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**Datasheet for the decision  
of 26 January 2012**

**Case Number:** T 0645/11 - 3.5.01  
**Application Number:** 01912343.9  
**Publication Number:** 1199892  
**IPC:** G06F 17/30, G11B 20/10,  
H04N 5/93, G11B 27/30  
**Language of the proceedings:** EN

**Title of invention:**

Device and method for reproducing image and voice

**Applicant:**

Panasonic Corporation

**Headword:**

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**Relevant legal provisions (EPC 1973):**

EPC Art. 84, 113(1)  
EPC R. 29(2), 67, 111(2)

**Keyword:**

"Substantial procedural violation - yes"  
"Remittal to the department of first instance - yes"  
"Reimbursement of the appeal fee - yes"

**Decisions cited:**

J 0020/85, J 0003/90, T 0669/90, T 0892/92, T 0763/04,  
T 0246/08

**Catchword:**

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Case Number: T 0645/11 - 3.5.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.01  
of 26 January 2012

**Appellant:**  
(Applicant)

Panasonic Corporation  
1006, Oaza Kadoma  
Kadoma-shi  
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**Representative:**

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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted 4 November 2010  
refusing European patent application  
No. 01912343.9 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** S. Wibergh  
**Members:** P. Scriven  
G. Weiss

## Summary of Facts and Submissions

- I. The appeal is against the Examining Division's decision to refuse the European patent application 01912343.9.
- II. The Examining Division sent a first communication, on 30 May 2007, in which it raised objections under Rule 29(2), Article 84, and Article 56 EPC 1973.
- III. With the letter of reply, dated 2 October 2007, the applicant filed a new set of claims. The number of independent claims was reduced from six to four, and the phrases to which the Examining Division had objected had been modified. In the letter, the applicant presented arguments regarding clarity and inventive step.
- IV. The Examining Division refused the application, in a decision dated 4 November 2010.
- V. The appellant appealed that decision. In the statement setting out the grounds of appeal, it made the following requests.
  - (a) That the decision to refuse the application be set aside.
  - (b) That the appeal fee be reimbursed.
  - (c) That a patent be granted on the basis of claims 1 to 26, submitted together with the statement of grounds.

- (d) That oral proceedings be held if the Board intends to uphold the Examining Division's decision.

VI. The appellant argued as follows.

- (a) While it is possible to refuse an application after a single communication, it was not clear why that was done in this case, especially in consideration of the long delay between the applicant's reply and the decision.
- (b) The objections formulated in the first communication were under EPC 1973, those in the refusal under EPC 2000. It had not been possible to take account of the new provisions.
- (c) The objections on which the refusal is based are not the same as those presented in the first communication.
- (d) The objection under Rule 43(2) EPC was incorrect, because exception (c) applied.
- (e) The objection under Article 84 EPC was incorrect, because the case law allows the description to be used to interpret the claims.
- (f) The terms to which the Examining Division had objected had all been amended, and the first communication had not raised any objection to the term *group*.
- (g) In the first communication, the Examining Division had set out its objection regarding inventive step

with regard to claim 1, which defined an apparatus for generating a control file. The refusal objected to claim 4, which defined an apparatus for reproducing a data file.

- (h) In addition, the objection was based on ignoring unclear features and, since the situation regarding clarity had changed, so had that regarding inventive step. The applicant had, therefore, not had an opportunity of presenting comments regarding claim 4.

## **Reasons for the Decision**

1. Article 113(1) EPC 1973, the right to be heard
  - 1.1. A European patent application may only be refused based on grounds or evidence on which the applicant has had an opportunity of presenting its comments (Article 113(1) EPC 1973). This provision guarantees that proceedings before the EPO will be conducted openly and fairly (cf. J 20/85, OJ EPO 1987, 102, point 4(a) of the reasons; J 3/90, OJ EPO 1991, 550).
  - 1.2. The right to be heard ensures that the parties to proceedings are not taken by surprise by grounds mentioned in an adverse decision (cf. decisions T 669/90, OJ EPO 1992, 739 and T 892/92, OJ EPO 1994, 664, for example). That requires, firstly, that a party be given an opportunity to comment on the grounds and evidence alleged against it. In particular, it means that if a decision to refuse is taken on the basis of grounds which have not previously been presented to the

applicant, then the decision does not comply with the provisions of Article 113(1) EPC 1973. In such a presentation, it is not sufficient that the applicant be presented with an assertion that the application fails to comply with some provision of the EPC. There must also be an explanation of why it fails to comply.

