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**Datasheet for the decision
of 21 December 2017**

Case Number: T 1423/13 - 3.3.06

Application Number: 10192821.6

Publication Number: 2335805

IPC: B01D53/22, B01D71/64,
B01D67/00, B01D69/08, B01D71/82

Language of the proceedings: EN

Title of invention:

Crosslinked and crosslinkable hollow fiber membrane and method
of making same

Applicant:

Chevron U.S.A. Inc.

Headword:

Crosslinkable hollow fibre/Chevron

Relevant legal provisions:

EPC Art. 113(1), 116(1)
EPC R. 103(1) (a)

Keyword:

Remittal to the department of first instance - fundamental
deficiency in first instance proceedings
(yes) misleading information -
refusal without summoning to oral proceedings as announced
Reimbursement of appeal fee -
(yes) substantial procedural violation

Decisions cited:

T 0611/01, T 0849/03

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent
Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89
2399-4465

Case Number: T 1423/13 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 21 December 2017

Appellant: Chevron U.S.A. Inc.
(Applicant) 6001 Bollinger Canyon Road
San Ramon, CA 94583 (US)

Representative: Rogers, Alex Lee
Haseltine Lake LLP
Redcliff Quay
120 Redcliff Street
Bristol BS1 6HU (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 1 February 2013
refusing European patent application No.
10192821.6 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman B. Czech
Members: G. Santavicca
S. Fernández de Córdoba

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Examining Division refusing divisional European patent application No. 10192821.6 on the ground of lack of inventive step.
- II. In its last communication (dated 11 May 2012) issued before the refusal decision had been posted, the Examining Division had maintained inventive step objections already raised earlier against the then pending Claim 1. It also stated the following:
*"Finally, the applicant is warned that in case no allowable set of claims is presented, the **next office action will be the summons to oral proceedings in the Hague**"* (emphasis added by the Board).
- III. With its reply thereto (dated 20 November 2012), the Applicant had filed another set of claims (Claim 1 remaining unamended) and taken position with regard to (*inter alia*) inventive step as regards the subject-matter of Claim 1. The representative also indicated its readiness to deal with remaining objections by telephone, if considered expedient.
- IV. The Examining Division then issued the decision to refuse the application without contacting the Applicant again. The decision, although dated "1 February 2013", had actually already been handed over to the EPO postal service on "29.01.13", as apparent from EPO Form 2007, Sheet 2, which is part of the decision.

In the decision under appeal, the Examining Division came (*inter alia*) to the following conclusions.

- a) "The decision takes into account the latest submissions and is based on facts, evidence and grounds already presented in the written

procedure. The latest submissions (by the Applicant, i.e. letter dated 20 November 2012) did not overcome the objections under Article 56 EPC raised in the European Search Opinion (issued on 9 May 2009) and repeated in the communication (of the Examining Division) dated 11 May 2012."

- b) "As the last amendments do not change the scope of the claimed subject-matter (when compared to the previous examined set of claims), the objections underlying the present decision were already known to the applicant. Considering also the course of the proceedings for the parent application EP 02 799 294 (and in particular the detailed discussion of its content during the oral proceedings held on 23 November 2010), in view of the Examining Division there is no further point in pursuing the subject-matter of the present divisional. Given the content of both applications and the nature of the outstanding objections, no new arguments can be conceivably brought forward by the applicant that could lead to the patentable subject-matter."
- c) "The request to contact the applicant on the phone in case any outstanding objections remain 'which may be usefully dealt with by telephone' is not granted as the telephone consultation cannot bring the present proceedings forward".
- d) "As the applicant did not request the oral proceedings at any point of the written procedure, it is concluded that the applicant's right to be heard has been entirely respected (Article 113(1) EPC)".

V. By a letter filed online on 31 January 2013, the Applicant had requested oral proceedings in the event that the Examining Division was minded to refuse the application.

