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**Datasheet for the decision
of 14 August 2008**

Case Number: T 0246/08 - 3.4.03

Application Number: 04737285.9

Publication Number: 1604226

IPC: G01V 1/16

Language of the proceedings: EN

Title of invention:
Coupling aid for seismic cable

Patentee:
Services Pétroliers Schlumberger

Opponent:
-

Headword:
Seismic sensor/SCHLUMBERGER

Relevant legal provisions:
EPC Art. 78(1)(c), 113(1), 113(2), 111(1), 120
EPC R. 137(3), 132(2), 103(a)
RPBA Art. 11

Relevant legal provisions (EPC 1973):
EPC Art. 78(1)(c), 113(1), 113(2), 96(2),
EPC R. 86(3), 67, 84

Keyword:
"Substantial procedural violations (yes)"

Decisions cited:
T 0763/04, T 0872/90, J 0007/82

Catchword:

To safeguard a party's right to be heard pursuant to Article 113(1) EPC a decision must show that all potentially refutative arguments adduced by a party are actually refutable; reasons 2.

A refusal of consent to amend made in advance of any amendment being submitted cannot be a reasonable exercise of discretion pursuant to Rule 137(3) EPC (former Rule 86(3) EPC 1973) and is *ipso facto* a substantial procedural violation; reasons 3.

The substantive legal requirement for the continued presence of claims in an application is expressed in Article 78(1)(c) EPC not in Article 113(2) EPC; reasons 5.



Case Number: T 0246/08 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 14 August 2008

Appellant: Services Pétroliers Schlumberger
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 11 September 2007
refusing European application No. 04737285.9
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. G. O'Connell
Members: V. L. P. Frank
T. Bokor

Summary of Facts and Submissions

I. This is an appeal from the refusal of application 04 737 285 for lack of agreed claims (Article 78(1)(c) EPC 1973).

II. Claim 1 as originally filed reads as follows:

"A coupling device, comprising:

a collar defining an opening therethrough to receive a seismic sensor such that the collar permits rotation about the seismic sensor; and

at least three extensions from the collar, the extensions capable of rotating with the collar such that any two of them may couple to the ground."

In claim 1 in the version not admitted by the examining division pursuant to Rule 86(3) EPC 1973 - and forming the basis of the main request on appeal - the expression "*seismic sensor*" was replaced by "*sensor housing*".

III. The following document is cited in this decision:

D1: WO 02/14905 A

IV. The proceedings before the department of first instance can be summarized as follows:

(a) In a first communication issued pursuant to Article 96(2) EPC 1973 and posted February 2006, the examining division objected that the subject-matter of claim 1 was not new having regard to document D1, as this document disclosed a coupling

device comprising **a collar** (24) defining an opening (25a) therethrough to receive a seismic sensor (3) such that the collar permitted rotation about the seismic sensor and at least three extensions from the collar, the extensions capable of rotating with the collar such that any two of them may couple to the ground (figure 5b and page 16).

- (b) By letter of June 2006 the applicant responded that claim 1 had been amended to specify that the collar had *"a dimension parallel to an axial direction of the seismic sensor that is smaller than a corresponding dimension of the seismic sensor parallel to the axial direction"*. It was further pointed out that the base disclosed in D1, which was equated by the examining division to the collar of the present invention, had a maximum extent (d_1) in the direction parallel to the seismic cable which was substantially equal to the maximum extent (d_2) in a direction perpendicular to the cable. Moreover, the sensor was deployed within the base, and the in-line dimension of the base was equal to or larger than the length of the sensor housing. It was therefore submitted that D1 did not disclose or suggest a collar having an extension in the axial direction of the sensor that was smaller than the axial extension of the sensor (figures 1a to 1e; page 7). In the same letter the applicant indicated their preference for prosecuting the application in writing, nevertheless requesting oral proceedings as a "precautionary measure".

