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**Datasheet for the decision  
of 14 March 2013**

**Case Number:** T 0996/12 - 3.2.07

**Application Number:** 03773356.5

**Publication Number:** 1576201

**IPC:** C23C 8/36

**Language of the proceedings:** EN

**Title of invention:**

Hydrogen diffusion barrier on steel by means of a pulsed-plasma ion-nitriding process

**Applicant:**

COPPE/UFRJ - COORDENACAO DOS PROGRAMAS DE POS  
GRADUACAO DE ENGENHARIA DA UNIVERSIDADE FEDERAL DO  
RIO DE JANEIRO

**Headword:**

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**Relevant legal provisions:**

EPC Art. 111(1), 113(1)(2)  
EPC R. 103(1)(a), 137(2)(3)  
RPBA Art. 11

**Keyword:**

"Principle of party disposition infringed, decision on a request that had been withdrawn (point 4), right to be heard infringed (point 5), reimbursement of the appeal fee"

**Decisions cited:**

T 0745/03, T 1685/07, T 0647/93, T 0946/96, T 0237/96,  
T 0690/09, T 1854/08, G 7/93

**Catchword:**

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Case Number: T 0996/12 - 3.2.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 14 March 2013

**Appellant:**  
(Applicant)

COPPE/UFRJ COORDENACAO DOS PROGRAMAS DE POS  
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**Representative:**

Johansson, Lars-Erik  
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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted 29 December 2011  
refusing European patent application  
No. 03773356.5 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** H. Meinders  
**Members:** I. Beckedorf  
H. Hahn

## **Summary of Facts and Submissions**

- I. Subject-matter of the appeal of the applicant (appellant) is the decision of the Examining Division dated 29 December 2011 refusing European Patent application No. 03 773 356.5.
  
- II. With communication of 17 November 2005, the Examining Division informed the appellant that claim 1 as originally filed was subject to multiple objections under Article 84 EPC with respect to clarity and also lacked features essential to the claimed invention that thus could not be considered as involving an inventive step (Article 56 EPC) over the disclosures of the prior art documents D1 to D4.
  
- III. In the subsequent proceedings, the appellant filed four consecutive amendments in the form of new sets of claims. These were all subject to essentially the same objections as their predecessors, the last being additionally subject to multiple objections under Article 123(2) EPC. Upon the Applicant's auxiliary request and together with its negative position, the Examining Division summoned the appellant to oral proceedings scheduled for 30 November 2011. It invited the appellant to file any further remarks marking the 31 October 2011 as the "final date for making written submission and/or amendments".
  
- IV. The appellant, with its letter of 31 October 2011, filed a new set of claims to "form the sole request at the start of the oral proceedings". On 15 November 2011, the Examining Division decided to allow the appellant's request for a videoconference. However, in its letter

of 23 November 2011, the appellant withdrew its request for oral proceedings and submitted a "redrafted main request".

- V. The Examining Division issued a communication pursuant to Article 94(3) EPC dated 30 November 2011 (sent in advance by facsimile on 25 November 2011) informing the appellant - with no invitation to comment on it - that a refusal of the application under Article 97(2) EPC was to be expected and stated that the appellant's submissions of 23 November 2011 were late filed and "moreover deemed by the Examining Division to be inadmissible as it not only in no way overcomes the ... objections outstanding from the previous and currently admissible set of claims of 31.10.2011 but gives rise to new objections under Art. 123(2) EPC, Art. 84 EPC and Art. 54 EPC (lack of novelty). In view of the time imposed, this claim is moreover not considered to be in the spirit of Rule 137(3) EPC whose purpose is ... to guide the examination proceedings to a conclusion via giving the applicant a fair number of opportunities to provide 'converging' claim sets. The current claim however is rather of the unacceptable 'diverging sort' (see T 1685/07 and T 745/03) which has not only had the effect of going back to square one of the examination proceedings but has provided a claim devoid of even the limitations of originally filed claim 1."

With letter of 28 November 2011, the appellant indicated it would not attend the oral proceedings. Said oral proceedings were thus cancelled.

- VI. The decision under appeal gives an account of the sequence of events, in particular of the various

requests submitted by the appellant and the various communications issued by the Examining Division. In spite of this, the Examining Division stated at the end of the facts and submissions (point 8): "In view of the Applicant's submissions of 23.11.2011 being inadmissible, the current decision to refuse the application is based on the set of claims 1-6 provided with the Applicant's letter of 31.10.2011 (see Annex 1)." Consequently, the reasons for the decision are based solely on the claims filed with the appellant's letter of 31 October 2011 that were held as infringing Articles 123(2), 84 and 56 EPC. In an "addendum" at the end of the reasons of the decision, the Examining Division essentially recites the remarks in its communication of 25/30 November 2011 in respect of the inadmissibility of the (ultimate) set of claims submitted by the appellant on 23 November 2011.

