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**Datasheet for the decision  
of 26 September 2016**

**Case Number:** T 1033/16 - 3.5.07

**Application Number:** 09425065.1

**Publication Number:** 2221734

**IPC:** G06F17/30

**Language of the proceedings:** EN

**Title of invention:**

Cross community invitation and multiple provider product  
information processing system

**Applicant:**

Accenture Global Services Limited

**Headword:**

Cross-community invitation/ACCENTURE GLOBAL SERVICES

**Relevant legal provisions:**

EPC Art. 18

EPC R. 11(3), 103(1)(a), 113

**Keyword:**

Appealed decision - signed by the director on behalf of the second examiner - not taken by the Examining Division in its correct composition

Substantial procedural violation - (yes)

Reimbursement of appeal fee - (yes)

**Decisions cited:**

G 0012/91, T 0211/05

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 1033/16 - 3.5.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.07**  
**of 26 September 2016**

**Appellant:** Accenture Global Services Limited  
(Applicant) 3 Grand Canal Plaza  
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Dublin 4 (IE)

**Representative:** Müller-Boré & Partner  
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**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 21 December 2015 refusing European patent application No. 09425065.1 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** R. Moufang  
**Members:** R. de Man  
P. San-Bento Furtado

## **Summary of Facts and Submissions**

- I. The applicant (appellant) appealed against the decision of the Examining Division refusing European patent application No. 09425065.1 for lack of inventive step in the subject-matter of claims 1 to 13 of a sole substantive request.
- II. The decision was issued in writing on 21 December 2015 as a so-called "decision on the state of the file" on EPO Form 2061 without prior oral proceedings. This form refers for the reasons for the refusal to a communication of the Examining Division dated 30 June 2014. It further lists the names of the first examiner, second examiner and chairman of the Examining Division.
- III. Also present in the file is the signature page of the decision in the form of EPO Form 2048.2. It lists the same three names of the members of the Examining Division and includes the signatures of the first examiner and of the chairman. The signature of the second examiner is not present; instead, the form was signed by another person whose name is mentioned below the name of the second examiner, preceded by "i.V.". It is apparent from EPO Form 2701, which is dated 20 April 2016 and deals with the question of interlocutory revision, that this person is the director of the directorate to which the members of the Examining Division were assigned.
- IV. With the statement of grounds of appeal, the appellant maintained the sole substantive request considered in the contested decision as a main request and filed new sets of claims corresponding to first, second and third

auxiliary requests. It requested oral proceedings if the Board was inclined to refuse the main request.

- V. With a communication dated 16 August 2016, the Board drew the appellant's attention to the signature page and to decision T 211/05 of 30 July 2009, which in a similar situation had concluded that the decision had not been validly signed. The Board expressed its intention to set the appealed decision aside, to remit the case to the Examining Division for further prosecution, and to order reimbursement of the appeal fee. It invited the appellant to inform the Board whether, in those circumstances, it agreed to a remittal without first holding oral proceedings.
- VI. By letter of 12 September 2016, the appellant confirmed that should the Board intend to set aside the decision under appeal and remit the case to the Examining Division in view of the formal issue of the decision not being validly signed, no oral proceedings needed to take place.
- VII. The appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, in the alternative, on the basis of one of the first, second and third auxiliary requests.

### **Reasons for the Decision**

1. The appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.
2. It follows from Article 18(1) EPC that the examining division is responsible for the examination of a

European patent application, which includes the taking of a decision on the refusal of the application. In so far as this duty of the examining division has not been entrusted by a decision of the President of the EPO under Rule 11(3) EPC to other employees of the EPO, such a decision is to be taken by all its members in accordance with Article 18(2) EPC.