- (c) In a second communication of July 2006, the examining division objected that the amendment to claim 1 introduced added subject-matter (Article 123(2) EPC 1973), since the so amended claim would also embrace eg a structure with a collar located at the centre position of the sensor, something that was not supported by figures 3A or 3B. It was declared that the next action would be a summons to oral proceedings.
- (d) The applicant argued in their response of November 2006 that the amendment to claim 1 was nothing more than a declaratory amendment that clarified the meaning of the term "collar", since the term "collar" generally referred to a structure having the form of a band or ring, with relatively limited extent in the axial direction. The amendment did therefore not alter the scope of claim 1 and the added feature was clearly disclosed in figures 3A and 3B of the application. It was further argued that the structure mentioned by the examining division, ie a collar at the centre position of the sensor, was already covered by claim 1 as originally filed which did not specify any position of the collar.
- (e) Oral proceedings were appointed for 12 June 2007 by summons issued February 2007. In the annex to the summons the examining division objected that the *coupling device* of claim 1 was not clear (Article 84 EPC 1973), since it was defined by a second entity, namely the *seismic sensor*, which was not part of the invention and maintained their objection of added subject-matter.

- (f) In their response of May 2007 the applicant stated that in claim 1 the expression *seismic sensor* had now been replaced by *sensor housing*, argued that the device of claim 1 was clear, as the Guidelines for Examination (C-III 4.8a) allowed reference to a second entity which although not part of the claimed first entity was related to it through use and reiterated their arguments against the objection of added subject-matter. 1st to 5th auxiliary requests were filed with this response.
- (g) On 5 June 2007, the applicant was informed by fax that the preliminary opinion of the examining division was that the claims of the main and 1st to 4th auxiliary requests did not fulfil the requirements of the EPC. It was further announced that "*According to Rule 86(3) EPC no consent of the Examining Division for further amendments in preparation for these oral proceedings is given*".
- (h) By fax of 6 June 2007 the applicant pointed out that their request included a 5th auxiliary request formed by claims 1 to 13 of the 4th auxiliary request.
- (i) On 11 June 2007 the applicant's representative advised the first examiner by phone that they would not attend the oral proceedings scheduled for 12 June 2007.
- (j) The oral proceedings took place in the foreshadowed absence of the applicant's representative. The main and 1st to 5th auxiliary

requests were discussed and found not to fulfil the requirements of the EPC. With respect to the objection of added subject-matter, the minutes presented as an example of what was covered by amended claim 1 of the main request "*a configuration with a collar having an axial dimension which amounts to more than one half of the axial dimension of the sensor housing*". It was formally declared that the proceedings would be continued in writing; that one further opportunity would be given to the applicant to submit arguments in support of their point of view with regard to these requests; that a decision would be taken in the light of their arguments and that pursuant to Rule 86(3) EPC 1973 no consent of the examining division was given for further amendments.

- (k) A communication issued pursuant to Article 96(2) EPC 1973 and posted 18 June 2007, invited the applicant to file observations and to correct the deficiencies, insofar as they were rectifiable, within **a period of 1 month** from the notification of the communication. It was stated that failure to comply with the invitation in due time would result in the application being deemed to be withdrawn (Article 96(3) EPC 1973). The communication summarized the results of the oral proceedings and gave the applicant one further opportunity to submit arguments. It was also confirmed that pursuant to Rule 86(3) EPC 1973 the examining division did not consent to further amendments.

- (1) On 19 July 2007 the applicant sent an amended main claim request in which the feature defining the relation between the axial dimensions of the collar and the sensor housing was deleted from claim 1. This was done in response to the objection of added subject-matter raised by the examining division in the minutes of the oral proceedings, which was based on the example of a collar extending for more than half of the axial length of the sensor housing. It was pointed out that this objection had been raised for the first time during the oral proceedings (according to the minutes) and had not been raised in the summons to oral proceedings or in the preceding communications. The applicant considered that they were entitled, therefore, to amend claim 1 of the main request in response to this new objection.

With respect to the main request, the applicant argued that, as already explained in their letter of November 2006 (referred to at (d) above), the term *collar* referred to a structure having the form of a band or ring. They further presented as examples the definitions of *collar* of the American Heritage Dictionary, which *inter alia* defined a *collar* (definition 5) as "*any of various ring-like devices used to limit, guide or secure a machine part*". It was again argued that D1 disclosed a base having an axial extension substantially equal to its transverse extension and that D1 did not, therefore, disclose or suggest a collar. The teaching of D1 taught away from the use of a collar.

