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**Datasheet for the decision
of 2 April 2014**

Case Number: T 0305/14 - 3.2.08

Application Number: 07866126.1

Publication Number: 2099381

IPC: A61C13/00, A61C13/08

Language of the proceedings: EN

Title of invention:

MULTICOLOR DENTAL BLANKS AND RELATED METHODS

Applicant:

Giordano, Russell, A.

Headword:

Relevant legal provisions:

EPC Art. 113(1), 84
EPC R. 103(1)(a), 103(2)

Keyword:

Reimbursement of appeal fee - (yes) - Interlocutory revision -
substantial procedural violation (yes)

Decisions cited:

T 0772/07, T 0295/02

Catchword:



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Chambres de recours**

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Case Number: T 0305/14 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 2 April 2014

Appellant: Giordano, Russell, A.
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Representative: Müller, Wolfram Hubertus
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 27 August 2013
refusing European patent application No.
07866126.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: T. Kriner
Members: C. Herberhold
D. T. Keeling

Summary of Facts and Submissions

- I. By decision posted on 27 August 2013 the Examining Division refused European patent application No. 07866126.1 on the basis of Article 84 EPC.
- II. In its decision the Examining Division held that independent claim 1 as filed on 22 July 2013 was in contradiction with the description and figures 1 to 9 on file. Therefore a lack of clarity of the scope of protection of claims 1 to 13 arose in the light of the description, an objection which had already been raised in point 4a of a preceding communication dated 18 January 2013. The claims thus did not meet the requirements of Article 84 EPC.
- III. The appellant (applicant) lodged an appeal against this decision on 24 October 2013, paying the appeal fee on the same day. The statement setting out the grounds of appeal was filed on 23 December 2013.
- IV. The appellant requested:
- to annul the contested decision and
 - to reimburse the appeal fee.

As an auxiliary measure the appellant requested oral proceedings.

Together with the grounds of appeal, the appellant filed an amended description, pages 1-10, the amended pages clarifying that "merely the embodiment of Figures 10 to 13 of the present application was in accordance with independent claim 1 as filed on July 22, 2013...".

V. With letter dated 4 February 2014 the Examining Division granted interlocutory revision in accordance with Article 109(1) EPC but refused the request to reimburse the appeal fee. Therefore, as stipulated in Rule 103(2) EPC, the issue of reimbursement is to be decided by the Board of Appeal.

VI. The essential arguments of the appellant can be summarised as follows:

The appeal fee was to be reimbursed because the Examining Division's refusal was based on a substantial procedural violation and constituted a breach of the fundamental right to be heard.

Firstly, the alleged inconsistency between independent claim 1 and the embodiment illustrated in Figures 1 to 9 had been raised with respect to a previous version of independent claim 1, whereas claim 1 filed on 22 July 2013 had been amended by adding features of the description. Hence, the amended claim had not yet been considered by the Examining Division and a further communication was to be expected. Moreover, the appellant had explicitly stated that "an adaptation of the specification was deferred until a consensus over allowable claims could be reached", thus indicating that it was not intended that the originally filed description should form the basis for any decision, in particular for a decision concerning its consistency with the amended claims. Therefore, in accordance with the case law of the Boards of Appeal of the European Patent Office, in particular decisions T 0772/07 and T 0295/02, there existed no valid reason for refusal of the application.

Secondly, the appellant had tried to focus the discussion on patentability, thus aiming for effective examination proceedings. An obligation to file (temporarily) adapted pages of the description or (temporarily) cancel drawings every time a set of amended claims was filed would delay the examination proceedings and make them unnecessarily complex.

Thirdly, a decision refusing the application could not be expected, since the independent claim was amended by adding features of the description which had not yet been considered by the Examining Division, such that the appellant could at least expect a further communication in the event that the Examining Division raised new objections concerning novelty or inventive step with respect to the newly amended independent claim 1.

Summarising, the applicant had to file an appeal and pay the appeal fee due to a completely unpredictable ruling of the Examining Division and on the basis of several evident procedural violations so that the appeal fee had to be reimbursed according to Rule 103(1) (a) EPC.

Reasons for the Decision

1. The appeal is admissible.
2. The right to be heard (Article 113(1) EPC)
 - 2.1 In accordance with Rule 103(1) (a) EPC, the appeal fee is to be reimbursed in the event of interlocutory revision [...], if such reimbursement is equitable by reason of a substantial procedural violation. In the appellant's view a substantial procedural violation

occurred because its right to be heard, which is enshrined in Article 113(1) EPC, was not respected.

2.2 Before dealing in detail with the present case, the Board wishes to point out that Article 97(2) EPC provides for the refusal of a European patent application if any requirement of the EPC is not met, without laying down any hierarchical order. Hence, where an objection concerning an inconsistency between the claims on the one hand, and the description or the drawings on the other hand, has been raised in a communication from the EPO, failure to overcome that objection is as much a valid ground for a subsequent refusal as failure to comply with any other requirement of the EPC.

In the written procedure, each objection raised by the Examining Division should be dealt with in the applicant's reply, either by amendment of the application or by counter-arguments. Contrary to the appellant's belief, if the particular inconsistency and thus the objection under Article 84 EPC persist, i.e. if the legal and factual reasoning for the particular inconsistency does not need to be changed because of the subsequent claim amendment, then there is no absolute requirement to issue a further communication only because the claims have been further amended.