- VI. The Applicant did not return the "acknowledgement of receipt" form dispatched together with the decision of the Examining Division but filed a notice of appeal against said decision within the prescribed time limit.
- VII. With its statement of grounds of appeal filed on 6 June 2013, the Appellant/Applicant filed further items of evidence and five sets of claims as Main Request (claims that had been pending before the Examining Division) and 1st to 4th Auxiliary Requests.
- VIII. The Applicant requested 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, alternatively, that the case be remitted to the Examining Division for further consideration of the Main Request, or of any of the Auxiliary Requests, filed with the statement setting out the grounds of appeal.
- IX. The arguments of the Appellant of relevance here can be summarised as follows (see statement of grounds, Point 44):
- a) The Applicant had filed a request for oral proceedings with its letter of 31 January 2013, i.e. before the decision was issued.
 - b) The Examining Division unequivocally stated in its Communication of 11 May 2012 that oral proceedings would be the next step if no allowable claims were presented. Hence, the Applicant had a reasonable and legitimate expectation that oral proceedings would have been called, irrespective of whether or not the Applicant had actually requested them.
 - c) Therefore, the issuance of the decision instead of calling oral proceedings was against the principle of legitimate expectations.

- d) This course of action amounted to a substantial procedural violation warranting the remittal of the case to the Examining Division and the reimbursement of the appeal fee pursuant to Rule 103(1) (a) EPC.

Reasons for the Decision

1. The present decision only concerns the question whether the refusal of the application was the consequence of a substantial procedural violation warranting the remittal of the case and the reimbursement of the appeal fee.
2. Procedural violation
 - 2.1 According to Article 116(1) EPC, "Oral proceedings shall take place either **at the instance of the European Patent Office if it considers this to be expedient** or at the request of any party to the proceedings" (emphasis added by the Board).
 - 2.2 For the Board, the wording of the statement of the Examining Division in its communication dated 11 May 2012 that "*... in case no allowable set of claims is presented, the **next office action** will be the **summons to oral proceedings** ...*" (emphasis added by the Board) is perfectly clear *per se*. It unambiguously implies that the Examining Division considered an oral hearing "at the instance of the EPO" to be expedient under the conditions expressly identified, i.e. "*in case no allowable set of claims is presented*".
 - 2.3 Between the issuance of said communication and of the decision to refuse the application, the Examining Division neither withdrew nor rectified said statement,

e.g. in order to inform or warn the Applicant that its application might be refused even without holding oral proceedings, as previously deemed expedient if no allowable claims were filed.

2.4 The considerations of the Examining Division (decision under appeal, paragraph bridging pages 2 and 3) based on what happened in the prosecution of the parent application are of no relevance, in particular since such considerations had already been verbalised in the very same communication dated 11 May 2012 (see section under the heading "Article 56 EPC") which contains the final indication "... in case no allowable set of claims is presented, the **next office action** will be the **summons to oral proceedings** ...".

2.5 For the Board, this statement by the Examining Division was a source of legitimate expectation for the Applicant. In the present case, the violation of this principle led to the decision to refuse the application, which came as a surprise to the Applicant.

More particularly, in the communication of 11 May 2012, the Examining Division had given the clear impression that if no allowable claims were filed, no decision negatively affecting the Applicant would be taking without beforehand summoning the Applicant to oral proceedings.

2.6 Having given that impression, the Examining Division, by issuing the decision to refuse the application without summoning the Applicant to oral proceedings, took the Applicant by surprise, thereby depriving it of a further opportunity to present arguments or its final fall back positions.

The applicant was thus denied its right to be heard (see also, for instance, decisions T 611/01 of 23 August 2004, Reasons, 5.2 to 6, and T 849/03 of 19 August 2004, Reasons).

2.7 In the Board's judgement, this course of action amounts to a substantial procedural violation.

3. Consequences

3.1 Request for remittal

3.1.1 Article 11 RPBA stipulates that "a Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reason present themselves for doing otherwise".

3.1.2 Considering the circumstances of the present case, the Board sees no such "special reasons" possibly justifying not to remit the case. Moreover, remittal was expressly requested by the Appellant.

3.2 Reimbursement of the appeal fee

Considering that the Board deems the appeal to be allowable, the reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC is equitable by reason of the substantial procedural violation occurred.

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 appeal fee is to be reimbursed.

The Registrar:

The Chairman:



D. Magliano

B. Czech

Decision electronically authenticated