VII. The appellant filed an appeal against said decision on 7 March 2012 and simultaneously paid the appeal fee. Upon a communication of the Registry of the Board of 5 September 2012, the appellant remedied the missing name and address with its letter of 8 October 2012.

VIII. In its statement of grounds of appeal of 3 April 2012, the appellant essentially submitted its objections under Article 113(1) and (2) EPC because the Examining Division had completely ignored its sole request based on the set of claims filed on 23 November 2011 by taking its decision in respect of the former set of claims submitted on 31 October 2011. Thus, the Examining Division violated the principle of party disposition. At the same time, the Examining Division infringed the right to be heard because it gave no

substantive reasons for its opinion expressed in its communication of 25/30 November 2011 concerning the patentability of the set of claims filed on 31 October 2011 and of claim 1 of the redrafted main request filed on 23 November 2011 (the letter of 6 December 2011 referred to by the appellant just deals with the cancellation of the oral proceedings and the continuation of the procedure in writing). Furthermore, the Examining Division, before taking a decision on the admissibility of the last amendments, failed to give the appellant an opportunity to reply to its opinion that the latter set of claims was of an unacceptable "diverging sort". In this respect, the Examining Division exercised its discretion according to Rule 137(3) EPC not only unreasonably but also in applying the wrong principles.

Apart from this, the appellant argued that claim 1 of the set of claims filed on 23 November 2011 fulfilled the requirements of the EPC.

IX. The appellant requested

that the decision under appeal be set aside,  
that a patent be granted on the basis of claim 1  
of the sole request dated 23 November 2011 and  
that the appeal fee be reimbursed according to  
Rule 103(1)(1) EPC.

Additionally, it requested

that the case only be remitted to the Examining Division if the Board of Appeal considers that the subject-matter of claim 1 cannot form the basis for the grant of the application.

## **Reasons for the Decision**

### *Procedural issues*

1. Having regard to that neither the appellant has requested oral proceedings nor that the Board considers oral proceedings to be expedient (Article 116(1), 1<sup>st</sup> sentence EPC) this decision is taken in written proceedings according to the state of the file.
2. The appeal complies with the provisions mentioned in Articles 106 to 108 EPC and Rule 99 EPC and therefore is admissible.

### *Fundamental deficiencies*

3. The appellant contests the decision of the Examining Division essentially for both procedural and substantive matters. The latter objections become relevant only if the first were to be held unfounded. Thus, the alleged infringement of the appellant's procedural rights will be considered first.

The appellant's submissions and arguments in this context involve four different aspects, which are to some extent interrelated with each other, i.e.

- (1) that the Examining Division infringed the principle of party disposition by taking its decision on the (former) request submitted by the appellant on 31 October 2011 (Article 113(2) EPC),
- (2) that the Examining Division gave no substantive reasons for its opinion expressed in its letter of 25/30 November 2011 regarding the patentability of the set of claims filed on 31 October 2011 and of claim 1 filed on 23 November 2011,
- (3) that the Examining Division, before taking a decision on the admissibility of the last amendments, failed to give the appellant an opportunity to reply to its opinion that the latter set of claims was of an unacceptable "diverging sort" (Article 113(1) EPC), and
- (4) that, in this last respect, the Examining Division exercised its discretion according to Rule 137(3) EPC not only unreasonably, but also applying the wrong principles.

4. In consideration of the first aspect, it needs to be noted that the appellant has filed its last version of claim 1 with its letter of 23 November 2011. This claim was presented as "new main claim" and "redrafted main request" that the appellant considered to meet all objections made by the Examining Division in its communication of 26 May 2011. Furthermore, the appellant expressly requested the "grant of a patent on the basis of the redrafted main claim filed with this letter" with a description to be adapted later.



It is reasonable to interpret this letter and request as the clear intention of the appellant to have only this new main request examined by the Examining Division. In other words the appellant agreed only to the text submitted with this letter.

