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**Datasheet for the decision  
of 4 December 2007**

**Case Number:** T 1100/06 - 3.2.06

**Application Number:** 99123751.2

**Publication Number:** 1006261

**IPC:** F01D 5/08

**Language of the proceedings:** EN

**Title of invention:**

Gas turbine plant

**Applicant:**

KABUSHIKI KAISHA TOSHIBA

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

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

**Keyword:**

"Decision to grant in form of text approved by applicant (no)"  
"Substantial procedural violation (yes)"  
"Reimbursement of appeal fee (yes)"

**Decisions cited:**

T 0647/93, T 0971/06

**Catchword:**

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Case Number: T 1100/06 - 3.2.06

**DECISION**  
of the Technical Board of Appeal 3.2.06  
of 4 December 2007

**Appellant:**

KABUSHIKI KAISHA TOSHIBA  
72, Horikawa-cho,  
Saiwai-ku  
Kawasaki-shi,  
Kanagawa-ken 210-8572 (JP)

**Representative:**

Kramer - Barske - Schmidtchen  
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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 8 December 2005  
granting a patent on application No. 99123751.2  
pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** P. Alting Van Geusau  
**Members:** G. Pricolo  
K. Garnett

## Summary of Facts and Submissions

- I. The appellant, Kabushiki Kaisha Toshiba, appeals against the decision of the Examining Division dated 8 December 2005 to grant a European patent.
  
- II. On 21 July 2003 the Examining Division issued a communication under Rule 51(4) EPC, informing the appellant of its intention to grant a patent on the basis of the application (No. 99123751.2) with the text and drawings as set out in that communication. The appellant responded on 14 November 2003 with proposed amendments, and requested the grant of a patent in accordance with the enclosed set of claims. Translations were enclosed and the relevant fees paid.
  
- III. On 29 November 2004 a communication under Art. 96(2) EPC was issued by the Examining Division in response to the appellant's request, and in which the Division raised certain objections to the appellant's request.
  
- IV. A telephone conversation between the appellant's representative and the Primary Examiner took place on 2 February 2005, as a result of which the appellant wrote on 23 March 2005 enclosing a new claim 1 which, it was said, corresponded with what had been agreed on the telephone. The letter concluded with a request to grant a patent with claim 1 as enclosed with that letter and with claims 2 to 16, the description and drawings in accordance with the Rule 51(4) communication of 21 July 2003, subject to two minor corrections which were set out. Relevant translations were enclosed.

- V. On 30 November 2005 the Examining Division issued a brief communication referring to the letter of 23 March 2005, stating that the request for amendments had been allowed. This corresponds to internal records generated by the Office on 23 November 2005 in which it is recorded that the applicant had remedied the deficiencies in the application and the grant procedure might continue (Form 2092A, signed by the members of the Division) and where also the documents for grant are set out. These include claim 1 as filed with the letter of 23 March 2005 and take into account the two minor corrections requested in that letter.
- VI. On 8 December 2005 the Examination Division issued a decision in the following terms: "Following examination ... a European patent with the title and the supporting documents indicated in the communication pursuant to Rule 51(4) EPC dated 21.07.03 is hereby granted in respect of the designated Contracting States. The modifications subsequently requested by the applicant and received at the EPO on 18.11.03 have been taken into account."
- VII. On 22 December 2005 the appellant filed a notice of appeal against this decision and paid the appeal fee. The notice of appeal included the grounds of appeal.
- VIII. Mention of the grant of the patent was published in the Official Journal on 18 January 2006.

IX. As a result of a communication issued by the Board on 24 July 2007, the following requests are now made by the appellant:

(a) The decision under appeal be set aside.

(b) A patent be granted on the basis of:

(i) Claim 1 as filed with the letter dated 23 March 2005 and claims 2 to 16 as filed with the letter dated 15 May 2003;

(ii) the description consisting of pages 1, 2, 3, 6, 8, 9, 12, 13, 14, 16, 17, 18, 19 and 20 as originally filed and pages 4, 5, 7, 10, 11, 15, and 21 as amended in accordance with the Communication under Rule 51(4) EPC dated 21 July 2003; and

(iii) drawing sheets 1/12 to 10/12 and 12/12 as originally filed and sheet 11/12 (Fig. 20) as filed with the letter dated 23 March 2005.

(c) The appeal fee be reimbursed.

X. The submission of the appellant is that the decision of the Examining Division did not correspond with the request filed on 23 March 2005 and as indicated as being allowable according to the communication of 30 November 2005.

## Reasons for the Decision

1. The appellant was adversely affected by the decision of the Examining Division: the decision did not correspond to the appellant's request. The appeal is therefore admissible.
2. It follows from paragraphs IV and VI, above, that the decision to grant a patent was made by reference to a version of the text which was no longer agreed by the applicant. Such a decision was a violation of Articles 97(2) and 113(2) EPC and thus should be set aside or cancelled. See T 971/06, paragraphs 2, 7 and 8.
3. Since examination of the claims has been completed and the appellant and the Examination Division have agreed on the documents for grant, an order for the Examination Division to grant a patent in the agreed form can be made.
4. The decision to grant a patent in a form which had not been agreed to by the applicant amounted to substantial procedural violation: T 647/93 (OJ EPO 1995,132), paragraph 2.6.
5. In the circumstances the Board considers it equitable to order reimbursement of the appeal fee.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division with the order to grant a patent on basis of:
  - (a) Claim 1 as filed with the letter dated 23 March 2005 and claims 2 to 16 as filed with the letter dated 15 May 2003;
  - (b) the description consisting of pages 1, 2, 3, 6, 8, 9, 12, 13, 14, 16, 17, 18, 19 and 20 as originally filed and pages 4, 5, 7, 10, 11, 15, and 21 as amended in accordance with the Communication under Rule 51(4) EPC dated 21 July 2003; and
  - (c) drawing sheets 1/12 to 10/12 and 12/12 as originally filed and sheet 11/12 (Fig. 20) as filed with the letter dated 23 March 2005.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:

M. Patin

P. Alting Van Geusau