to ensure that this was done. Should the divisional application not be accorded the date of filing of the present application, the appellant would be adversely affected. Alternatively, since the aforementioned letter clearly identified the appellant's intention to file a divisional application, the grant of the patent eventually, when no divisional application had been filed, adversely affected the appellant.

If a different deadline had been involved such that Article 122 EPC was applicable, then an application for *restitutio in integrum* would have been successful, given the actions of the appellant. Therefore, the

adversely-affected requirement should not be interpreted in the present case so strictly as to put the appellant in a worse position than it would be in accordance with other provisions of the EPC, such as Article 122 EPC, in similar circumstances.

Whilst appreciating that the law and rules governing patent prosecution and procedure in the United Kingdom are different from those of the EPC, in the UK an already granted patent can be rescinded so as to allow the filing of a divisional application (decision of the High Court of Justice, Patents Court (UK) dated 06.04.2006 in case CH/2005/APP/0728).

The EPO requires the payment of the ninth year renewal fee to be made on this case; thus, it would seem that officially this is still a pending application. That status would seem to be confirmed by the fact that the renewal fees at the national offices where the patent is being validated are being returned to the appellant.

Since the pertinent issue is the legal basis for the appeal, the Board should consider exercising its discretion under Article 21(3)(b) EPC and include two legally qualified members in this case.

Reasons for the Decision

1. *Request for enlarging the composition of the Board pursuant to Article 21(3)(b) EPC*

The appellant has requested that, in view of the legal issues to be decided in the present appeal and

involving in particular the admissibility of the appeal, the Board should be enlarged with two legal members. According to Article 21(3)(a) EPC, for appeals from a decision of the examining division a Board of Appeal shall consist of "two technically qualified members and one legally qualified member, when the decision concerns [...] the grant of a European patent and was taken by an Examining Division consisting of less than four members", and according to Article 21(3)(b) EPC the Board shall consist of "three technically qualified members and two legally qualified members when the decision was taken by an Examining Division consisting of four members or when the Board of Appeal considers that the nature of the appeal so requires".

However, the decision under appeal was taken by an examining division consisting of three members. In addition, as regards the nature of the appeal, the present Board has not been confronted, either during the written appeal proceedings or during the oral proceedings at the end of which the Board gave its decision, with any special circumstance or any particular legal or factual issue that would have justified in the present case enlarging the composition of the Board. Accordingly, the present Board in its original composition pursuant to Article 21(3)(a) EPC considered that it was neither necessary nor appropriate to enlarge its composition under Article 21(3)(b) EPC as requested by the appellant and consequently decided to reject the appellant's request in this respect.

2. *Admissibility of the appeal*

2.1 According to Article 107 EPC, any party to proceedings (in the present case the then applicant) "adversely affected by a decision" may appeal, and according to Rule 65(1) EPC compliance with Article 107 EPC is a prerequisite for an appeal to be considered as admissible. The question therefore arises whether the appeal lodged by the appellant against the decision of the examining division to grant the patent is admissible under Rule 65(1) EPC, and in particular whether the appellant was "adversely affected" by the decision to grant within the meaning of Article 107 EPC.

2.2 The decision to grant a patent was issued by the first-instance department in accordance with the requirements of Article 97(2) EPC and the provisions set forth in Rule 54 EPC, and after the appellant expressly approved and intentionally complied with all the procedural steps leading to the grant of the patent (point I above). Thus, it is clear from the facts and not even disputed by the appellant (point V above) that the procedure leading to the grant of the patent was consistent with the grant procedure prescribed by the EPC and, in addition, was based on the application documents amended according to the then valid and unambiguous request of the appellant. In these circumstances, the decision under appeal was fully consistent with the request of the appellant at that time - or, using the more precise formulation of the French text of Article 107 EPC, the decision "a fait droit aux prétensions" of the appellant - and the Board is unable to see in what respect the appellant could have been adversely affected by the decision to grant

(see decisions J 12/83 (OJ EPO 1985, 6), point 3 of the reasons, J 12/85 (OJ EPO 1986, 155), points 3 to 6, J 28/03 (OJ EPO 2005, 597), point 11, and T 953/96, points 1 and 2).

