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**Datasheet for the decision
of 13 August 2018**

Case Number: T 0536/13 - 3.5.02

Application Number: 07013885.4

Publication Number: 1837980

IPC: H02K19/10, H02K1/27

Language of the proceedings: EN

Title of invention:

Reluctance type rotating machine with permanent magnets

Applicant:

Kabushiki Kaisha Toshiba

Relevant legal provisions:

EPC Art. 111(1), 113(2)

EPC R. 103(1)(a), 111(2)

Keyword:

Basis of decision - text submitted or agreed by applicant (no)

Substantial procedural violation - appealed decision
sufficiently reasoned (no)

Remittal to the department of first instance (yes)

Reimbursement of appeal fee - (yes)



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0536/13 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 13 August 2018

Appellant: Kabushiki Kaisha Toshiba
(Applicant) 1-1, Shibaura 1-chome,
Minato-ku
Tokyo (JP)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 16 July 2012
refusing European patent application No.
07013885.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Lord
Members: G. Flynn
R. Cramer

Summary of Facts and Submissions

- I. The applicant's appeal contests the examining division's decision dated 16 July 2012 refusing the European patent application no. 07 013 885.4.
- II. With the statement of Grounds of Appeal (letter dated 8 November 2012) the appellant requested that the decision under appeal be set aside and that a patent be granted in accordance with the main request or first auxiliary request filed therewith. In the event that the Board should not intend to allow the application in accordance with one of these requests the appellant requested oral proceedings.
- III. In a communication pursuant to Rule 100(2) EPC dated 23 July 2018 the Board pointed to some fundamental deficiencies in the first instance proceedings and stated that it would seem appropriate for the Board to set aside the contested decision and to remit the case to the department of first instance for further examination, pursuant to Article 111(1) EPC and Article 11 RPBA. The Board stated that under these circumstances it would also seem appropriate for the Board to order reimbursement of the appeal fee in accordance with Rule 103(1) (a) EPC. The appellant was invited to confirm whether or not the request for oral proceedings was maintained in this eventuality.
- IV. With a letter dated 10 August 2018 the appellant responded to the above communication and withdrew their request for oral proceedings subject to the course of action set out in section 8 thereof being taken and the appeal fee being reimbursed.

Reasons for the Decision

1. The appeal is admissible.
2. The contested decision is a so-called "decision according to the state of the file". The grounds for the decision read as follows:

"In the communication(s) dated 05.03.2012 , 18.10.2011 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 16.05.2012 .

The application must therefore be refused."

3. The later of the two communications cited in the grounds for the decision was a communication annexed to a summons to attend oral proceedings. According to that communication the examination was being carried out on the following application documents:

Description, Pages

28, 40 as originally filed

1, 7, 20-27, 29-39, 41-59 received on 6 September 2011
with letter of 5 September 2011

2,3,6 received on 12 January 2012 with letter of
11 January 2012

Claims, Numbers

1-16 received on 12 January 2012 with letter of
11 January 2012

Drawings, Sheets

1/35-35/35 as originally filed

4. According to the file, the applicant responded to the summons to attend oral proceedings with a letter that was dated and sent by fax on 23 April 2012. With that letter the applicant filed:

"amended description pages 2 and 2a, and amended Claims 1-14 on pages 60-62 to replace, without prejudice to the filing of further amendments based on the application as originally filed, description page 2 and all claims currently on file".

Furthermore, the applicant set out detailed reasons as to why, in their view, the amendments overcame the various objections that had been raised in the communication annexed to the summons.

5. On 15 May 2012 a telephone consultation took place between the applicant's representative and the first examiner. The result of the telephone consultation was recorded in a communication dated 21 May 2012 as follows:

"The representative asked for the preliminary opinion of the first examiner. The first examiner indicated that in his opinion claim 1 now on file suffers from the same deficiency as claim 1 as originally filed. He also referred to the decision on the parent application dealing with substantially the same subject-matter."

6. The applicant's request "that a decision according to the state of the file be issued" was made in a letter that was dated and filed by fax on 16 May 2012. At that time, the state of the file included the applicant's letter dated 23 April 2012, the amended application documents filed therewith and the telephone consultation of 15 May 2012.
7. From the statement in the reasons for the decision that "The applicant filed no comments or amendments in reply to the latest communication ...", it is evident that the decision does not take into account the comments and amended application documents that were filed with the applicant's letter dated 23 April 2012. Consequently the decision does not comply with the requirement of Article 113(2) EPC that the EPO shall examine, and decide upon, the European patent application only in the text submitted to it, or agreed, by the applicant. This amounts to a substantial procedural violation.
8. Furthermore, in the absence of any reasoning in respect of the applicant's latest comments and amendments the Board and the appellant are left in doubt as to which of the previously-raised objections still apply. Whilst it might be assumed that claim 1 as filed on 23 April 2012 was the subject of the telephone consultation of 15 May 2012, there is no indication that the outstanding deficiencies were discussed in substance and the contested decision does not refer to the telephone consultation at all. Thus the decision is not reasoned within the meaning of Rule 111(2) EPC, which constitutes a further substantial procedural violation.

9. In view of these fundamental deficiencies in the first instance proceedings the Board considers it appropriate to set aside the contested decision and to remit the case to the department of first instance for further prosecution, pursuant to Article 111(1) EPC and Article 11 RPBA.

10. In view of the substantial procedural violations reimbursement of the appeal fee is equitable in accordance with 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 shall be reimbursed in full.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated