

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [X] To Chairmen
- (D) [-] No distribution

**Datasheet for the decision
of 4 May 2012**

Case Number: T 1326/11 - 3.3.10

Application Number: 07005677.5

Publication Number: 1806153

IPC: A61L15/18

Language of the proceedings: EN

Title of invention:

Absorbing agent composition, absorbent material, and absorbent product containing absorbent material

Applicant:

NIPPON SHOKUBAI CO., LTD.

Headword:

Relevant legal provisions:

EPC R. 137(3) (2010)
EPC Art. 113(2)

Keyword:

Correct exercise of discretion by the examining division under Rule 137(3) EPC.

Decisions cited:

T 1064/04, G 0007/93

Catchword:



Case Number: T1326/11 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 4 May 2012

Appellant: NIPPON SHOKUBAI CO., LTD.
(Applicant) 1-1, Koraibashi 4-chome
Chuo-ku
Osaka-shi, Osaka 541 (JAPON)

Representative: Müller - Hoffmann & Partner
Patentanwälte
Innere Wiener Strasse 17
81667 München (ALLEMAGNE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted 24 January 2011
refusing European patent application No.
07005677.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: P. Gryczka
Members: R. Pérez Carlón
D. Rogers

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the examining division to refuse European patent application No. 07005677.5.
- II. The examining division, pursuant to Rule 137(3) EPC, did not admit into the proceedings a request filed under cover of a letter dated 11 March 2010 and received after a communication under Rule 71(3) EPC informing the applicant of the text in which it was intended to grant a patent. Thus there was no agreed text (Article 113(2) EPC) and the application had to be refused under Article 97(2) EPC.
- III. The applicant appealed this decision and requested that a patent be granted upon the basis of claims 1-7 filed with the grounds of appeal, identical to those filed under cover of a letter dated 11 March 2010 not admitted into the proceedings by the examining division.
- IV. In its summons, the board informed the appellant that the sole issue to be discussed during the oral proceedings was whether the examining division properly made use of its discretion under Rule 137(3) EPC by not admitting the request filed under cover of a letter dated 11 March 2010.
- V. The examining division explained in its decision that the applicant had already had sufficient opportunity to amend its case and sufficient time to prepare for the oral proceedings. At the end of said oral proceedings, the examining division had announced that it intended to grant a patent on the basis of the sole request then on file. The later set of claims received under cover

of a letter dated 11 March 2010 and after a communication under Rule 71(3) EPC, omitted a feature which had been added in order to overcome objections under Articles 83 and 54 EPC; the amendments proposed were, hence, substantive amendments which called into question the outcome of the earlier procedure. The conditions for accepting late amendments defined in the decision G 7/93 were, therefore, not met. The examining division took into account both the right of the applicant to a valid patent and the interest of the EPO in bringing the examination to a close, and decided not to admit into the proceedings the set of claims at issue.

- VI. The appellant argued that the examining division was not precluded from reopening examination proceedings up to the moment at which the decision was handed over to the internal postal service, and cited the Guidelines for Examination in the EPO, C-VI, 14.4.

The appellant argued that the discretion of the examining division should be exercised taking into consideration all relevant factors, including the right of the applicant to a patent with the broadest possible scope.

The application related to a complex invention, which justified an exception. Since the applicant could not file further divisional applications, these broader claims filed after the communication under Rule 71(3) EPC were its sole possibility to obtain the scope of protection commensurate to the invention.

- VII. Oral proceedings before the board were held on 4 May 2012.

The appellant confirmed its requests on file, namely that the decision be set aside and the case be remitted to the examining division for further prosecution upon the basis of claims 1-7 as filed under cover of a letter dated 11 March 2010 before the examining division.

VIII. At the end of the oral proceedings the decision of the board was announced.

Reasons for the Decision

1. Although the admissibility of the appeal is questionable since the statement of the grounds for appeal does not challenge the reasons for refusing the application given in the decision under appeal, it is not necessary to decide on this issue since the appeal is not allowable.
2. The decision under appeal deals solely with the refusal under Rule 137(3) EPC of the examining division to admit into the proceedings the request received after issuance of the communication under Rule 71(3) EPC. Thus, the question to be decided on this appeal is whether this refusal is an appropriate exercise of the discretion given to the examining division under Rule 137(3) EPC.
3. Guidance on the principles to be applied can be derived from the Enlarged Board of Appeal decision G 7/93 (OJ EPO 1994, 775), as summarised in decision T 1064/04 (not published in OJ EPO):
 - (a) Until the issue of a decision to grant the patent, the examining division has a discretion under Rule 137(3) EPC whether or not to allow the amendment

of the application at a late stage (G 7/93, point 2.1).