2.3 A first line of argument developed by the appellant in support of the admissibility of the appeal is that he was *subsequently* adversely affected by the decision to grant on the grounds that a prior art disclosure (document A1) found during parallel national proceedings and not considered during the examination proceedings before the EPO might be pertinent in possible opposition or national revocation proceedings. It cannot be denied that the situation faced by the appellant in such circumstances can be qualified as subjectively adverse. Nonetheless, irrespectively of the degree of relevance of the disclosure of the document, the Board can at the most conclude from these facts that the appellant may possibly be adversely affected by the disclosure of the document in possible subsequent post-grant proceedings, not however that he was actually and objectively adversely affected by the decision to grant within the meaning of Article 107 EPC because by granting the patent the first-instance department fully acceded to the then valid request of the appellant.

The further contention of the appellant that the decision to grant adversely affected him "in restricting the scope of amendment subsequently available to him" to give account of the disclosure of document A1 cannot be followed either. An applicant has the legitimate interest of having a patent being granted and, once a patent has been granted with the

explicit and express approval of the applicant, he is presumed to be aware of, and to cope with the consequences of having the patent granted such as the substantial restrictions imposed by the EPC to the scope of amendments of a granted patent during possible post-grant proceedings (Articles 123(3) and 138(2) and Rule 57a EPC). Accordingly, the restrictions to the scope of amendments available to a patent proprietor in possible post-grant proceedings cannot be subsequently invoked in support of the contention that the patent proprietor was, in retrospect, adversely affected by the decision to grant. As regards the existence of a potentially pertinent prior art document found by the appellant after the grant of the patent, this may be legitimately invoked in support of the need for a post-grant procedure enabling a patent proprietor to give account of new facts - as has been actually done (see for instance decision G 9/93, OJ EPO 1994, 891, point 4.1 of the reasons) and followed by the legislator who introduced new Article 105a in the revision of the EPC 2000 (OJ EPO 2001, Special edition No. 4, page 97) that has not yet entered into force - but, in the absence of any appropriate legal provision in the EPC and as already concluded in the former paragraph, cannot be invoked in support of the admissibility of the appeal, let alone in support of the appellant's wish that the appeal be tacitly deemed to be admissible under Rule 65(1) EPC in order to give the Board the possibility of considering reopening the examination proceedings for a reassessment of the case to protect the appellant from possible adverse effects that may arise from the existence of document A1.

2.4 According to a second line of argument of the appellant, the filing of a divisional application was already announced during the examination proceedings but - due to circumstances that are not relevant to the present appeal - the divisional application was only filed after the relevant date of the decision under appeal with the consequence that the appellant would be adversely affected if the filing date of the application in suit could not be accorded to the divisional application pursuant to Rule 25 EPC.

It is however noted that the declaration made by the appellant during the examination procedure that he reserved the right to file divisional applications expressed at the most an intention at that time and did not create any obligation on the part of the examining division in charge of the examination of the application to check the status of any possible divisional application based on the application in suit, still less to possibly postpone the grant of the patent in order to elucidate the outcome of the appellant's intentions regarding possible divisional applications. Thus, once the appellant gave during the grant procedure his approval to the text for grant, the general principles of due process and good faith were fully complied with by the examining division when it proceeded to grant the patent since as stated in decision T 824/00 (OJ EPO 2004, 5, point 6 of the reasons) "a competent first instance department of the EPO is empowered under Article 113(2) EPC to take a decision which terminates the first instance procedure on the basis of the *ostensible final requests* of the parties as determined by the department concerned with due care and diligence having regard to what has been

duly submitted by the parties" [emphasis added by the Board]. Thus, the formulation of the requests during the grant procedure and the approval of the application documents proposed for grant were the sole responsibility of the appellant (T 953/96, *supra*, point 3 of the reasons) and it was incumbent upon the appellant, and not upon the examining division or upon the EPO, to undertake the appropriate measures to ensure that any possible divisional application was being filed in due time before the grant procedure was closed.