- 1.3. The right to be heard also requires the deciding instance demonstrably to hear and consider any relevant comments (T 763/04, Reasons 4.4 or T 246/08, Reasons 2.6, neither published in the OJ EPO). Therefore, if an applicant has made arguments which bear upon the clarity of terminology used in the claims (an example with a particular relevance to the present case), and the Examining Division refuses the application, citing a lack of clarity in that terminology, then they must explain why the applicant's arguments have been rejected. If an explanation is not given, the applicant's right to be heard has been infringed.

2 Article 84 EPC 1973, clarity of the term *group*.

- 2.1. The refusal, at point II 2, noted that amendments had been made which aimed at clarifying the claims; but the refusal went on to state that the amendments were insufficient, because *the "groups" have not been defined before and it is not clear what the groups comprise, what the plurality of groups comprises and what the effects of these groups are*. The application was refused because of this lack of clarity.

- 2.2. The Examining Division, in its first communication, dealt with clarity issues under point 3. It objected specifically to three phrases:

- *sequentially described in at least one group,*
- *a plurality of groups having the same group identifier,*
- *do not exist in the same automatic reproduction control file.*

The Board considers that the applicant would have understood those phrases to be objectionable, but not that the term *group* on its own was.

- 2.3. As part of the discussion of inventive step, at point 4 in the communication, the Examining Division referred to the *completely obscure definition of "groups" and the "plurality of groups" which "do not exist"*. The Board considers that the applicant would have understood that as a reference to the clarity objection under point 3. Certainly, there was no reasoning as to why the term *group* on its own was unclear. Nor can the Board see anything about what the groups comprised, what the plurality of groups comprised, or what their effects were.
- 2.4. The objection to the clarity of *groups*, therefore, had not been presented to the applicant before the decision was taken, and the Board judges that the decision failed to comply with Article 113(1) EPC, as set out above at 1.2.
- 2.5. The applicant responded to the first communication by filing amendments and arguments. The amendments addressed each of the three phrases to which the Examining Division had explicitly objected, and the arguments sought to show that the amended phrases were

clear.

2.6. The Board can not find any reasons, in the Examining Division's decision, which address the applicant's arguments on clarity. Although the Examining Division presented a new objection in its decision, the applicant's arguments were nevertheless relevant; at least, they seem so at first sight. Thus, if, as seems to be the case, the Examining Division found the arguments unconvincing, they should have given reasons. The Board finds that the failure to do so was a second failure with regard to Article 113(1) EPC 1973, as set out at 1.3.

2.7. Claim 1, in the form underlying the refusal, had this formulation:

*... in the automatic reproduction control file, file designating information ... is provided in a sequence of reproduction for each data file in at least one group.*

2.8. That seems to say, straightforwardly, that the groups consist of data files: there are groups of data files, and for each data file in at least one of those groups, file designating information is provided in a particular order.

2.9. The Board, therefore, cannot follow the Examining Division's assertions that the groups have not been defined, that it is unclear of what they consist, and of what the plurality of groups consists. The groups seem to be defined as collections of data files, and therefore to consist of data files. The plurality of



groups seems to consist of groups.

- 2.10. The Examining Division may well have had reason to believe that the apparently straightforward interpretation is not available, or does not accord with the description, or is deficient in some other way. If that is so, the refusal does not explain it. That would mean the refusal failed to comply with Rule 111(2) EPC. Thus, in addition to the failure to allow the applicant an opportunity to comment, and to the failure to take apparently relevant comments into account, the refusal is either wrong about the clarity of the term "group", or else lacks sufficient reasoning.

3 Rule 29(2) EPC 1973

- 3.1. According to Article 2 of the Decision of the Administrative Council of 7 December 2006, amending the Implementing Regulations to the EPC 2000 the *Implementing Regulations to the EPC 2000 shall apply to all European patent applications, . . . ., in so far as the forgoing are subject to the provisions of the EPC 2000*. Rule 43 EPC 2000 specifies the content and form of the claims of a European patent application referred to in Articles 78 and 84 EPC 2000.

