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**Datasheet for the decision
of 22 June 2017**

Case Number: T 2092/13 - 3.4.02

Application Number: 09000629.7

Publication Number: 2063219

IPC: G01B11/06, G01B21/08

Language of the proceedings: EN

Title of invention:

Measurement of hot container wall thickness

Applicant:

OWENS-BROCKWAY GLASS CONTAINER INC.

Relevant legal provisions:

RPBA Art. 11

EPC R. 103(1)(a)

Keyword:

Substantial procedural violation (yes)

Remittal to the department of first instance and reimbursement
of the appeal fee (yes)

Decisions cited:

G 0002/97, J 0003/87



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Case Number: T 2092/13 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 22 June 2017

Appellant: OWENS-BROCKWAY GLASS CONTAINER INC.
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Perrysburg, OH 43551-2999 (US)

Representative: Mergel, Volker
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 24 April 2013
refusing European patent application No.
09000629.7 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman R. Bekkering
Members: F. J. Narganes-Quijano
G. Decker

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal against the decision of the examining division refusing European patent application No. 09000629.7 filed as a divisional application of European patent application No. 00100472.0.

II. In its decision the examining division referred *inter alia* to documents

D1: US 3535522 A
D2: EP 0643297 A1
D5: US 3356212 A

and held with respect to the main and the auxiliary requests then on file that

i) claim 1 of the main request did not involve an inventive step (Article 56 EPC) with regard to the disclosure of document D2, and

ii) the description of the auxiliary request did not satisfy the requirements of Article 76(1) EPC.

The examining division also expressed in an *obiter dictum* of the decision its view that

- claims 1 and 2 of the main request did not involve an inventive step (Article 56 EPC) with regard to the disclosure of each of documents D1 and D5,

- the description of the main request did not satisfy the requirements of Article 123(2) EPC, and

- claims 1 and 2 of the auxiliary request did not involve an inventive step (Article 56 EPC).

III. With the statement setting out the grounds of appeal the appellant requested that the decision under appeal

be set aside and a patent be granted on the basis of the set of claims of the main request or of the first auxiliary request underlying the decision under appeal, or on the basis of one of the sets of claims of two additional auxiliary requests filed with the statement of grounds of appeal.

In the statement of grounds of appeal the appellant also alleged a series of procedural violations in the first-instance proceedings and requested the reimbursement of the appeal fee.

- IV. In a communication annexed to a summons to oral proceedings the board presented a preliminary assessment of the case on appeal.
- V. In reply to the summons to oral proceedings the appellant filed with its letter dated 20 April 2017 an amended description comprising pages 1 to 11, and the following sets of claims:
- claims 1 and 2 labelled "Main Request",
 - claims 1 and 2 labelled "Auxiliary Request 1",
 - claims 1 and 2 labelled "Auxiliary Request 2",
 - claims 1 and 2 labelled "Auxiliary Request 3",
 - claim 1 labelled "Auxiliary Request 4",
 - claim 1 labelled "Auxiliary Request 5", and
 - claim 1 labelled "Auxiliary request 6".
- VI. Oral proceedings were held on 22 June 2017.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims of the main request filed with the letter dated 20 April 2017 or, as an auxiliary measure, on the basis of one of the sets of claims of auxiliary requests 1 to 6 filed with the letter dated

20 April 2017, together with pages 1 to 11 of the description filed with the letter dated 20 April 2017 and drawing sheets 1/4 to 4/4 as originally filed.

The appellant further requested the reimbursement of the appeal fee by reason of procedural violations.

During the discussion on the procedural violations alleged by the appellant, the appellant requested that the case be remitted to the department of first instance for further prosecution by reason of the alleged procedural violations.

At the end of the oral proceedings the board announced its decision.

VII. Claim 1 of the main request reads as follows:

"A method of measuring the wall thickness of molded hollow glass articles (12) having a predetermined average wall thickness, and while the articles (12) are hot from the molding process, comprising the steps of:

(a) measuring the intensity of radiation emitted by the article (12) indicative of the surface temperature,

(b) determining the wall thickness of the article (12) as a combined function of the intensity measured in said step (a) and said predetermined average wall thickness."

