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**Datasheet for the decision  
of 16 October 2006**

**Case Number:** T 0934/05 - 3.2.07

**Application Number:** 01914107.6

**Publication Number:** 1268315

**IPC:** B65F 1/14

**Language of the proceedings:** EN

**Title of invention:**

Method and container for selectively collecting solid urban waste

**Applicant:**

Barbaro, Filippo

**Opponent:**

-

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 111(1), 113(1)

EPC R. 67

**Keyword:**

"Substantial procedural violation - yes; essential reasoning first given in written decision"

"Non-appearance at oral proceedings - does not mean right to be heard has been observed when non-communicated reasons were given in the decision"

"Refund of appeal fee - yes"

"Remittal - yes"

**Decisions cited:**

T 0951/92, T 0003/90

**Catchword:**

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Case Number: T 0934/05 - 3.2.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 16 October 2006

**Appellant:** Barbaro, Filippo  
Via Trabocchetto, 1, n. 7  
I-89100 Reggio Calabria (IT)

**Representative:** Crugnola, Pietro  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 8 February 2005  
refusing European application No. 01914107.6  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chair:** H. Meinders  
**Members:** P. O'Reilly  
C. Holtz

## Summary of Facts and Submissions

- I. European application No. 01 914 107.6 was refused by the examining division for lack of inventive step of the subject-matter of independent method claim 1 and lack of novelty of the subject-matter of independent apparatus claim 9.
- II. The appellant (applicant) filed an appeal against the decision.
- III. The appellant requested that the decision under appeal be set aside and the case be remitted to the examining division for further examination. Alternatively, the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of an amended independent claim 1 filed with the appeal and independent claim 9 filed with letter of 11 December 2003. The appellant further requested that the appeal fee be reimbursed.
- IV. International application No. PCT/IB01/00449 was filed with 55 claims. The International Searching Authority found that there were five inventions. No additional search fees were paid and the search was carried out on the basis of the first invention claimed in claims 1 to 17. On entering into the regional phase before the EPO claims fees were paid only for claims 1 to 17.

The examining division, in its first communication dated 17 April 2003, repeated the ground of lack of unity as in the International search report despite the fact that claims fees were only paid for the first invention. The examining division considered that the

subject-matter of independent method claim 1 lacked novelty in view of each of D1 or D2. The examining division further considered that the subject-matter of independent apparatus claim 13 lacked novelty in view of each of D3, D4 and D5. The examining division further considered that D1 disclosed the features of dependent claims 1 (*sic*) to 6, 8, 9 and 11, that D2 disclosed the features of dependent claims 2 to 10 and 12, and that the features of claims 14 to 16 were known from D1 to D5. It was not clearly stated for all dependent claims which claims lacked novelty and which claims lacked an inventive step in view of which documents.

With its letter dated 11 December 2003 the applicant filed an amended independent method claim 1 which was a combination of previous claims 1, 2, 3, 5 and 7 and an amended independent apparatus claim 9 which was a combination of previous claim 13 and part of the description on pages 5 and 6. Arguments in favour of patentability were presented by the applicant. Oral proceedings were requested by the applicant before the issue of a final decision.

On 24 March 2004 a summons to oral proceedings was issued by the examining division for the 19 April 2004 with a last date for filing submissions of 5 April 2004. The summons was received by the applicant on 1 April 2004. In the accompanying communication the examining division considered that the subject-matter of claim 1 lacked novelty in view of D2 and a short argumentation to this effect was provided. It further gave the opinion "that the subject-matter of claims 1 to 13 does at least not involve an inventive step in

view of D1 and D2 taking into account the common knowledge of the skilled man". No reasons were given for this conclusion.

After a protest by the applicant in its letter of 1 April 2004 that the summons to oral proceedings did not comply with Rule 71(1) EPC the examining division cancelled the oral proceedings and summoned again for 22 November 2004. No communication was appended to the summons to this later oral proceedings.

With letter of 19 November 2004 the applicant indicated that it would not attend the oral proceedings.

The oral proceedings took place as scheduled in the absence of the applicant and a decision was announced to refuse the application for lack of inventive step in claim 1 as indicated in the minutes of the oral proceedings from 22 November 2004 dated 8 February 2005.

In the decision of the examining division it was considered that the subject-matter of claim 1 was novel over D1 and D2. However, it was considered that claim 1 lacked an inventive step based on either of D1 or D2 and the general knowledge of the skilled person in the technical field. The subject-matter of claim 9 was considered to lack novelty over D1. The dependent claims were also considered to lack inventive step in view of D1 and D2. The examining division considered that the requirements of Article 113(1) EPC were fulfilled by the scheduling of an oral proceedings even in the absence of the applicant.

