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DECISION
of 16 February 2006

Case Number: T 1360/05 - 3.4.03
Application Number: 00103168.1
Publication Number: 1030273
IPC: G07F 19/00
Language of the proceedings: EN

Title of invention:

Electronic asset utilization system, electronic asset utilization method, server for use with electronic asset utilization system, and recording medium having recorded thereon electronic asset utilization method

Patentee:

MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.

Opponent:

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Headword:

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Relevant legal provisions:

EPC R. 67, 68(2)

Keyword:

"Decision on the state of the file: reasoned (no)"
"Substantial procedural violation (yes)"
"Reimbursement of appeal fee (yes)"

Decisions cited:

T 0034/90, G 0009/91, T 0278/00, T 0701/01, T 0861/02,
T 0897/03, T 1309/05

Catchword:

A request for a decision on the state of the file is not to be construed as a waiver of the right to a fully reasoned first instance decision; reasons 12.



Case Number: T 1360/05 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 16 February 2006

Appellant: MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.
1006, Oaza Kadoma
Kadoma-shi, Osaka (JP)

Representative: Grünecker, Kinkeldey,
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 June 2005
refusing European application No. 00103168.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. G. O'Connell
Members: E. Wolff
T. Bokor

Summary of Facts and Submissions

- I. This is an appeal from the refusal of European patent application 00 103 168.1.
- II. The relevant first instance file history can be summarised as follows:
- (a) In a first communication issued pursuant to Article 96(2) EPC and dated January 2003 the examining division raised objections under Articles 52(2) and (3), 56, 83 and 84 EPC to which the applicant replied with detailed counterarguments.
 - (b) In a second communication dated 21 December 2004 ("the December communication") and accompanying a summons to oral proceedings scheduled for 15 June 2005 the Article 52(2) and (3) EPC objections were dropped, but the objections under Articles 56 EPC, and under Article 84 in conjunction with Rule 29(2) EPC were maintained and particularised.
 - (c) On 17 May 2005 the applicant filed new claims 1 to 23, including a single independent apparatus claim and a single independent method claim, replacing claims 1 to 53 as originally filed, which had included 13 independent claims. On the basis of supporting arguments he maintained that the amended application could be allowed without oral proceedings ("the May submissions").
 - (d) By letter dated 8 June 2005 the applicant informed the examining division that he would not attend

the oral proceedings and requested a decision "on the status of the file".

- (e) On 10 June 2005 the primary examiner phoned the applicant and informed him that the objections to the originally filed claims applied also to the May submissions.
- (f) On 14 June 2005 the examining division informed the applicant in writing that the oral proceedings had been cancelled and that the procedure would be continued in writing.
- (g) On 17 June 2005 the decision to refuse the application was posted, as was a note of the telephone call of 10 June.

III. The grounds for the decision of the examining division dated 17 June 2005 read in full:

"In the communication(s) dated 15.12.2004, 10.06.2005 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 09.06.2005.

The application must therefore be refused."

IV. The statement of grounds of appeal includes the following statement:

"It was therefore expected to receive a decision of rejection discussing the claims on file. To our surprise, however, we received the decision of rejection of June 17, 2005 with only very short statement on the grounds of decision, referring to the previous Communication of December 15, 2004.

The claims and arguments of May 17, 2005 were not discussed at all although these claims included substantial amendments beyond the previous claims.

This procedure is not considered acceptable and justifies the appeal."

V. The appellant applicant requests that the decision under appeal be set aside and that a patent be granted on the basis of the May submissions. Auxiliarily oral proceedings are requested.

Reasons for the Decision

1. The appeal is admissible.
2. The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision taken by a first instance department (cf *inter alia* T 34/90 (OJ 1992, 454) and G 9/91 (OJ 1993, 408)) at point 18. A reasoned decision issued by the first instance department meeting the requirements of Rule 68(2) EPC is accordingly a

prerequisite for the examination of the appeal pursuant to Article 108 EPC.

3. In the present case the examining division refused the application in response to a request for a decision "on the status of the file". The Guidelines for Examination in the EPO (June 2005) E-X 4.4, state:

"Applicants may request a decision 'on the file as it stands' or 'according to the state of the file', eg when all arguments have been sufficiently put forward (sic) in the proceedings and the applicant is interested in a speedy appealable decision. In such a case, the decision will be of a standard form, simply referring to the previous communication(s) for its grounds and to the request of the applicant for such a decision."

4. If the board is correctly informed, the practice of accepting a request for a so-called decision 'according to the state of the file' was adopted informally in the early days of the EPO from the German Patent Office practice of facilitating applicants who had an interest in obtaining a formal refusal decision for the purposes of the German statute relating to employed inventors - a decision which, albeit appealable, it was not normally intended to appeal. Since then the practice in the EPO has emerged from the shadows and since 1999 has a mention in the guidelines, with the crucial difference that now the aim in view is to draft and dispatch the adverse decision as speedily as possible to facilitate an early appeal.