- (m) The decision under appeal found that amended claim 1 of the main request was not admissible (grounds for the decision, II.1), since the applicant had been advised in the communication of 18 June 2007 (see point (k) above) that pursuant to Rule 86(3) EPC 1973 no consent for further amendments was given. Since the applicant nevertheless submitted an amended main claim request, the application lacked a valid set of claims for the main request as required by Article 78(1) EPC 1973 (grounds, II.1.1)(see reasons, point 5 below.).

In a supplementary reasoning the examining division went on to find that in substance the amended claim 1 corresponded to original claim 1 with the phrase "*seismic sensor*" being replaced by "*seismic sensor housing*" (sic) (this phrase was in fact replaced by "*sensor housing*"). Reference was made to the communication of 17 February 2006 (point (a) above) in which an objection of lack of novelty with regard to document D1 had already been raised against such a claim. It was stated again that figure 5b of D1 clearly showed a sensor housing which was rotatably engaged with a collar having extensions. The subject-matter of claim 1 was therefore not new (grounds, II.1.2).

The examining division concluded therefore that "*Taking these two points into consideration - Art. 86(3) and Art. 54 EPC as already discussed in the first letter of 17-02-2006 - the amended Main request is not admissible.*".

The five auxiliary requests were subsequently discussed and found not to be allowable.

- V. In the statement of grounds of appeal the appellant applicant alleged that a substantial procedural violation had occurred, arguing essentially as follows:

Article 113(1) EPC provided that decisions of the European Patent Office be based only on grounds or evidence on which the parties have had an opportunity to present their comments. Article 113(1) EPC was not a formal provision but one of substance and "*...requires not merely that a party be given an opportunity to voice comments, but more importantly it requires that the deciding instance demonstrably hears and considers these comments*" (T 0763/04, reasons 4.4). In the present case, detailed arguments as to the meaning of the terms *collar* and *ring collar* were filed with the letter of 19 July 2007. Although the interpretation of the term *collar* or *ring collar* was clearly an important point for assessing patentability of this application over the prior art, there was no indication in the appealed decision that the examining division had considered the arguments as to the meanings of a *collar* or *ring collar*. It was accordingly submitted that the failure of the examining division demonstrably to hear and consider the submissions filed with the letter of 19 July 2007 represented a substantial procedural violation according to the reasoning set out in decision T 0763/04.

Arguments on the patentability of the main and 1st to 5th auxiliary requests were also presented.

VI. The appellant applicant was advised by telephone in March 2008 that the board was minded to remit the case to the department of first instance for further prosecution and to order the refund of the appeal fee, as fundamental deficiencies were apparent (Article 11 RPBA and Rule 103 EPC).

The representative withdrew their request for oral proceedings.

VII. The appellant applicant requests that the decision under appeal be set aside and that a patent be granted on the basis of a main or 1st to 5th auxiliary requests refiled with the statement of grounds of appeal. They further request reimbursement of the appeal fee.

Reasons for the Decision

1. The appeal is admissible.

2. *Right to be heard (Article 113(1) EPC 1973)*

2.1 Article 113(1) EPC 1973 reads:

"The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments"

2.2 Established jurisprudence has interpreted this provision to mean that the comments presented must be considered in the ensuing decision (J 7/82 OJ EPO 1982, 391). Thus a decision which fails to take explicitly into account potentially refutative arguments submitted by a party, ie arguments which may militate against or cast doubt on the decision in question, contravenes Article 113(1) EPC 1973, thereby constituting a substantial procedural violation. In brief, a decision must show that all potentially refutative arguments adduced by a party are actually refutable.

2.3 The examining division objected in a first communication (February 2006)(summarized under point IV.(a) above) that the coupling device of claim 1 was not new, as document D1 disclosed a coupling device comprising **a collar** (24) defining an opening (25a) therethrough to receive a seismic sensor (3) such that the collar permitted rotation about the seismic sensor and at least three extensions from the collar, the extensions capable of rotating with the collar such that any two of them may couple to the ground (fig. 5b and page 16).