Reasons for the Decision

1. The appeal is admissible.

2. *Article 11 RPBA*

2.1 With the statement setting out the grounds of appeal the appellant submitted that the decision under appeal was tainted with a series of procedural violations. In particular, the appellant submitted that no intention to refuse the application was announced in the official communication preceding the refusal of the application, i.e. in the communication dated 7 December 2010. This argument was further developed by the appellant during the oral proceedings held before the board.

2.2 The facts of the first-instance proceedings relevant for the issues under consideration are the following:

a) The application as originally filed contained a set of claims 1 to 8. The subject-matter of claim 1 and dependent claim 2 was the same as the subject-matter of independent claim 23 and dependent claim 24 of the parent application as originally filed.

b) In the European Search Opinion based on the application as originally filed it was held that

- neither the subject-matter of independent claim 3 and dependent claims 6 to 8, nor the description of the application were in conformity with Article 76(1) EPC, and

- the subject-matter of independent claim 1 and dependent claim 2 was not new in view of document D1 and did not involve an inventive step over the disclosure of document D2.

c) With its letter dated 12 August 2009 the appellant submitted a new set of claims 1 to 8 and amended pages 2 and 2a of the description, independent

claims 1 and 3 containing amendments with respect to independent claims 1 and 3 as originally filed. The letter included counter-arguments in response to the examining division's objections of lack of novelty and lack of inventive step.

d) In its communication dated 7 December 2010 the examining division reiterated its view that the application documents on file, and in particular the amended independent claim 3 and the amended pages of the description, did not comply with Article 76(1) EPC (point 1 of the communication, paragraphs (i) and (ii), and point 2), and indicated that a way of overcoming the objections under Article 76(1) EPC was seen "*in using [...] claims 23 and 24 [of the parent application as originally filed] as the only basis for new claims*" (point 1 of the communication, paragraph (iii)). This indication of the examining division was followed by the following statement in paragraph iv) of point 1 of the communication: "*The examination of novelty and inventive step is deferred until the Article 76(1) problems are solved. It is further referred to the Novelty and Inventive Step objections raised in the European Search Opinion.*"

e) In reply to the communication, the appellant submitted with its letter dated 1 June 2011 a set of claims 1 and 2 and an amended description as a main request. Claims 1 and 2 of the main request corresponded, except for minor linguistic amendments, to claims 23 and 24 of the parent application as originally filed. In this letter of reply the appellant stated that the amended documents of the main request "correspond to the hints given by the Examiner under item 1(iii)" of the communication (point 1.1 of the letter) and submitted arguments in support of its view

that the amended application documents complied with Articles 76(1) and 123(2) EPC.

f) Subsequently, the examining division issued the decision under appeal. According to the decision the main request was not considered allowable because the subject-matter of claim 1 of the main request did not involve an inventive step over the disclosure of document D2 (*cf.* point II above).

g) Claims 1 and 2 of the present main request are identical to claims 1 and 2 of the main request underlying the decision under appeal.

2.3 It follows from these facts that in the official communication preceding the refusal of the application the examining division focused on the issue of the compliance of the application documents then on file with the requirements of Article 76(1) EPC and explicitly suggested to the appellant a way of overcoming the objections raised under Article 76(1) EPC by reinstating claims 23 and 24 of the parent application as originally filed (corresponding to claims 1 and 2 of the application as filed) as the sole claims, as the appellant subsequently did. The further statement by the examining division that the examination of novelty and inventive step was "deferred" until the objections raised under Article 76(1) EPC were appropriately overcome, while at the same time "referring" to the objections of lack of novelty and inventive step raised in the European search opinion, is ambiguous and, in its specific context, misleading. Indeed, such statement can, on the one hand, be interpreted in the sense that, in view of the objections raised under Article 76(1) EPC, no assessment of novelty and inventive step was carried

out at that stage of the proceedings with respect to the claims then on file, and in particular with respect to the amended claims 1 and 2, but that, nonetheless, the objections of novelty and inventive step previously raised with respect to claims 1 and 2 as originally filed were expressly maintained in the event that these claims were reinstated. On the other hand, as submitted by the appellant during the oral proceedings before the board, the same statement can also be interpreted - as the appellant actually did - in the sense that the examining division considered premature to reassess the issues of novelty and inventive step of the claims, so that any consideration of these issues was postponed until a set of claims complying with Article 76(1) EPC was filed, and that the objections previously raised in the European search opinion were only formally "referred" to as the basis for a subsequent re-assessment of novelty and inventive step in view of the claims to be filed and of the arguments submitted by the appellant with its previous letter of reply.

