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**Datasheet for the decision  
of 27 February 2015**

**Case Number:** T 2460/12 - 3.2.07

**Application Number:** 05794538.8

**Publication Number:** 1931572

**IPC:** B65D33/02, B65D81/26, B65F1/00

**Language of the proceedings:** EN

**Title of invention:**  
BAG FOR COLLECTING ORGANIC WASTE OR FOODSTUFFS

**Applicant:**  
ASPIC S.r.l.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 111(1), 113(1)  
EPC R. 103(1)(a), 111(2)  
RPBA Art. 11

**Keyword:**  
Appealed decision sufficiently reasoned - (no)  
Substantial procedural violation - (yes)  
Reimbursement of appeal fee - (yes)

**Decisions cited:**  
T 0278/00, T 1997/08

**Catchword:**



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Case Number: T 2460/12 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 27 February 2015**

**Appellant:** ASPIC S.r.l.  
(Applicant) Via Leone Pancaldo 7  
20129 Milan (IT)

**Representative:** Marietti, Andrea  
Marietti, Gislon e Trupiano S.r.l.  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 29 June 2012  
refusing European patent application No.  
05794538.8 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** H. Meinders  
**Members:** K. Poalas  
E. Kossonakou

## **Summary of Facts and Submissions**

- I. The appeal lies against the decision of the examining division refusing European patent application 05 794 538.8.
- II. The following documents from the examination proceedings are referred to in this decision:
- D1: DE 66 05 916 U  
D2: WO 89/10311 A  
D3: GB 1 062 748 A  
D4: US 2 582 286 A.
- III. In a first communication, dated 11 August 2008, the examining division adopted, by reference to the international preliminary examination report (IPER) already drawn up for the present application, the objections raised therein concerning lack of novelty of the subject-matter of the then valid claim 1 over either document D1 or D2.
- IV. With its response, dated 20 February 2008, the applicant filed amended claims replacing the claims then on file and gave reasons as to why it considered the subject-matter of the new claims to be novel and to involve inventive step. As a precautionary measure oral proceedings were requested.
- V. In a second communication, dated 28 August 2009, the examining division argued again lack of novelty of the subject-matters of the then valid independent claims 1, 10 and 11 over either document D1 or D2.
- VI. With its second response, dated on 8 March 2010, the applicant filed amended claims replacing the claims

- then on file, and explained why it considered the new claims to meet the requirements of Articles 54, 56, 84 and 123(2) EPC.
- VII. A summons to oral proceedings was dispatched on 2 March 2012, accompanied by a communication introducing two new prior art documents D3 and D4. An inventive step objection was raised against the subject-matter of then valid claim 1 in view of the disclosure of document D1 in combination with the general technical knowledge of the person skilled in the art, said knowledge being disclosed for example in documents D3 and D4.
- VIII. The applicant responded thereto with its submission dated 13 April 2012 and provided detailed arguments that sought to counter these objections. It explained why D1 cannot be considered to represent the closest prior art for the subject-matter of claim 1, why the examining division failed to define correctly the "objective technical problem" solved by the differentiating features of claim 1 and why the "could-would approach" was not properly applied. It argued further that there were no circumstances that would have made it "*prima facie*" desirable for the skilled person to use a flat bottom having a number of steps for erecting a paper bag suitable to collect humid items.
- IX. With its fax dated 9 May 2012 the applicant informed the examining division that it would not attend the scheduled oral proceedings.
- X. The oral proceedings were then cancelled and the decision to refuse the application was dispatched on 29 June 2012.

- XI. In the statement setting out the grounds of appeal the appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the main request or of one of the first or second auxiliary requests, all as filed with said statement. Subsidiarily, oral proceedings are requested.
- XII. During a telephone conversation on 12 January 2015 with the rapporteur the appellant was informed that the Board considers that a procedural violation has occurred when issuing the decision and that it intends to remit the case to the examining division for further prosecution. The appellant stated that under these circumstances it withdraws its auxiliary request for oral proceedings.
- XIII. The Board was thus in the position to decide the present case in written proceedings.
- XIV. The appellant's arguments, as far as relevant for the present decision, are:

The examining division's decision does not discuss in-depth the patentability of the subject-matter of claim 1 underlying said decision. It does not apply the "problem-solution approach", nor does it explain why some features of claim 1 are deemed to be "obvious" or are the result of an "obvious" combination of features taken from various prior art documents.