5. It would perhaps have reduced misunderstanding if this new 'product' had been relabelled as a 'decision by reference'. In the view of this board such a first instance decision by reference is entirely appropriate when the communication incorporated by reference contains a fully reasoned exposition of the examining division's objections to the current application text and refutation of any rebuttal by the applicant. Such a procedure is not only efficient but also effective in making it transparent that the decision is being taken on the agreed text and that nothing is being said in the decision which has not already been communicated to the applicant with an opportunity to present comments, thus guaranteeing compliance with Article 113(1) and (2) EPC.

6. A number of decisions of the EPO Boards of Appeal have pointed out however that a decision form which refers to several communications, leaving it to the board of appeal to construct the applicable reasons by mosaicing various arguments from the file, or which leaves it in doubt which arguments apply to which claim version, does not meet the 'reasoned' requirement of Rule 68(2) EPC; cf T 278/00 (OJ 2003, 546), T 861/02, T 897/03, T 276/04 and T 1309/05. The decision under appeal in T 701/01 also used the standard form for a decision 'according to the state of the file' and the deciding board found that Article 113(2) EPC had not been complied with since the preprinted form text used did not reflect the facts.

7. In the present case it is clear from the statement of grounds of appeal that the applicant's request of June 2005 for a decision "on the status of the file"

was for none of the above, but instead was a waiver of his right under Article 113(1) EPC to an opportunity to present comments on the reasons for a likely refusal, such waiver being in accordance with his expressed intention not to comply with the summons to oral proceedings.

8. Notwithstanding the fact that the guidelines and the standard form text of the decision under appeal sanction reference to previous communication(s) - which in this context has to be understood as reference to communications pursuant to Article 96(2) EPC - the dates inserted by the examining division in the form text of the decision under appeal here are those of the December communication (cf point 9 below) and the telephone call, the note of which was posted with the decision under appeal.
9. No document on file has a date of 15.12.2004; the board assumes that the December communication was meant.
10. According to the preprinted form text the applicant had filed no comments or amendments in reply to the latest communication. The last communication *sensu stricto* was the December communication and the applicant's May submissions manifestly met at least the objection of excessive number of independent claims (see II (c) above). As recorded in the note of 17 June 2005, the telephone call of 10 June, on the other hand, did not address any aspect of the May submissions. Instead, it merely referred, without any apparent attempt at differentiating, to objections that were made against the earlier and significantly different version of the claims.

11. Whether they were examined or not, there is no indication that the May submissions formed the basis for deciding to refuse the application. The decision of the examining division cannot therefore be considered to be a reasoned decision within the meaning of Rule 68(2) EPC, in the sense that it was not reasoned in relation to the subject-matter **on file**, ie the applicant's latest request.

12. The applicant requested a decision on the state of the file. Such a request is not to be construed as a waiver of the right to a fully reasoned first instance decision even in the light of the suggested procedure in the guidelines; cf T 1309/05, point 3.7 of the reasons. Quite apart from the fact that no provision of the guidelines can override an article or rule of the EPC, such as Rule 68(2) (T 861/02, point 5 of the reasons), it is noted that the quoted passage in the guidelines (cf point 3 above) does not discuss in detail the procedure to be followed if such a request is presented when the latest communication precedes the latest submissions, and it is not at all apparent that a decision having the "standard form" as suggested in the guidelines is appropriate or applicable under such circumstances. The term "state of the file" implies that all relevant facts and arguments are already on file - ie that they exist in a written form, as opposed to statements which were presented in oral proceedings. However, the "state of the file" is not restricted to those documents on file which were issued by the EPO, but also includes all those documents which were filed by the applicant prior to (or even simultaneously with) his request for a decision "on the status of the file".

- Therefore, it is clear that the request of the applicant encompassed those claims which were filed with the May communication.
13. In the judgement of the board, neither did any other statement of the applicant imply a waiver of his right to a reasoned decision, and in any case the examining division would have been under no obligation to comply with such a request, even if it contained an explicit waiver. The examining division was in particular not obliged to restrict itself to a decision by reference using the "standard form" when the necessary reasons in relation to the latest filed claims had not been formulated in any document on file. The examining division was however obliged by Rule 68(2) EPC to issue a decision presenting the legal and factual reasons for refusing the application.
 14. The duty to provide reasons in administrative decisions is a fundamental principle in all contracting States, Rule 68(2) EPC being simply an expression of this principle. Further, from the point of view of the practical functioning of the system envisaged in the EPC, absent a reasoned decision within the meaning of Rule 68(2) EPC the board cannot examine the appeal (Article 110 EPC); cf. T 278/00 *supra* point 3 of the reasons.
 15. In accordance with the established jurisprudence of the boards of appeal, the case is remitted to the department of first instance for further prosecution. The appeal is allowed insofar as the decision under appeal is set aside and the appeal fee is reimbursed pursuant to Rule 67 EPC by reason of the substantial

procedural violation constituted by non-compliance with Rule 68(2) EPC. The reimbursement is equitable since the appellant was obliged to file this appeal to obtain a reasoned decision to which he was entitled pursuant to Rule 68(2) EPC and which would have allowed the board to examine the legal and factual reasoning underlying the refusal. It follows also that no purpose would be served by appointing oral proceedings as requested.

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 reimbursed.

Registrar

Chair

D. Meyfarth

R. G. O'Connell