- V. The appellant with its appeal grounds filed an amended claim 1 and argued that the subject-matter of each of the independent claims 1 and 9 was novel and involved an inventive step. Oral proceedings were requested if the Board should be of a different opinion.
- VI. In a communication of the Board, the Board set out its provisional opinion. The Board indicated that it considered that the right to be heard of the applicant in accordance with Article 113(1) EPC did not appear to have been respected in the examination proceedings. The Board provisionally concluded that a substantial procedural violation had been committed. The Board indicated its intention to remit the case to the department of first instance for further examination and to order reimbursement of the appeal fee.
- VII. With letter of 3 January 2006 the appellant concurred with the opinion of the Board. In the letter appellant requested the remittal of the case and the reimbursement of the appeal fee. The request for oral proceedings was maintained only if the Board did not remit the case.

## **Reasons for the Decision**

1. *Article 113(1) EPC*
- 1.1 In the first communication of the examining division the opinion was expressed that the independent method claim 1 lacked novelty over D1 and that the independent apparatus claim 13 lacked novelty over each of D1 to D5. For the dependent claims the examining division

indicated that claims 1 to 6, 8, 9 and 11 lacked novelty over D1 though without giving any supporting reasons. The examining division also gave an indication where the features of the dependent claims could be found in the prior art or if the features were considered to be general knowledge. Such a communication is quite usual and serves first of all to give the applicant the reasons why the independent claims are not allowable and secondly what problems could arise if one or more of the dependent claims are combined with the independent claims. The Board sees no procedural difficulty with the content of such a communication as a first communication.

The applicant also reacted reasonably in that with its response it filed a new set of thirteen claims in which the independent claims were considerably restricted. Independent method claim 1 was restricted to a combination of claims 1, 2, 3, 5 and 7 whereby it may be noted that the examining division apparently considered claim 7 at least to be novel. Independent apparatus claim 9 was based on original claim 13 together with part of the description. There was therefore a reasonable possibility that the objections of the examining division could be overcome by the amendments. The applicant additionally provided arguments in his response as to why the subject-matter of the independent claims was novel and involved an inventive step. The applicant also requested oral proceeding before a final decision. The response was thus a serious attempt by the applicant to respond to the objections of the examining division.

Up to this point therefore the examination proceedings had run normally and the Board sees nothing particularly reproachable in the actions of the examining division.

1.2 The examining division then summoned the applicant to oral proceedings with less than three weeks notice without obtaining his agreement to a period shorter than the two months that are required by Rule 71(1) EPC. Such an action by the examining division to limit the right to be heard of the applicant is clearly procedurally wrong and cannot be condoned by the Board. Since, however, the examining division, after receipt of the protest by the applicant, then set a new date for the oral proceedings with more than the required two months notice the Board considers that the examining division avoided committing a substantial procedural violation by this measure.

1.3 With the summons to oral proceedings the examining division indicated its provisional opinion. It considered that claim 1 lacked novelty over D2, indicating that the last feature of claim 1 was known from a specific part of D2. It was stated by the examining division, however without supporting reasoning, that the subject-matter of claims 1 to 13 lacked an inventive step in view of D1 and D2 and the common general knowledge of the skilled person. Such a communication may be considered as a suitable indication of the matters to be discussed in oral proceedings, though in respect of inventive step of the subject-matter of claims 1 to 13 it may not have constituted a reasoned communication sufficient to fulfil the requirements of Article 113(1) EPC of

informing the applicant of the grounds against the grant of a patent.

- 1.4 Although the applicant indicated that it would not attend the oral proceedings the examining division held the oral proceedings in the absence of the applicant and announced the decision to refuse the application. It is established practice that a statement by a party that it will not attend the oral proceedings which it has requested must be interpreted as a withdrawal of this request (see T 3/90 OJ 1992, 737) since a party does not have a right to oral proceedings which it does not intend to attend. On the other hand an examining division is entitled to summon to oral proceedings at its own initiative without a request by the applicant (see Article 116(1) EPC, first sentence) and to continue oral proceedings in its absence (see Rule 71(2) EPC). The oral proceedings before the examining division in the present case must therefore be considered to have fallen into the latter category, i.e. at the initiative of the examining division, since it did not cancel the oral proceedings after the statement by the applicant that it would not attend the oral proceedings.

What was discussed at those oral proceedings held on 22 November 2004 thus remained entirely within the examining division until it was communicated to the applicant on 8 February 2005 together with the impugned decision.

- 1.5 This Board considers that the case law on how the term "grounds" has to be interpreted with respect to fulfilling the requirements of Article 113(1) EPC

before taking a decision to refuse an application is quite clear: the applicant must have been clearly informed beforehand of the essential reasoning, both legal and factual, on which the finding of non-compliance with the EPC is based and must have had sufficient opportunity to comment thereon (see T 951/92, point 3(v) of the reasons OJ 1996, 53).

"Grounds or evidence" as mentioned in Article 113(1) EPC should not be interpreted narrowly, i.e. the expression does not refer merely to a requirement of the EPC which is not considered to have been met.