In addition, the ambiguity of the examining division's statement mentioned above had also the effect that the statement "If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(2) EPC" in the text of form 2001 accompanying the mentioned communication was also ambiguous as to whether the "deficiencies" to be rectified only referred to the objections raised under Article 76(1) EPC, or also included - notwithstanding the examination on novelty and inventive step being "deferred", and in the event that the original claims 1 and 2 were subsequently reinstated in the proceedings - the objections of novelty and inventive step raised in the European Search Opinion.

2.4 It is a general principle governing relations between the EPO and applicants that communications addressed to applicants must be clear and unambiguous so as to rule out misunderstandings on the part of a reasonable addressee, and that an applicant must not suffer a disadvantage as a result of having relied on a misleading communication (see for instance decisions G 2/97 (OJ EPO 1999, 123), points 1, 4.1 and 5.1 of the Reasons, and J 3/87 (OJ EPO 1989, 3), Headnote, points I and II). The mentioned communication of the examining division contained, on the one hand, an explicit and clear suggestion to reinstate claims 1 and 2 as originally filed as the sole claims in order to overcome the objections under Article 76(1) EPC. On the other hand, however, the aforementioned statement made by the examining division (see point 2.2 above, paragraph d)) was ambiguous as to the possible procedural consequences of the reinstatement of original claims 1 and 2. In the board's view this ambiguity objectively misled the appellant to expect that, after reinstatement of claims 1 and 2 as originally filed as the sole claims as expressly suggested by the examining division, the deferred examination of the issues of novelty and inventive step would then be resumed taking into account the arguments previously submitted by the appellant, and that the appellant would then be informed of any subsequent negative finding in this respect.

Therefore, the board considers that, in the specific circumstances of the case, the examining division's communication created a realistic and reasonable expectation that any subsequent negative finding of the examination division on the issue of novelty and/or inventive step would then be communicated to the appellant before any adverse decision on any of these

issues would be taken by the examining division. The appellant could therefore not expect that by closely following the examining division's suggestion in respect of the original claims 1 and 2 a decision refusing the application on the grounds of lack of inventive step of these claims could then be immediately issued. For these same reasons, the fact that the appellant saw at this stage of the proceedings no need to request oral proceedings as a precautionary measure was justified in the circumstances of the case.

- 2.5 In the board's opinion the refusal of the main request then on file for lack of inventive step immediately after resuming the deferred examination of this issue constituted, in the specific circumstances mentioned above, a fundamental deficiency in the first-instance proceedings within the meaning of Article 11 RPBA as it adversely affected the procedural rights of the appellant. According to Article 11 RPBA the board shall remit the case to the department of first instance if such a fundamental deficiency occurred in the first-instance proceedings, unless special reasons present themselves for doing otherwise. The overall length of the proceedings to date (priority date of 12 January 1999) may constitute such a special reason. However, the application is a divisional application, and this explains, at least in part, the length of the proceedings. In addition, this sole circumstance does not constitute in the present case a sufficient special reason for not considering the remittal of the case, especially in view of the procedural deficiency noted above affecting the whole proceedings, and also in view of the new issues raised under Articles 83 and 84 EPC 1973 on a preliminary basis in the board's communication annexed to the summons to oral

proceedings which might require further consideration by the examining division.

The board concludes that, under these circumstances, the decision under appeal is to be set aside and the case remitted to the department of first instance for further prosecution (Article 11 RPBA).

3. *Rule 103(1)(a) EPC*

The appeal is allowable within the meaning of Rule 103(1)(a) EPC insofar as the decision under appeal is set aside (*cf.* point 2 above). In addition, the fundamental procedural deficiency considered in point 2 above and justifying the remittal of the case constitutes a substantial procedural violation that justifies the reimbursement of the appeal fee as requested by the appellant.

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:



S. Sánchez Chiquero

R. Bekkering

Decision electronically authenticated