Unlike the situation where an applicant submits one or more auxiliary requests, submitting a new main request (possibly followed by other - new - main requests in the course of the proceedings) automatically leads to the replacement and - in legal terms - withdrawal of (any) previous main request(s). This notion is a direct result of the fundamental procedural principle of party disposition (*ne ultra petita*) that is guaranteed by Article 113(2) EPC (see Benkard-Günzel/Beckedorf, EPÜ, 2<sup>nd</sup> edition 2012, vor Art. 106-112, n° 25 *et seq.*).

Consequently, the earlier request with the set of claims filed on 31 October 2011 was no longer valid but - at least as regards claim 1 - was replaced by the subsequent request of 23 November 2011. As a result, the previous agreement of the appellant with that earlier text was conclusively withdrawn.

The fact that the Examining Division did not agree to the last amendment of claim 1 of the main request as filed with the appellant's letter of 23 November 2011 but held it to be inadmissible for various procedural and substantive reasons (as set out both in its communication of 25/30 November 2011 and in the addendum to the decision under appeal) could not and did not "revive" or "re-establish" the finally withdrawn previous main request(s).

The conclusion of the Examining Division as to the inadmissibility of the main request of 23 November 2011 merely could have led to a state of the examining proceedings where no valid text agreed to by the appellant was present to take a decision on and, therefore, to a refusal of the application under Article 97(2) EPC for this particular reason alone (see T 647/93, OJ EPO 1995, 132; T 946/96; T 237/96; T 690/09).

By contrast, the Examining Division based its decision explicitly on the earlier set of claims that was submitted on 31 October 2011, irrespective of the subsequent (automatic) withdrawal by the appellant when filing a new main request on 23 November 2011. Hence, the Examining Division examined and decided upon a request that was (no longer) part of the proceedings and, thus, upon a text to which the appellant (no longer) agreed to in the sense of Article 113(2) EPC.

The provision of Article 113(2) EPC marks a fundamental procedural principle and is of such prime importance that any infringement of it must be considered to be a substantial procedural violation (see T 1854/08, Reasons 2.1; T 690/09, Reasons 8).

5. In addition to this infringement of Article 113(2) EPC, the decision under appeal suffers from a further procedural defect in view of Article 113(1) EPC and the appellant's right to be heard.

By a first facsimile letter of 25 November 2011 (i.e. the pre-sent communication dated 30 November 2011) the

appellant was informed that its submission of 23 November 2011 was late filed and moreover deemed by the Examining Division to be inadmissible for procedural (Rule 137(3) EPC) and substantive (Articles 84, 123(2) and 54 EPC) reasons. This fax contained the form 2001, setting a time limit of four months to reply.

This form, **with its time limit**, was invalidated by a second fax of 25 November 2011, which otherwise contained the same communication. In both faxes the date of the oral proceedings was maintained.

After the applicant's announcement, dated 28 November 2011, that it would not attend these oral proceedings the appellant was informed by fax of 29 November 2011 that the oral proceedings were cancelled and that the proceedings were continued in writing.

However, by cancelling the time limit the appellant was not given any opportunity to present its comments to overcome the negative position expressed in said communications against the claims filed with letter of 31 October 2011.

Moreover, the appellant had to gather from both communications that ended with the observation by the Examining Division that a refusal of the application under Article 97(2) EPC was to be expected, that it was no longer possible to convince the Examining Division of the contrary. This follows from also the fact that the refusal to admit the newly filed request was not presented as a provisional opinion of the Examining Division to prepare a discussion but as a decision

which could not be overturned. This is all the more so in view of the statement under point 3 of the communications that "no further amendment may be made prior to the oral proceedings" which were, however, afterwards cancelled. The only conclusion one can take from the above is that the proceedings were continued in writing but that the appellant had no right to react to the substantive and procedural issues raised by the Examining Division.

This contravenes Article 113(1) EPC that clearly provides that the decisions of the EPO may only be based on grounds on which the parties concerned have had an opportunity to present their comments.

6. Since the infringement of Article 113(1) and (2) EPC in itself already justifies that the decision under appeal is set aside the Board just briefly adds some summary observations concerning the appellant's further objections.

6.1 The objection under Article 113(1) EPC that the Examining Division gave no substantive reasons for its opinion expressed in its faxes of 25 November 2011 regarding the patentability of the set of claims filed on 31 October 2011 and of claim 1 filed on 23 November 2011 is more an objection under Rule 111(2) EPC (insufficient reasoning) than a question of the right to be heard. Further, it is not well-founded. The reasons given in these communications are to be read together with the various earlier communications to which the Examining Division expressly refers. The appellant could derive from those communications straightforwardly what kind of objections the Examining

Division had against the various versions of the requests, and the appellant obviously reacted to it by submitting an amended version of claim 1 as a new main request with its letter of 23 November 2011.