- 1.6 The fact that both the first communication and the communication accompanying the summons refer as such to the grounds of lack of novelty as well as lack of inventive step, as is the case in the decision under appeal, cannot therefore suffice to fulfil the requirements of Article 113(1) EPC. Moreover, after the first communication the subject-matter of the independent claims 1 and 9 has been amended by incorporating into claim 1 the subject-matter of dependent claims and into claim 9 parts of the description, thus changing the basis of the examination.

Thus, for the purpose of determining whether the right to be heard has been observed, the reasoning in the communication accompanying the summons to oral proceedings, which was sent after the above mentioned amendment of the independent claims, has to be compared with reasoning in the decision under appeal.

- 1.7 The reasons given in the subsequent written decision of the examining division do not correspond to the cursory

reasoning given in the communication accompanying the original summons to oral proceedings. Whereas the communication indicates a lack of novelty of claim 1 over D2 giving some reasoning, the reasoning given in the decision against claim 1 is lack of inventive step **either** on the basis of D1 together with general knowledge **or** on the basis of D2 together with general knowledge. In the case of claim 9 the communication indicates lack of inventive step in view of D1 and D2 together with general knowledge, without any reasoning despite the fact that the claim contained features from the description on which the examining division had at no point given an opinion. In the decision on the contrary, the ground is lack of novelty in view of D1, this time substantiated with reasons.

- 1.8 The communication accompanying the summons expresses the opinion "that the subject-matter of claims 1 to 13 does at least not involve an inventive step in view of the documents D1 **and** D2, taking into account the common knowledge of the skilled man." Not only can this opinion as expressed in this communication not be considered as sufficiently reasoned - it does not mention which is the closest prior art document; how the teachings of these documents are combined or where the "common knowledge" comes into play - so as to fulfil the requirements of Article 113(1) EPC. It also does not correspond to the reasoning in the decision under appeal. There, each document on its own serves as a basis for an inventive step objection.

An applicant who is faced with a ground of lack of inventive step in view of a particular document is not necessarily in a position to argue the presence of

novelty since that has already been acknowledged by the examining division. On the other hand, an applicant who is faced with a ground of lack of novelty in view of a particular document is not necessarily in a position to argue the presence of an inventive step since it does not know which feature or features the examining division concludes as leading to the presence of novelty and hence to be considered with respect to inventive step.

1.9 The decision of the examining division therefore changes the reasoning against each of the independent claims compared to the one set out in the above-mentioned communication so that the applicant was only informed of the essential reasoning on which the decision is based for the first time in the decision itself, without having had an opportunity to comment as required by Article 113(1) EPC.

1.10 The examining division in its decision "noted" that the fact that the applicant had requested oral proceedings and that these were held meant that it had had the opportunity to present comments in accordance with Article 113(1) EPC before the final decision was issued. This may be true in respect of the reasoned objection raised against the novelty of the subject-matter of claim 1 as given in the communication accompanying the invitation to oral proceedings. It, however, does not hold for an unreasoned objection of lack of inventive step against claims 1 to 13 which is clearly further developed in the oral proceedings considered to have been held at the initiative of the examining division itself (see point 1.4 above) and which is essentially different from what was communicated previously. This

counts all the more for the subject-matter of claim 9 where the unsubstantiated objection for lack of inventive step was substituted by an objection of lack of novelty in the decision under appeal.

The minutes of these proceedings, sent to the applicant on the same date as the decision under appeal state that "after inventive step of the subject-matter of independent claim 1 had been discussed by the members of the examining division, the chairman announced the decision that the patent application is revoked (*sic*), because the subject-matter of claim 1 lacks an inventive step." Nothing is mentioned about the subject-matter of independent claim 9.

It may be noted that had the applicant never requested oral proceedings, the examining division would not have been able to issue a decision immediately upon receipt of the response of the applicant without infringing the right to be heard since it had not communicated to the applicant the essential reasoning for the objections against the amended independent claims.

The Board considers that the holding of the oral proceedings by the examining division in the absence of the applicant does not automatically fulfil the requirements of Article 113(1) EPC. The subsequent refusal of the application based on reasons which were only communicated to the applicant for the first time by the decision means that the right to be heard of the applicant under Article 113(1) EPC has not been respected. This means that the examining division has committed a substantial procedural violation.

2. *Remittal to the First Instance*

2.1 In accordance with Article 111(1) EPC, the Board considers it appropriate to remit the case to the department first instance so as to give the appellant the opportunity in accordance with Article 113(1) EPC to comment on the reasons given in the decision under appeal so as to preserve its right to argue its case before two instances.

3. *Reimbursement of the appeal fee*

3.1 In the view of the Board there has been a substantial procedural violation and the appeal is deemed allowable because of this violation. It is also equitable that the appeal fee should be reimbursed pursuant to Rule 67 EPC.

**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 is to be reimbursed.

The Registrar:

Chairman:

G. Nachtigall

H. Meinders