In addition, while the status of the application on which the patent was granted - or, for the present purposes, the outcome of the present appeal - may be crucial for the legal status of the divisional application, the Board cannot see in what respect the divisional application may have any bearing on the admissibility of the present appeal. In particular, any allegation relating to the circumstances under which the divisional application was filed might well be pertinent to the legal status of the divisional application, but is irrelevant to the issue of the admissibility of the present appeal under Article 107 EPC.

In view of the above, neither the fact that the appellant announced his intention to file a divisional application nor the filing and the status of the divisional application constitute a sufficient reason to conclude that the appellant was adversely affected by the decision to grant within the meaning of Article 107 EPC (see decision T 549/93, points 3 and 6 of the reasons).

The further contention of the appellant that the requirement under Article 107 EPC should not be interpreted so strictly as to put the appellant in a worse situation than he would be in accordance with other provisions such as those set forth in Article 122 EPC does not persuade the Board either. The requirement of Article 107 EPC cannot be purposively construed to meet the particular circumstances of the present appeal by citing special provisions of the EPC that have no bearing on the admissibility of the appeal itself. In addition, there is no legal provision or general principle in support of the contention of the appellant that different legal provisions - and in particular those of Articles 107 and 122 and Rule 25 EPC - should be interpreted so as to put a party to proceedings in procedurally comparable situations. On the contrary, Article 122 EPC itself expressly specifies exceptions to the extent of applicability of its provisions (see Article 122(5) EPC) and is therefore explicitly at variance with the contention of the appellant in this respect (see also T 824/00, *supra*, point 6 of the reasons).

Finally, the submissions of the appellant that in the United Kingdom the grant of a patent can be "rescinded" so as to permit the applicant to file a divisional application based upon the corresponding application *rely*, as acknowledged by the appellant himself and shown in the decision of the Patent Court of the High Court of Justice of the United Kingdom cited by the appellant, on legal provisions and rules that have no counterpart in the EPC. These submissions are therefore irrelevant to the admissibility of the present appeal.

2.5 The appellant has also submitted that the fact that the EPO has requested payment of the ninth year renewal fee and the fact that the national offices have returned to the appellant the renewal fees would indicate that officially the application is still pending. However, these facts merely reflect the suspensive effect that the present appeal against the entirety of the decision to grant has pursuant to Article 106(1) EPC on the payment of renewal fees under Articles 86(4) and 141(2) EPC, the suspensive effect persisting until the end of the present appeal proceedings (J 28/94 (OJ EPO 1995, 742), point 2.2 of the reasons and J 28/03, *supra*, points 12 to 14 and 18). Thus, the facts alleged by the appellant merely reveal the pending status of the present appeal against the decision to grant, not that the application itself is still pending independently of the present appeal since that would require setting aside of the decision under appeal what in turn would presuppose the existence of an admissible appeal.

Accordingly, the suspensive effect of the present appeal is a direct consequence of, and is subordinate to the appeal itself (Article 106(1) EPC) and, consequently, no circumstance directly arising from the suspensive effect of the appeal can be invoked in support of the admissibility of the appeal itself.

2.6 In view of the above, and in the absence of evidence that the circumstances during, and relating to the first-instance examination proceedings were such that the appellant was adversely affected by the decision under appeal within the meaning of Article 107 EPC, the Board concluded during the oral proceedings that the

appeal had to be rejected as inadmissible in accordance with Rule 65(1) EPC.

3. In the absence of an admissible appeal, the Board has no competence to consider the allowability of the appeal (Article 110(1) EPC) and in particular the allowability of the requests of the appellant to set aside of the decision and to remit the case to the examining division for further prosecution. In addition, the fate of the divisional application referred to by the appellant is immaterial to, and beyond the legal framework of the present appeal (T 549/93, *supra*, point 6 of the reasons).

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

M. Kiehl

A. G. Klein