2.4 In response (June 2006) the applicant argued that the base member 24 in D1, which the examining division equated to the collar of the present application, was not a collar, but had an extension in the axial direction that was comparable to the extension in the transverse direction. A collar, however, had generally the form of a band or ring, with relatively limited extent in the axial direction. The applicant subsequently (July 2007) submitted evidence in the form of a dictionary definition of *collar* stating that the

- latter was *"any of various ring-like devices used to limit, guide or secure a machine part"* (see points IV.(b), (d) and (l) above).
- 2.5 The examining division did not refute these arguments, contest the dictionary evidence or explain why in their view the base member disclosed in document D1 could be considered a collar, either in the communications sent to the applicant or in the decision under appeal. The latter merely contains the assertion that, as already stated in the first communication, document D1 *"clearly shows"* the features of the device of claim 1 of the main request.
- 2.6 There is thus no evidence in the decision that the examining division took the applicant's evidence and arguments into consideration. As stated in T 763/04 *"it is not sufficient to observe Article 113(1) merely formally by granting the Applicant the **procedural** possibility for presenting comments, as this was the case here. This procedural step falls short of its legislative purpose and remains a pure formality, if there is no trace in the file that such comments were indeed read and discussed on the merits, beyond a mere acknowledgement of their existence. In summary, Article 113(1) requires not merely that a party be given an opportunity to voice comments, but more importantly it requires that the deciding instance demonstrably hears and considers these comments."* (reasons, 4.4)
- 2.7 The board judges therefore that the failure to take into due account a potentially refutative argument of the applicant when deciding the case deprived the

applicant of their right to be heard in contravention of Article 113(1) EPC 1973 and amounts to a substantial procedural violation.

3. *Application of Rule 137(3) EPC (former Rule 86(3) EPC 1973)*

3.1 The examining division declared in the fax of 5 June 2007 (IV.(g)) that no consent was given to further amendments under Rule 86(3) EPC 1973. A similar declaration, stating that no further amendments were consented to, was reiterated in the minutes of the oral proceedings and in the subsequent communication of 18 June 2007, although the minutes contained a new argument as to why claim 1 did not fulfil Article 123(2) EPC 1973 (see point IV.(j)above).

3.2 It is the established jurisprudence of the boards of appeal that the power of the examining division to consent to amendments under Rule 137(3) EPC is a discretionary power that has to be exercised after considering all the relevant factors of the specific case and balance in particular the applicant's interest in obtaining an adequate protection for his invention and the EPO's interest in bringing the examination to a close in an effective and speedy way. Moreover, the exercise of a discretionary power has to be reasoned, otherwise it would be arbitrary. Thus, in T 872/90 the then deciding board held that neither the remark "*the applicant has already once amended the claim*" nor a reference to Rule 86(3) EPC 1973 could be considered as reasoning, because such statements solely constituted a reference to the power given to the examining division by the above rule.

3.3 It follows that a refusal of consent to amend made in advance of any amendment being submitted cannot be a reasonable exercise of discretion pursuant to Rule 137(3) EPC. Indeed in the judgement of the board it is *ipso facto* a substantial procedural violation since it risks deterring an applicant from making an amendment which could not reasonably have been forbidden. There is a world of difference between a preemptive **formal declaration** that no amendments will be admitted and **advising** the applicant that a discretionary power to permit or refuse amendment exists and will be exercised in the event that amendments are submitted.

3.4 As set out in detail at point IV(1) above, the applicant amended claim 1 of the main request in response to a new objection, insisting that they had the right to do so. The examining division gave two reasons for finding the amended claim request inadmissible (see point IV(m) above). The first reason merely invoking its earlier preemptive declaration constituted a further substantial procedural violation for the reasons explained at point 3.2 above. The second reason based on the fact that the amended claim 1 returned in substance to claim 1 as originally filed, and to which the original objection of lack of novelty still applied, would have been *per se* procedurally in order were it not for the fact that it failed fully to address the applicant's responses of November 2006 and July 2007 in particular on the meaning of the word *collar*. To that extent this second reason was also tainted by a substantial procedural violation.