3. To allow verification by parties to proceedings and by the public that official acts by the EPO are performed by the competent employees, Rule 113(1) EPC provides that any decisions, summonses, notices and communications from the EPO are to be signed by, and state the name of, the employee responsible. According to Rule 113(2) EPC, where such a document is produced by the employee responsible using a computer, a seal may replace the signature.
4. In the present case, the decision refusing the application was notified to the appellant on EPO Form 2061. This form was produced using a computer and states the names of the employees responsible for the decision. It further includes the seal of the EPO. The decision thus formally complies with Rule 113 EPC.
5. To the Board's knowledge, however, the presence of the EPO's seal on EPO Form 2061 does not guarantee that the decision was in fact taken by all members of the Examining Division. The consistent practice of the EPO is therefore that EPO Form 2061 (in case of a so-called "decision according to the state of the file" as described in Guidelines for Examination, C-V, 15) and EPO Form 2007 (in case of a "regular" refusal decision) are accompanied in the public file by EPO Form 2048.2, which bears the signatures of the members of the

examining division (cf. Guidelines for Examination, E-IX, 4.1).

6. The signatures on EPO Form 2048.2 in the file of the present application include those of the first examiner and the chairman of the Examining Division. By signing the form these members have confirmed having taken part in the decision under appeal. But the form has been signed only *on behalf* ("i.V.", i.e. "in Vertretung") of the second examiner by the director.
7. It thus appears that the director has taken part in the decision-making process, not as a member of the Examining Division, but on behalf of the second examiner. Although the director presumably possesses the qualifications necessary to act as a technically qualified examiner, it is - with the exceptions set out in decisions by the President of the EPO under Rule 11(3) EPC - contrary to Article 18 EPC if the duties of a member of an examining division are carried out by a person not a member of that examining division. Decisions under Rule 11(3) EPC deal with the delegation of duties involving no technical or legal difficulties to formalities officers and have no bearing on the present case.
8. An alternative, but in the Board's view less natural interpretation of the director's signature is that it confirms that the second examiner did in fact fully take part in the decision-making process but had, for some reason, merely been prevented from signing it. But as the Enlarged Board has stated in decision G 12/91 (OJ EPO 1994, 285), reasons 7.1, a decision taken by an examining or opposition division following written proceedings comes into existence, albeit only "in camera", when it is signed by the division's members.

The act of signing the decision is thus an indispensable element of a member's fully taking part in a decision taken in writing. Therefore, even if the alternative interpretation were the intended one, the conclusion would be that the contested decision has not been validly taken by all members of the Examining Division.

9. Hence, this Board comes to the same conclusion as the deciding board in case T 211/05, which dealt with an essentially identical factual situation. Since the decision under appeal has not been validly taken by the Examining Division in its correct composition, the decision is to be set aside and the case is to be remitted to the Examining Division for further prosecution. Since this substantial procedural violation is the immediate cause for the remittal, it is equitable to reimburse the appeal fee under Rule 103(1)(a) EPC.
  
10. As explained in decision T 211/05, instead of signing the decision on behalf of the second examiner, the director could have formally changed the composition of the Examining Division if the return of the second examiner could not be awaited. The replacement second examiner would then have had to make him- or herself familiar with the case to the extent that he or she could have fully participated in the decision-making process. The Board notes that in this respect no difference exists between a decision "according to the state of the file" taken following a corresponding request by an applicant and a "regular" refusal decision. Such a request by an applicant by no means permits, let alone obliges, an examining division to immediately conclude the examination proceedings as a mere formality with a decision issued in standard form;



rather, the examining division will have to verify *inter alia* whether it is in fact in a position to adopt the opinion and reasons expressed in its last substantive communication as its definite stance on the case.

11. The Board further notes that EPO Form 2701, relating to the question of interlocutory revision, was signed (below the crossed box "Examining Division") by the first examiner, the chairman and, again on behalf of the second examiner, by yet another person.

However, assessing whether to grant interlocutory revision or not is a duty of the department whose decision is contested (see Article 109(1) EPC). EPO Form 2701 should therefore not have been signed for the Examining Division by a person who was not a member of it.

12. Since the substantive submissions filed by the appellant in connection with the appeal are now part of the file, the Examining Division in its further prosecution of the case cannot confine itself to issuing a properly signed identical decision.

## 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:



I. Aperribay

R. Moufang

Decision electronically authenticated