An applicant is free to defer dealing with a specific objection or to focus on a particular raised objection only, however at the risk that the application may be refused on account of one of the objections not dealt with, provided that there is no pending (auxiliary) request for oral proceedings and provided that the essential legal and factual reasoning with respect to said objection has been brought to the applicant's

attention in a preceding communication. In fact, this could not have been a surprise to the appellant as in the first paragraph of the cover sheet of the communication dated 18 January 2013 it is explicitly mentioned that "if the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(2) EPC". A statement that it was intended to deal with the objection later, i.e. an announcement of the intended filing of further hypothetical application documents, cannot prevent procedural acts by the Examining Division.

In this context the Board fails to see why an amendment of the description - similar to the one submitted by the appellant with the statement of grounds of appeal - would make the examination proceedings complex or would delay these proceedings. On the contrary, the amendments now performed by the appellant appear relatively straightforward and confirm and clarify that it was indeed intended that some of the embodiments should no longer be covered by the claims. Furthermore, in the event the amended claims were found allowable, an amended description would make a further communication by the Examining Division otiose, thus indeed shortening the proceedings.

It is noted that the situation is different in oral proceedings (with the exception of oral proceedings held in the applicant's absence) which are of a more interactive character and during which objections are normally dealt with one after the other. Therefore, decisions T 772/07 and T 295/02 (cited by the appellant), which both refer to decisions taken by the Examining Division in oral proceedings, are not directly transposable to the present case and cannot be interpreted in the sense that an objection under

Article 84 EPC based on an inconsistency between the description and the claims could not be a valid reason for a refusal in the written proceedings.

2.3 Article 113(1) EPC stipulates that "the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments." According to established case law (Case Law of the Boards of Appeal of the European Patent Office, 7th edition 2013, IV.B.2.7.3), in the context of the examination procedure, the word "ground" in Article 113(1) does not refer merely to a ground of objection in the narrow sense of a requirement of the EPC, but should be interpreted as referring to the essential reasoning, both legal and factual, which leads to the refusal of the application. Only if a preceding communication pursuant to Article 94(3) EPC sets out the essential legal and factual reasoning to support a finding that a requirement of the EPC has not been met, can a decision based on such a finding be issued without contravening Article 113(1) EPC.

2.4 In the present case, in point 4a of a communication dated 18 January 2013, the Examining Division had raised the following objection:

"The embodiments illustrated in Figures 1 to 9 are contradictory to the subject-matter of independent claim 1, such that a lack of clarity of the scope of protection of claims 1 to 16 arises in the light of the description (see also "Guidelines", F-IV, 4.3)"

The decisive question is thus, whether or not this objection can be considered to set out the essential

legal and factual reasoning that the requirements of Article 84 have not been met?

The wording of the objection details the requirement of the EPC which was considered not to be met (Article 84 EPC) and further gives an unproven statement that Figures 1 to 9 were contradictory to the subject-matter of independent claim 1. However, although the objection is correct in substance, there is no reasoning as to which particular feature specified in the claims was not shown in said drawings. The appellant thus was not clearly informed in the communication why the Examining Division was of the opinion that there was the mentioned inconsistency between Figures 1 to 9 and the subject-matter of independent claim 1. The statement was put forward in an abstract way only, without the necessary logical chain between the given statement and the particular technical facts of the case.

It was only with the impugned decision that the appellant learnt about the technical considerations behind the objection. In the "Grounds for the Decision", the Examining Division explained that:

"According to independent claim 1, "the inner zone (Z1) is surrounded in its entirety by the outer zone" (see independent claim 1, line 4), while in the embodiments shown in figures 1 to 9 and described on page 4, line 30, to page 5, line 25, this condition is not met, because on one surface of the blank, the inner zone (Z1) is not covered by the outer zone (Z3)"

and

"According to independent claim 1, "the inner zone (Z1) is not visible on any surface (S1-S6) of the blank" (see independent claim 1, lines 5 and 6), while in the embodiments shown in figures 1 to 9 and

described on page 4, line 30, to page 5, line 25, this condition is not met, because on one surface of the blank, the inner zone (Z1) is visible".

- 2.5 The Board notes that an inconsistency with any particular passages of the description had not been mentioned in the communication dated 18 January 2013 at all, whereas the inconsistency with respect to Figures 1 to 9 had been mentioned, however without the technical details of the objection later given in the decision, i.e. without detailing that it was the technical issue of whether the inner zone was covered or not or whether the inner zone was visible or not which was causing the inconsistency.

The Board is thus of the opinion that the communication dated 18 January 2013 did not set out the essential reasoning, both legal and factual, on which the subsequent refusal was based. Because the appellant learnt about the essential reasoning for the first time in the impugned decision, it did not have an opportunity to present its comments with respect to that reasoning, contrary to the requirements of Article 113(1) EPC. Since that procedural violation led to the refusal of the application, it must be considered a substantial procedural violation within the meaning of Rule 103(1)(a) EPC and a reimbursement of the appeal fee is thus equitable.

3. As interlocutory revision was granted by the Examining Division and because the Board - for the reasons set out above - has decided to grant reimbursement of the appeal fee, the auxiliary request to hold oral proceedings has become otiose.

Order

For these reasons it is decided that:

The appeal fee shall be reimbursed.

The Registrar:

The Chairman:



V. Commare

T. Kriner

Decision electronically authenticated