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**Datasheet for the decision
of 12 July 2013**

Case Number: T 0161/13 - 3.4.03
Application Number: 10189953.2
Publication Number: 2275875
IPC: G03G 15/01, G03G 15/08
Language of the proceedings: EN

Title of invention:

Image forming apparatus, developing device and developing unit thereof

Applicant:

Samsung Electronics Co., Ltd.

Headword:

-

Relevant legal provisions:

EPC Art. 113(1)
EPC R. 116(2), 137(3), 103(1)(a)
RPBA Art. 11

Keyword:

"Substantial procedural violation (yes)"

Decisions cited:

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Catchword:

-



Case Number: T 0161/13 - 3.4.03

D E C I S I O N
of the Technical Board of Appeal 3.4.03
of 12 July 2013

Appellant: Samsung Electronics Co., Ltd.
(Applicant) 129, Samsung-ro
Yeongtong-gu
Suwon-si, Gyeonggi-do, 443-742 (KR)

Representative: Waddington, Richard
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 15 October 2012
refusing European patent application
No. 10189953.2 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: G. Eliasson
Members: R. Q. Bekkering
T. Bokor

Summary of Facts and Submissions

- I. This is an appeal against the refusal of application No. 10 189 953.
- II. In the decision under appeal, the applicant's main request then on file was refused for lack of clarity and support by the description of claim 1, Article 84 EPC, for added subject-matter in claim 1, Articles 76(1) and 123(2) EPC and for lack of novelty of the subject-matter of claim 1, Article 54(1) EPC.

The applicant's first auxiliary request then on file was refused for lack of novelty of the subject-matter of claim 1, Article 54(1) EPC.

The applicant's second auxiliary request, which was filed during the oral proceedings before the examining division replacing a previous second auxiliary request, was considered as non admissible, pursuant to Rule 137(3) EPC and Rule 116 EPC, because claim 1 was *prima facie* not allowable and even new objections had to be raised for lack of clarity of claim 1, Article 84 EPC and added subject-matter, Articles 76(1) and 123(2) EPC.

- III. The appellant requested with the statement of the grounds of appeal that the decision under appeal be set aside and that a patent be granted on the basis of the claims according to the main request or one of the first or second auxiliary requests, all filed with the statement of the grounds of appeal.

Moreover, a refund of the appeal fee under Rule 103 EPC was requested, as a substantial procedural violation against Article 113 EPC occurred.

As a precaution, oral proceedings before the application was refused were requested.

Reasons for the Decision

1. The appeal is admissible.
2. *Procedural matters*
 - 2.1 In the statement setting out the grounds of appeal, the appellant noted that "*At Oral Proceedings the Examining Division concluded that the finally submitted amendments introduced added subject matter (Article 123(2) EPC). The Examining division closed the Hearing without allowing the final auxiliary request into the proceedings. We were not given an opportunity to comment on the rejections. We believe this is a substantial procedural violation against Art 113 EPC and we therefore request refund of the Appeal Fee under rule 103 EPC*".

The minutes of the oral proceedings before the examining division merely contain the following "*The chairman declared the oral proceedings open. The chairman summarised the relevant facts as appearing from the file.*

The applicant's representative addressed the examining division and submitted a first auxiliary request (Annex 1) and a second auxiliary request (Annex 2) that was

subsequently replaced a new second auxiliary request (see Annex 3).

The matter was discussed with the applicant's representative".

In the decision under appeal it is stated that "*The second auxiliary request (which was filed last during oral proceedings) was considered as non admissible, pursuant to R. 137 (3) EPC and R. 116 EPC, because its claim 1 is prima facie not allowable and even the following new objections had to be raised (Art. 84 EPC, Art. 123(2) EPC and Art. 76(1) EPC)*" followed by details as to each of these objections.

2.2 Rule 137 EPC, on which the decision under appeal relies for not admitting the replacement second auxiliary request, provides that

"(2) Together with any comments, corrections or amendments made in response to communications by the European Patent Office under Rule 70a, paragraph 1 or 2, or Rule 161, paragraph 1, the applicant may amend the description, claims and drawings of his own volition,

(3) No further amendment may be made without the consent of the Examining Division".

The amendments made in the replacement second auxiliary request submitted in the oral proceedings before the examining division were preceded by a number of amendments made in the course of the examination procedure in accordance with Rule 137(2) EPC, and thus

constitute a "*further amendment*" within the meaning of Rule 137(2) EPC.