- 3.2. Neither Article 78 EPC 2000, nor Article 84 EPC 2000, is mentioned in Article 1 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000. Thus neither applies to European patent applications pending at the time of its entry into

force of the EPC 2000 (13 December 2007).

- 3.3. The present application was filed before 13 December 2007. Therefore, neither Article 78 nor 84 EPC 2000 is applicable, and it follows that Rule 43(2) EPC 2000 is not applicable either. It is Rule 29(2) EPC 1973 that applies in the present case.
- 3.4. Nevertheless, since Rule 29(2) EPC 1973 and Rule 43(2) EPC 2000 set out the same requirements, the Board can see no merit in the appellant's argument that it had not been able to take account of the new provisions.
- 3.5. The first set of claims considered by the Examining Division was submitted with the letter dated 6 September 2006. There were seven claims, of which claims 1 and 2 were directed to an *apparatus for generating an automatic reproduction control file*, claim 4 to a *method for generating an automatic reproduction control file*, claims 5 and 6 to an *apparatus for reproducing a data file*, and claim 7 to a *method for reproducing a data file*.
- 3.6. In their first communication, the Examining Division, in point 2, objected as follows.

*Claims 1, 2, 5, 6 and 4, 7 have been drafted as separate independent claims in the same category, respectively.*

*Under Article 84 in combination with Rule 29(2) EPC an application may contain more than one independent claim in a particular category only if the subject matter claimed falls within one or more of the exceptional situations set out in paragraphs (a),(b) or (c) of Rule*

*29(2) EPC. This is not the case in the present application however.*

*The applicant is requested to file an amended set of claims which complies with Rule 29(2). Failure to do so, or to submit convincing arguments as to why this current set of claims does in fact comply with these provisions, will lead to refusal of the application under Article 97(1) EPC.*

3.7. The applicant's response to this objection was to delete claims 2 and 6. That left four independent claims, directed to methods and apparatuses for *generating an automatic reproduction control file and for reproducing a data file.*

3.8. The refusal, at II 1 states the following:

*Claims 1, 4 and 3, 5 have been drafted as separate independent claims, wherein 1, 4 and 3, 5 are in the same category, respectively. The applicant gave no reasons why more than one claims [sic] in the same category are provided. The subject-matter of the independent claims in a particular category does not fall within one or more of the exceptional situations set out in paragraphs (a), (b) or (c) of Rule 43(2) EPC.*

3.9. Neither the Examining Division's first communication, nor its decision, explains why none of the exceptions listed in Rule 29(2) EPC 1973 applies. From the first communication, the applicant should have understood that the Examining Division considered the number of independent claims unjustified, because none of the exceptions applied. It could not, however, learn why they had formed that opinion. Nor could the applicant

have learnt that from the decision.

- 3.10. The situation, then, is that set out above at 1.2, and the Board judges that the refusal does not comply with Article 113(1) EPC 1973.

4 Reimbursement of the appeal fee

- 4.1. According to Rule 67 EPC 1973, reimbursement of the appeal fee *shall be ordered ... where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.*

- 4.2. In the present case, the Board does allow the appeal.

- 4.3. Depriving the applicant of its right to be heard constitutes a substantial procedural violation.

- 4.4. If the Examining Division had not committed the procedural violations, the appellant would not have been forced to file an appeal in order to pursue its application. The Board, therefore, considers reimbursement to be equitable.

5 Remittal to the department of first instance

- 5.1. Article 11 of the Rules of Procedure of the Boards of Appeal of the EPO (RPBA, OJ EPO 2007, 536) stipulates that a Board *shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise.* The Board considers that a failure to respect the

applicant's right to be heard is a fundamental deficiency, and can see no special reasons for doing other than remitting the case.

6 The request for oral proceedings

6.1. The appellant requested oral proceedings if the board *intends maintaining the decision of the examining division*. The Board does not so intend, and so it is not necessary to hold oral proceedings before taking a decision.

## 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:

The Chairman:

T. Buschek

S. Wibergh