The examining division's decision simply states conclusions, without giving a reasoned statement.

## Reasons for the Decision

1. Pursuant to Article 106(1) EPC an appeal shall lie from decisions of *inter alia* the examining divisions. According to Rule 111(2) EPC the decisions of the European Patent Office open to appeal shall be reasoned, since the function of appeal proceedings is to provide a judicial review of the contested decision. A reasoned decision is accordingly a prerequisite for the examination of the appeal.
2. It is established jurisprudence of the Boards of Appeal that for a decision to be reasoned all facts, evidence and arguments essential to the decision must be discussed in detail and that it must contain a logical sequence of arguments (see for instance T 278/00, OJ EPO 2003, 546, points 2 - 4; T 1997/08, not published in OJ EPO, point 4 of the reasons).
3. Furthermore, the Boards of Appeal have consistently decided that Article 113(1) EPC enshrines a party's right to be heard before a decision is issued against it (see Case Law of the Boards of Appeal, 7th edition 2013, IV.B.2.7.3, last paragraph). This right guarantees that all the relevant grounds are taken into account, in particular that the facts and arguments considered by the applicant to be central to his case so that it is decided to his favour, are dealt with in the written decision. Otherwise, if a party need merely be given the opportunity to voice comments, Article 113(1) EPC would turn into a farce.

It needs therefore to be established whether the decision under appeal meets these requirements.

4. With its communication accompanying the summons to oral proceedings, dated 2 March 2012, the examining division informed the applicant of its opinion that the subject-matter of claim 1 dated 8 March 2010 lacked inventive step in view of the disclosure of document D1, representing the closest prior art, in combination with the general technical knowledge of the person skilled in the art, as disclosed for example in documents D3 and D4, introduced into the proceedings with said communication.
  
5. With its reply to the summons, the applicant provided detailed reasons why it considered that claim 1 meets the requirements of Article 56 EPC. It also explained why D1 cannot be considered to represent the closest prior art in respect of claim 1, why the examining division had failed to define properly the "objective technical problem" solved by the differentiating features of claim 1 and why the "could-would approach" had not been properly applied. It argued further that no circumstances were apparent that would have made "*prima facie*" desirable for the skilled person to use a flat bottom in the form of a stepped blank for erecting a paper bag suitable to collect humid items.
  
6. The filing of the above-mentioned reply and a short summary of its content are mentioned in the contested decision's "Facts and Submissions", showing that the examining division was well aware of the appellant's arguments.

However, the "Reasons for the decision" are entirely silent in respect of these arguments. Indeed, apart from some minor editorial amendments, the reasons in this decision are essentially the same as those given in the earlier communication. The mere introduction

into the reasons of the expression "or for solving the problem of providing a blank with an alternative bottom forming shape" in point 11.4 of the impugned decision, does not solve this problem, since it does not take account of the applicant's arguments.

7. The Board follows in this respect the aforementioned established jurisprudence of the Boards of Appeal that Article 113(1) EPC is not a formal provision, but one of substance. Hence it is not sufficient to observe Article 113(1) EPC merely formally by granting the party the procedural possibility for presenting comments, as 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 considered and rebutted on their merits, beyond a mere acknowledgement of their existence.
8. Accordingly, the Board finds that the absence of any treatment of the appellant's arguments in the contested decision, constitutes a substantial procedural violation. Such a procedural violation requires that the decision under appeal be set aside and the case remitted to the examining division in application of Article 111(1) EPC and Article 11 RPBA.
9. Although the appellant has not requested reimbursement of the appeal fee, the Board considers in the present case to be equitable that the appeal fee be reimbursed, Rule 103(1) (a) EPC.



## 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:



G. Nachtigall

H. Meinders

Decision electronically authenticated