- 6.2 The appellant's further objection that the Examining Division exercised its discretion wrongly as to the inadmissibility of the last amendments of 23 November 2011, is also not well-founded.

Rule 137(2) EPC gives the applicant a right to amend the application once on its own volition after receipt of the first communication (here the first communication dated 17 November 2005). Rule 137(3), last sentence, EPC provides that no further amendment may be made without the consent of the Examining Division. According to the case law of the Boards of Appeal, an Examining Division has discretion to allow amendments until issue of a decision to grant (see G 7/93, OJ EPO 1994, 775, Reasons 2.2 and 2.3).

After the first amendment, filed with letter of 15 May 2006, the appellant had another two opportunities to file further amendments, with letters of 2 January 2009 and 31 October 2011, the latter in time to comply with the ultimate date set for the oral proceedings on 30 November 2011. Then, only one week before the oral proceedings another amendment was filed.

If a request for amendment is refused, the Examining Division must inform the applicant of the reasons for not admitting the amendments in order to satisfy the right to be heard according to Article 113(1) EPC. This

the Examining Division did with its faxes of 25 November 2011.

In general terms, the way in which the Examining Division should exercise its discretion to allow an amendment of an application will depend upon the circumstances of each individual case and on the stage of the pre-grant procedure which the application has reached (see G 7/93 (*supra*); T 690/09, Reasons 2; T 309/09, Reasons 6.1). A Board of Appeal reviews this exercise of discretion not in the form of how it would have decided in the case, but whether it was exercised according to the wrong principles, without taking into account the right principles or in an unreasonable way.

In this respect, the Board has to take recourse to the Guidelines for Examination, version April 2010, chapter C-VI, 4.7 and E-III, 8.6. The Board notes in the first place that the applicable Guidelines do not support the concept of converging claim sets being a requirement for allowing amendments or conversely, a diverging claim set not being acceptable.

This appears to be acknowledged by the decision appealed, since the Examining Division refers to two Board of Appeal decisions, T 1685/07 and T 745/03, for this concept.

This criterion is acknowledged in appeal proceedings (e.g. T 1685/07, Reasons 6 *et seq.*; T 745/03, Reasons 2.2; see Benkard-Günzel/Beckedorf, Art. 110, n° 102). Apart from the fact that these decisions particularly apply to the situation where a patent proprietor submits a plurality of auxiliary requests in addition

to a main request in opposition appeal proceedings, it needs to be stressed that its underlining justification is to be found in the efficiency of these **appeal** proceedings, the latter being of a judicial nature in contrast to the purely administrative character of the proceedings before e.g. the Examining Division or the Opposition Division. This fundamental distinction *eo ipso* makes the unqualified application of this criterion by the so-called first instance of the EPO questionable.

However, the other criteria applied in the impugned decision do show that the Examining Division exercised its discretion correctly:

- (a) the amended claim was clearly filed late (one week before the oral proceedings instead of one month), see Guidelines E-III, 8.6, second and third paragraphs, the subject of the proceedings not having changed,
- (b) the amended claim did not overcome the existing objections and gave rise to new objections, see Guidelines E-III, 8.6, fifth paragraph, and C-VI, 4.7, fourth paragraph,
- (c) the appellant has had a fair number of opportunities (three in total), see Guidelines, C-VI, 4.7, fifth paragraph,
- (d) procedural economy was at stake, Guidelines C-VI, 4.7, sixth paragraph, where the claim was not only considered to go back to the start of the

examination proceedings, but even beyond that by not having the limitations of original claim 1.

*Remittal of the case to the Examining Division and reimbursement of the appeal fee*

7. Notwithstanding the appellant's request that the case only be remitted to the Examining Division if the Board considers that the subject-matter of claim 1 cannot form the basis for the grant of the European patent, the Board, in exercising its discretion under Article 111(1), 2<sup>nd</sup> sentence EPC and Article 11 RPBA, finds that the fundamental deficiencies apparent in the examination proceedings, including the decision under appeal, are of such gravity that the case is to be directly remitted to the Examining Division for further prosecution without the Board dealing with the substance of the case.
  
8. Under the circumstances of the present case, the Board considers the requirements of Rule 103(1) (a) EPC to be met and, accordingly, the appeal fee shall be reimbursed.



**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 for further prosecution.
3. The reimbursement of the appeal fee is ordered.

The Registrar

The Chairman

G. Nachtigall

H. Meinders