4. *Time limit of a communication sent under Article 96(2) EPC 1973*
- 4.1 The communication under Article 96(2) EPC 1973 of 18 June 2007 (IV.(k)) was sent with a time limit of **one month**.
- 4.2 Article 120 EPC states that the Implementing Regulations shall specify *inter alia* the time limits which are to be observed in proceedings before the EPO and are not fixed by the Convention. Pursuant to this article Rule 132(2) EPC (former Rule 84 EPC 1973) stipulates that, unless otherwise provided, **a period specified by the EPO shall be neither less than two months nor more than four months**. Although, in some circumstances, this period may be extended, it may not be shortened.
- 4.3 The sending of a communication setting a time limit of only one month, and stipulating that failure to respond in due time would result in the application being deemed withdrawn (Article 96(3) EPC 1973), amounted to a further substantial procedural violation, since it deprived the applicant of their right to the conventional minimum period of two months to prepare and submit their response.
5. *The refusal ground for the main request*
- 5.1 The decision under appeal specified the legal ground for refusing the main request as "*the application is lacking a valid set of claims for the Main Request as required by Article 78(1) EPC.*".

5.2 The board notes that the Guidelines for Examination indicate Article 113(2) EPC 1973 as the legal basis for refusing an application in the circumstances of the present case, ie in which there exists no agreed claim text (C-VI.4.9, 5th paragraph, version December 2007).

5.3 The board prefers the approach of the examining division for the reason that Article 78(1)(c) EPC 1973 is a requirement of the application not only for according a filing date, but also for substantive examination and grant (Singer/Stauder EPC 3rd ed Art 78 @ 6) and Benkard EPÜ Art 78 2nd paragraph) whereas Article 113(2) EPC 1973 is silent as to the legal consequence of the absence of an agreed text.

5.4 Although an examining division should normally apply the guidelines, failure to do so is neither a mistake in law nor a procedural violation. For the reasons given above, in this particular instance the board sees the deviation as a matter for approval rather than reproach.

6. *What could have been done procedurally*

6.1 It is at first sight odd that a contravention of Article 113(1) EPC 1973 could have occurred in this case, considering the several communications from the examining division and the non-appearance of the applicant at oral proceedings appointed at the latter's request. However, the occurrence of a substantial procedural violation is an objective fact that may arise even with the best intentions of the persons concerned. As shown by this case, an applicant is not helped even by several communications if their

potentially refutative argument is not dealt with in any of them and not even in the refusal. Given that the examining division decided, for whatever reasons, that the applicant would be given a further opportunity to comment on the possible grounds of refusal the latter could expect that the opportunity to comment pursuant to Article 113(1) EPC 1973 was not a mere formality, but a genuine opportunity to voice their arguments **and have them heard**. Otherwise the invitation to submit further arguments would be nugatory.

6.2 Admittedly, the non-appearance of the applicant did not make the application of Rule 86(3) EPC 1973 easier, and the board recognises that the guidelines do not offer clear instructions for this situation. It is not for the board to pinpoint the exact moment when things went wrong or to prescribe the correct procedure for applying Rule 86(3) EPC 1973 in this specific case. That said, in retrospect it appears to the board that things could have been put right procedurally even at a late stage of the proceedings, practically at any time before the issuance of the refusal decision. A discussion of the meaning of "collar" could have been included in any of the communications or at least in the refusing decision. The application of Rule 86(3) EPC 1973 in the decision could also have been defended, simply by justifying its application with the substance of point II.I.2 of the refusing decision, instead of relying on the mere existence of this rule and the discretionary power of the examining division based on this rule.

6.3 The two procedural violations referred above under points 3 and 4 could have been remedied afterwards

respectively by informing the applicant that their amendments would be considered, but that the discretionary power of the examining division would be exercised and by sending a further communication with a new, correct time limit of at least two months.

- 6.4 For the avoidance of doubt the board emphasises that the above considerations relate solely to the procedural aspects of this case. In view of the order below the board refrains from commenting on the substantive issues.

7. Having regard to the substantial procedural violations identified above and the fact that inter alia the applicant was obliged to file this appeal to ensure a hearing of potentially refutative arguments reimbursement of the appeal fee is equitable (Rule 67 EPC 1973).

8. Pursuant to Article 111(1) EPC 1973 and 11 RPBA 2007 it is appropriate that the case be remitted to the department of first instance for further prosecution absent special reasons for doing otherwise.

9. It is noted that the applicant has no right to further oral proceedings before the examining division on the same issues (Article 116(1) EPC 1973, second sentence).

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

S. Sánchez Chiquero

R. G. O'Connell