2.3 Rule 116 EPC, on which the decision under appeal relies as well, provides that

"(1) When issuing the summons, the European Patent Office shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings shall be fixed. Rule 132 shall not apply. New facts and evidence presented after that date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed,

(2) If the applicant or patent proprietor has been notified of the grounds prejudicing the grant or maintenance of the patent, he may be invited to submit, by the date specified in paragraph 1, second sentence, documents which meet the requirements of the Convention. Paragraph 1, third and fourth sentences, shall apply mutatis mutandis".

With the summons to oral proceedings, the examining division set the final date for making written submissions and/or amendments within the meaning of Rule 116 EPC to be 17 August 2012.

The applicant's replacement second auxiliary request, consisting of claims 1 to 4 and marked in handwriting as "*submitted in Oral Proc. 13.00 replacement auxiliary request 2*" and attached to the minutes of the oral proceedings as "*Annex 3*" was presented at the oral

proceedings on 19 September 2012, after this final date.

It is noted in this respect that, as the issue is of no relevance for the present decision, the question is not addressed whether in the present case the request should not have been admitted on the ground that the subject of the proceedings had changed in accordance with Rule 116(2) EPC, as the subject-matter of claim 1 of the main and the first auxiliary request were held to lack novelty over document D13 which was introduced by the examining division only two days before the oral proceedings.

2.4 Accordingly, the applicant's replacement second auxiliary request constitutes a further amendment, subject to the consent of the examining division in accordance with Rule 137(3) EPC, and documents presented after the final date for making written submission in preparation for the oral proceedings, which need not be considered in accordance with Rule 116(2) EPC.

2.5 The admission and consideration of the replacement second auxiliary submitted in the oral proceedings is, thus, a discretionary decision by the examining division.

As with any decision of the EPO, this decision may only be based on grounds on which the party concerned has had an opportunity to present its comments, Article 113(1) EPC.

This implies in the circumstances of the present case, that the applicant should have been informed in the oral proceedings of the grounds argued by the examining division against the admission of the replacement second auxiliary request and that the applicant should have had the opportunity to present its comments on these grounds.

As is apparent from the decision under appeal these grounds included new objections under Articles 84, 123(2) and 76(1) EPC.

The appellant has submitted that the examining division closed the hearing without allowing the final auxiliary request into the proceedings and that they were not given an opportunity to comment on the rejections.

The minutes of the oral proceedings are entirely silent about the admission of the replacement second auxiliary request. From the mere fact that this request presumably was filed at 13:00 hours, as the handwriting on the request suggests, and the oral proceedings were closed at 13:30 hours according to the minutes, it cannot be inferred either that any opportunity to comment was given to the applicant. Indeed, most likely during at least part of this time the oral proceedings were interrupted for deliberation of the examining division prior to the announcement of the decision. Needless to say that minutes providing a minimum record of the course of events at the oral proceedings would have been helpful in the present case.

Furthermore, in the decision under appeal, concerning the replacement second auxiliary request, although at

least some of the objections under Articles 84, 123(2) and 76(1) EPC, are said to be new, which is understood to imply that they were not raised previously in the context of the main and first auxiliary request, or possibly the preceding version of the second auxiliary request, there is no mention of any argument brought forward by the applicant on any of these new objections. If arguments would have been advanced by the applicant countering the examining division's objections and indeed on the issue of admission of the request, these, as should be expected, would have been duly summarised and addressed in the decision under appeal, which further suggests that the applicant was not given an opportunity to comment, in breach of the provision of Article 113(1) EPC.

2.6 Since the provision of Article 113(1) EPC represents a fundamental procedural principle in proceedings before the EPO ensuring the right of a party to the proceedings to be heard before an adverse decision is issued, its breach amounts to a substantial procedural violation.

For the above reasons, the board remits, in accordance with Article 11 RPBA, the case to the department of the first instance under Article 111(1) EPC for further prosecution of the application.

The appeal fee is to be reimbursed in accordance with Rule 103(1) (a) EPC, since the appeal is considered to be allowable to the extent that the decision under appeal is set aside as requested and the reimbursement is equitable by reason of the substantial procedural violation, the appellant applicant having had to file

this appeal in order to have his comments, at least concerning those amendments pursued in appeal, considered.

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 reimbursement of the appeal fee is ordered.

Registrar:

Chair:

S. Sánchez Chiquero

G. Eliasson