- (b) The examining division is required to exercise its discretion considering all relevant factors, in particular the applicant's interest in obtaining a patent which is valid in all designated states, and the EPO's interest in bringing examination to a close, and must balance these against one another (G 7/93, points 2.2 and 2.3).
- (c) Allowing a request for amendment at a late stage of the examination proceedings during which the applicant has already had at least one opportunity to amend the application, and after the examining division has already completed substantive examination thereof, will be an exception and not the rule (G 7/93, point 2.3).
- (d) It is not the function of a board of appeal to review all the facts of the case as if it were in the place of the first instance department in order to decide whether or not it would have exercised the discretion in the same way. Rather, a board of appeal should only overrule a first instance exercise of discretion if it comes to the conclusion either that the first instance department has not exercised its discretion correctly as set out in (b) above, or has exercised its discretion in an unreasonable way, and thus exceeded the proper limits of its discretion (G 7/93, point 2.6).

- 4. In the present case, the proceedings before the examining division involved two communications according to Article 94(3) EPC, after each of which the

applicant filed amended claims, a detailed summons to attend oral proceedings, in response to which new claims were presented to the examining division, and oral proceedings before it, during which two sets of amended claims had been filed. At the end of the oral proceedings which took place on 29 September 2009, the examining division intended to grant a patent on the basis of claims 1-12 of the sole request then pending and an adapted description thereof. This was confirmed in a communication under Rule 71(3) EPC dated 23 November 2009. From this sequence of events, the board concludes that the applicant had several opportunities to amend the application and it did so, and that the substantive examination had been completed by the examining division.

5. The purpose of oral proceedings should be to settle as far as possible all outstanding questions relevant to the decision. A late stage of the examination proceedings had thus been reached at the end of the oral proceedings held on 29 September 2009, and any amendments thereafter fell to be considered under the principles derivable from decision G 7/93 as set out in point 3, above.
6. As stated in the decision under appeal, the examining division exercised its discretion under Rule 137(3) EPC to refuse to allow into the proceedings the set of claims filed after the communication under Rule 71(3) EPC because this would have required re-opening of the examination proceedings in relation to matters already thoroughly discussed during these proceedings.

The examining division explained in its decision that the claims which the appellant sought to introduce in the proceedings omitted one feature which had been

added previously to the claims in order to overcome objections under Articles 83 and 54 EPC. The board agrees with the examining division that the amendments proposed are substantive, in the sense that they call into question the outcome of the oral proceedings and, if taken into account, would have necessitated a substantive re-examination of the application and thus a delay in the closure of the examination procedure.

In addition, the validity of the claims upon which the examining division intended to grant a patent as mentioned in the communication under Rule 71(3) EPC has never been put into question by the appellant.

Thus, the examining division took into consideration the applicant's interest in obtaining a valid patent and the EPO's interest in bringing the examination to a close. The board concludes that the examining division has, hence, followed the principles set in G 7/93 as explained in paragraph (b) above, and considered all relevant factors as defined in G 7/93 in its decision not to admit the new request.

7. The board concludes, therefore, that the examining division has exercised its discretion under Rule 137(3) EPC in a reasonable manner by not admitting the set of claims filed under cover of a letter dated 11 March 2010 into the proceedings.
8. The appellant has argued that the present application was very complex, not only due to its subject-matter, but also since it was a divisional of a divisional application (EP-03076151 and EP-96306263), and because the examining division introduced with the summons to the first oral proceedings 32 additional documents which had been cited in the opposition proceedings

concerning the parent application. The scope of protection conferred by the claims proposed for grant would have been too narrow, and subsequent divisional applications could not be filed. For these reasons the present case was an exceptional situation in which reopening of the examination proceedings by the examining division was justified.

9. The board is of the view that the complexity of the case only supports the decision of the examining division not to admit a request at a very late stage of proceedings, which had already involved two communications of the examining division and oral proceedings before it. In fact, admitting the set of claims put before it at that late stage would have led, in the view of the complexity of the case, to re-starting the examination on complex substantive issues, with the consequence of unduly lengthening the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated